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TRANSCRIPT OF RECORD

Supreme Court of the United States

OCTOBER TERM, 1931

No. 506

AMERICAN TRADING COMPANY, PETITIONER,

vs.

H. E. HEACOCK CO.

No. 507

WM. A. ROGERS, LTD., AND AMERICAN TRADING COMPANY, PETITIONERS,

vs.

H. E. HEACOCK CO.

ON WRITS OF CERTIORARI TO THE SUPREME COURT OF THE PHILIPPINE ISLANDS

PETITION FOR CERTIORARI FILED NOVEMBER 6, 1931

CERTIORARI GRANTED JANUARY 11, 1932

(36,320, 36,321)

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United States of America
Philippine Islands

In the Supreme Court of the Philippine Islands

H. E. HEACOCK CO.,
Plaintiff and Appellee,

vs.

AMERICAN TRADING COMPANY,
Defendant and Appellant.

G. R. No. 31851 Concerning Trade-Marks and Unlawful Competition.

Wm. A. ROGERS, LTD., and AMERICAN TRADING COMPANY,
Plaintiffs and Appellants,

vs.

H. E. HEACOCK CO.,
Defendant and Appellee.

G. R. No. 31852 Concerning Trade-Marks and Unlawful Competition.

Appellate Jurisdiction

BE IT REMEMBERED that, in the above-entitled cases, and on the respective dates hereinafter set forth, there were taken and had before the Court of First Instance of the City of Manila the following

PROCEEDINGS:

(A)

On January 12, 1928, the plaintiff in case G. R. No. 31851, through its attorneys, Messrs. De-

Witt, Perkins & Brady, filed with the Clerk of said Court its complaint against the defendant herein, which complaint is in words and figures as follows:—

(HEADING AND TITLE OMITTED)

COMPLAINT

Comes now the plaintiff and for cause of action against the defendant alleges:

I

That the plaintiff is a corporation duly organized and existing under the laws of the Philippine Islands, with its principal place of business at No. 127 Escolta, in the City of Manila, Philippine Islands;

II

That the defendant is likewise a corporation organized and existing under the laws of the Philippine Islands, with its principal place of business at No. 310 Dasmariñas, in the City of Manila, Philippine Islands;

III

That for a period of upward of twenty years the plaintiff has been engaged in the importation and sale within the Philippine Islands of flatware bearing the name—ROGERS—stamped upon the back of the handle thereof, together with an indication of the material of which said flatware is composed;

IV

That on or about June 27, 1918, the plaintiff caused a trade-mark to be registered in its name,

in the Bureau of Commerce and Industry, consisting of the word—ROGERS—for use upon spoons and other flatware whether nickle, silver-plated, or silver, as well as nickel, silver-plated or silver goods of all kinds save and except cutlery, and ever since that date the said trade-mark has been used extensively by the plaintiff upon flatware imported and offered for sale by it throughout the Philippine Islands;

V

That the goods to which the said plaintiff has affixed the said trade-mark have become generally, favorably and popularly known throughout the Philippine Islands as ROGERS flatware;

VI

That notwithstanding the fact that the said defendant was well aware of the ownership of said trade-mark by the plaintiff and of the use made by the plaintiff hereof as hereinbefore alleged and of the favorable reputation the flatware imported by the plaintiff as ROGERS flatware has come to have throughout the Philippine Islands, and that no other dealer in flatware in the Philippine Islands has a right to the use of the word—ROGERS—in connection with the importation and sale of flatware, the said defendant in the year 1925 or thereabout began to import and sell within the Philippine Islands flatware of precisely the same designs as that imported and sold by the plaintiff with the

words—"Wm. A. ROGERS"—together with an indication of the material of which such flatware is composed, stamped in precisely the same position on the back of the handle thereof as that utilized by the plaintiff;

VII

That the said defendant, through the use of said infringing mark or stamp in selling flatware imported by it, has given and is giving said flatware the appearance of the flatware imported and sold by this plaintiff in such a way as to induce purchasers to believe that the flatware imported and sold by the defendant is the same as that imported and sold by the plaintiff, and such appearance has so induced and is now inducing purchasers within the Philippine Islands to such belief; and

VIII

That such imitation of plaintiff's mark upon the flatware imported by the defendant has been effected by the defendant for the purpose of deceiving the public and defrauding the plaintiff of its legitimate trade, and that the public has been and is being deceived and this plaintiff has been and is being defrauded thereby to its great damage.

WHEREFORE, the plaintiff respectfully prays:

a) That the defendant be ordered to render an account of the sales it has made of flatware under the mark—"Wm. A. ROGERS"—from the time

it began to import and sell the same, and of the profits derived from said sale;

b) That double the amount of said profits be adjudicated to this plaintiff as indemnity for the damages suffered by this plaintiff by reason of unlawful competition carried out by said defendant with regard to said trade-mark—ROGERS—of the property of the plaintiff;

c) That an order issue from this Court forever enjoining the defendant, its agents, employees and assigns, from selling nickel, silver-plated, as well as nickel, silver-plated or silver goods of any kind under any mark where the name—ROGERS—is used, and from any other means by which the public may be induced to believe that the flatware imported and sold by the defendant is the flatware imported and sold by this plaintiff and known as—ROGERS—flatware; and

d) That plaintiff be awarded the costs of the present suit.

(B)

The defendant having been summoned, duly appeared, and on February 11, by its attorney, Mr. J. W. Ferrier, filed its answer to said complaint, as follows:

ANSWER

Comes now the defendant, the American Trading Co., by its undersigned attorney, and in answer to the complaint of the plaintiff on file herein admits, denies and alleges as follows, to-wit:—

1. Admits the allegations of paragraphs I and II of plaintiff's complaint.

2. Denies the allegations contained in paragraph III of plaintiff's complaint.

3. In answer to paragraph IV of plaintiff's said complaint this defendant admits that the plaintiff caused the word "ROGERS" to be registered with the Bureau of Commerce and Industry as and for a trade-mark to be used upon silverware and flatware as stated in said paragraph IV by it this respect alleges that the registration of said trade-mark is of no legal validity as against this defendant for the reason that the name "ROGERS" is a family name or surname not belonging to the plaintiff and that, therefore, the plaintiff had no legal right to appropriate or attempt to appropriate such name to its exclusive use. Further answering said paragraph IV of said complaint this defendant denies that this plaintiff has been using such trade-mark upon merchandise imported and offered for sale by it within the Philippine Islands.

4. Denies generally and specifically that the plaintiff herein has ever affixed said trade-mark to any goods whatsoever as claimed by it in paragraph V of its said complaint and furthermore denies that any goods to which this plaintiff may have affixed said trade-mark have ever been or become popularly known throughout the Philippine Islands as "ROGERS" flatware.

5. In reply to paragraph VI of plaintiff's complaint this defendant denies specifically that this plaintiff has the exclusive right to the use of the word "ROGERS" in connection with the importation and sale of silverware and flatware within the Philippine Islands and furthermore specifically denies that the flatware and silverware imported and sold within the Philippine Islands by this defendant is of the same designs as that claimed to have been imported and sold by the plaintiff. Further answering said paragraph VI of plaintiff's said complaint this defendant alleges that all of the silverware and flatware imported by it and sold within the Philippine Islands and bearing the words "Wm. A. ROGERS" together with other symbols and marks as the trademark thereon were manufactured by Wm. A. Rogers, Ltd. in the United States of America and that the trade-marks appearing thereon have been duly registered in the Patent Office of the United States of America in accordance with the provisions of the laws of the said United States of America and is, therefore, admissible into the Philippine Islands under the provisions of Act No. 2460 of the Philippine Commission, of the Acts of Congress of February 20, 1905, as amended by the Acts of Congress of May 4, 1906, March 2, 1907, and February 18, 1909.

6. Denies generally and specifically each and every allegation contained in paragraph VII of plain-

tiff's said complaint and in this respect further alleges that even if the allegations of said paragraph were true nevertheless under the provisions of said Act 2460 and of the above mentioned acts of Congress this defendant would have the right to import and sell such merchandise within the Philippine Islands.

7. Denies generally and specifically each and every allegation contained in paragraph VIII of plaintiff's complaint herein.

As a further answer and special defense to plaintiff's complaint on file herein this defendant alleges:

8. That the registration by this plaintiff of the word "ROGERS", a family name or surname which forms no part of its own name, is unwarranted and unauthorized and can in no way prevent another person whose family name is "ROGERS" from using such name in the transaction of his legitimate business either within or without the Philippine Islands.

9. That this defendant is acting within the Philippine Islands as the local agent and representative of Wm. A. Rogers, Ltd., a corporation organized under the laws of the State of New York of the United States of America; that said corporation is engaged in the manufacture of silverware and flatware of various kinds and that it has registered in the Patent Office at Washington, D. C., United

States of America, the following trade-marks for use upon silverware and flatware manufactured by it and has been using such trade-marks from the different times of their registration (1897 to 1917) in its business and upon the goods manufactured by it consisting of silverware, flatware, etc.:

		Wm. A. ROGERS—E.P.N.S.		
		Wm. A. ROGERS—E.P.B.M.		
1881	R	ROGERS	R	E.P.N.S.
1881	R	ROGERS	R	E.P.B.M.
		W. R.		
1881	R	ROGERS	R	A-1
		Wm. A. Rogers (in old English script)		

10. That the merchandise imported by this defendant and about which this plaintiff is complaining beans some one or more of the above set forth trade-marks.

11. That such trade-marks having been duly registered in the United States, merchandise to which they have been affixed is entitled to admission to the Philippine Islands under the provisions of Act 2460 of the Philippine Commission as well as the Acts of Congress above cited and that being entitled to admission to the Philippine Islands through importation from the United States they are entitled to be sold therein.

WHEREFORE, this defendant prays the order of this Honorable Court dismissing plaintiff's complaint with costs against the plaintiff.

(C)

By stipulation between the parties herein, dated May 17, 1928, and with the approval of the Court, this case was ordered transferred to Branch IV of the Court of First Instance of the City of Manila presided over by Judge Carlos A. Imperial, and that it be heard simultaneously and tried together with Civil Case G. R. No. 31852 of this Supreme Court, entitled "Wm. A. ROGERS, LTD., a corporation, and AMERICAN TRADING COMPANY, a corporation, Plaintiffs, vs. H. E. HEACOCK CO., a corporation, Defendant."

(D)

On January 13, 1928, the plaintiffs in case G. R. No. 31852 through their attorney, Mr. J. W. Ferrier, filed with the Clerk of said Court their complaint against the defendant herein, which complaint is in words and figures as follows:—

(HEADING AND TITLE OMITTED)

COMPLAINT

Come now the plaintiffs herein, by their undersigned attorney, and for cause of action against the defendant herein respectfully show to this Honorable Court:

1.—That the plaintiff Wm. A. Rogers, Ltd., is a corporation duly organized and existing under and by virtue of the laws of the State of New York, of the United States of America; that the plaintiff, the American Trading Co., is a corporation duly organized and existing under and by virtue

of the laws of the Philippine Islands with its principal office in the City of Manila and that the defendant H. E. Heacock Co. is also a corporation duly organized and existing under and by virtue of the laws of the Philippine Islands with its principal place of business also in the said City of Manila.

2.—That the plaintiff, the American Trading Co., is the Philippine agent and representative of the other plaintiff, Wm. A. Rogers, Ltd., for the purpose of securing orders for the purchase and sale of silverware, silver platedhollow and flatware and cutlery manufactured by the said Wm. A. Rogers, Ltd., in the United States of America and sold throughout the United States and within the Philippine Islands under various trade-marks among which are the following:—

		WM. A. ROGERS—E.P.N.S.		
		WM. A. ROGERS—E.P.B.M.		
1881	R	ROGERS	R	E.P.N.S.
1881	R	ROGERS	R	E.P.B.M.
		W. R.		
1881	R	ROGERS	R	A-1
		Wm. A. Rogers (in old English script)		

3.—That such trade-marks were duly registered in the United States of America at different times from 1897 to 1917 and since their registration have been continuously used in trade by the said Wm. A. Rogers, Ltd., in the United States, in the Philippine Islands and throughout the world.

4.—That the plaintiff, the American Trading Co., as the local agent and representative of the other plaintiff, Wm. A. Rogers, Ltd., has been importing into the Philippine Islands such above mentioned merchandise manufactured by and bearing some or all of the trade-marks above mentioned of the other plaintiff, Wm. A. Rogers, Ltd., since 1923 and has built up a considerable business in the Philippine Islands in the sale of such merchandise.

5.—That the importation into the Philippine Islands of such merchandise bearing such trade-marks during the period stated was and is well known to this defendant which has until within the last few days made no objection thereto.

6.—That on or about the 27th day of June, 1918, the defendant registered with the Bureau of Commerce and Industry of the Philippine Islands, the word "ROGERS" as a trade-mark for silverware, flatware and other articles similar to those imported into the Philippine Islands as above stated by these plaintiffs.

7.—That the said word "ROGERS" is a family name and while as a mater of law it may be true that the defendant had a right to register such name as its trade-mark, which these plaintiffs deny, such registration can in no wise present another person having the family name "ROGERS" or a corporation of which the family name "ROGERS" is a part, as is the case with one of the plaintiffs here, from also using such name as his or its trade-mark.

8.—That beginning on or about December 15, 1927, this defendant wrote letters to the plaintiff, the American Trading Co., and to various customers of said plaintiff and of the other plaintiff herein threatening each and all of them with injunction proceedings and with a suit for an accounting of any profits which might arise from any sales made by them of silverware bearing the name "Wm. A. Rogers", basing such threats, as shown by such letters, upon the registration by it of the word "ROGERS" as its trade-mark as above stated.

9.—That such threats were and are based upon the illegal and unwarranted assumption that the registration by this defendant of the word "ROGERS" as its trade-mark for silverware is sufficient to prevent the plaintiffs herein and particularly the plaintiff Wm. A. Rogers, Ltd., from using that word either alone or in combination with other words, symbols or characters as its trade-mark upon similar merchandise and that such threats and demand were and are illegal, unauthorized and unwarranted.

10.—That the plaintiff, the American Trading Co., has requested the said defendant H. E. Heacock Co. to withdraw the various letters written by it to the said American Trading Co. and to the customers thereof and of the other plaintiff Wm. A. Rogers, Ltd., but that said defendant has neglected and refused and still neglects and refuses

so to do, to the damage and prejudice of these plaintiffs in that said customers of these plaintiffs have refused and are refusing to purchase the silverware manufactured by the plaintiff, Wm. A. Rogers, Ltd., bearing such trade-marks of said plaintiff, thus causing injury and damage to these plaintiffs in the amount of ₱4,000.00.

11.—That the continuance of the acts of this defendant set forth and complained of above during the pendency of the present action would work an injustice to these plaintiffs and that this defendant is doing and threatens to do acts in violation of this plaintiff's rights as above set forth, all of which, permitted to be continued, will work irreparable injury and damage to these plaintiffs.

WHEREFORE, these plaintiffs respectfully pray the judgment of this Honorable Court—

(a) Restraining and ordering this defendant to abstain from further interference with the business of these plaintiffs conducted under the above mentioned and set forth trade-marks;

(b) Condemning the defendant to pay to the plaintiffs as damages for the injuries caused them by its actions the sum of ₱4,000.00;

(c) Condemning the defendant to pay to these plaintiffs such other and further damages as they may be able to prove have accrued to them or may accrue to them during the pendency of this action

as the result of the wrongful and unlawful acts done and performed by said defendant;

(d) Condemning the defendant to pay the costs of this action;

(e) Giving and granting to these plaintiffs such other and further relief as this Honorable Court may deem just and equitable;

(f) Ordering and directing the issuance of a preliminary injunction herein upon the filing by these plaintiffs of a bond in such sum as this Honorable Court may designate, restraining said defendant, its agents, attorneys and employees from in any way interfering with the importation and sale within the Philippine Islands of silverware manufactured by Wm. A. Rogers, Ltd., and bearing any or all of the above set forth trade-marks.

(NOTE.—This complaint was verified by the oath of Mr. S. Allen Presby, President and General Manager of the plaintiff, the American Trading Co.)

(E)

The required bond having been filed and approved, on January 13, 1928, the Court of First Instance of the City of Manila, issued its writ of preliminary injunction against the defendant herein, the said writ being in words and figures as follows:

(HEADING AND TITLE OMITTED)

To H. E. Heacock Co., a corporation, its At-

torneys, Agents, Servants, or other Persons acting for or in privity with it.

Greetings:

Complaint having been filed before this Court of First Instance for the District of Manila in the above-entitled case against the defendant, H. E. Heacock Co., a corporation, above mentioned, praying that a preliminary injunction be issued against said defendant restraining it from continuing the performance of certain acts mentioned in the complaint and more particularly described hereafter; upon considering said complaint and affidavit by S. Allen Presby, President and General Manager of the plaintiff, the American Trading Company, a corporation, and it appearing to the satisfaction of the Court that this is a case where a writ of injunction should issue, sufficient reasons having been alleged, and the bond required by law having been given in the sum of TWO THOUSAND PESOS. (₱2,000.00), Philippine Currency, to the satisfaction of the Court;

IT IS HEREBY ORDERED by the undersigned Judge of this Court of First Instance that, until further orders, you, H. E. Heacock Co., a corporation, your attorneys, agents, servants, officers, or other persons acting for or in privity with you, shall desist and refrain from interfering in any way with the importation and sale within the Philippine Islands by the plaintiffs herein, Wm. A. Ro-

gers, Ltd., a corporation, and the American Trading Company, a corporation, of silverware, silverplated, hollow and flatware and cutlery bearing the trade-marks—

		Wm. A. ROGERS—E.P.N.S.		
		Wm. A. ROGERS—E.P.B.M.		
1881	R	ROGERS	R	E.P.N.S.
1881	R	ROGERS	R	E.P.B.M.
		W. R.		
1881	R	ROGERS	R	A-1
		Wm. A. Rogers (in old English script).		

or any of them, and shall further desist and refrain from interfering in any way with the sale by customers of the said plaintiffs of such merchandise, so marked, purchased by them by or through the plaintiffs, or either of them.

Manila, P. I., January 13, 1928.

(Sgd.) C. A. IMPERIAL
Judge,
Court of First Instance for the
Judicial District of Manila.

(Seal)

(F)

The defendant having been summoned, duly appeared, and on February 11, 1928, by its Attorneys, Messrs. DeWitt, Perkins & Brady, filed its original answer in this action, which original answer was subsequently amended under date of October 26, 1928, to read as follows:—

(HEADING AND TITLE OMITTED)

AMENDED ANSWER

Comes now the defendant in the above entitled cause, by its undersigned attorneys, and in answer to the complaint herein alleges:—

I

It admits the allegations of Paragraph I of said complaint.

II

It denies generally and specifically each and every allegation of each and every of the remaining paragraphs of said complaint, except such as may hereafter be expressly admitted.

By way of special defense, the defendant alleges:

I

That for a period of upward of twenty years the defendant has been engaged in the importation into and sale within the Philippine Islands of flatware bearing the trade-mark—"ROGERS"—stamped upon the back of the handles thereof, together with an indication of the material of which said flatware is composed;

II

That on or about June 27, 1918, the defendant caused a trade-mark to be registered in its name, in the Bureau of Commerce and Industry, consisting of the word—ROGERS—for use upon spoons

and other flatware whether nickel, silver-plated, or silver, as well as nickel, silver-plated or silver goods of all kinds save and except cutlery and ever since that date the said trade-mark has been used extensively by the defendant upon flatware imported and offered for sale by it throughout the Philippine Islands;

III

That the goods to which the said defendant has affixed the said trade-mark have become generally, favorably and popularly known throughout the Philippine Islands as ROGERS flatware;

IV

That notwithstanding the fact that the plaintiffs were well aware of the ownership of said trade-mark by the defendant and of the use made by the defendant thereof as hereinbefore alleged and of the favorable reputation the flatware imported by the defendant as ROGERS flatware has come to have throughout the Philippine Islands, and that no other dealer in flatware in the Philippine Islands has a right to the use of the word—ROGERS—in connection with the importation and sale of flatware, the said plaintiffs in the year 1925 or thereabout began to import and sell within the Philippine Islands flatware of precisely the same designs as that imported and sold by the defendant with the words "Wm. A. ROGERS"—together with an indication of the material of which such flatware is composed,

stamped in precisely the same position on the back of the handle thereof as that utilized by the defendant for that purpose;

V

That the said plaintiffs, through the use of said infringing mark or stamp in selling flatware imported by them, have given and are giving said flatware the appearance of the flatware imported and sold by this defendant in such a way as to induce purchasers to believe that the flatware imported and sold by the plaintiffs is the same as that imported and sold by the defendant, and such appearance has so induced and is now inducing purchasers within the Philippine Islands to such belief.

VI

That such imitation of defendant's mark upon the flatware imported and sold by the plaintiffs in the Philippine Islands has been effected by the plaintiffs for the purpose of deceiving the public and defrauding the defendant of its legitimate trade, and that the public has been and is being deceived and this defendant has been and is being defrauded thereby to its great damage.

As a second special defense, the defendant alleges:

I

That at the time the complaint herein was filed, this defendant had filed an action against the plain-

tiff herein, the American Trading Company, involving precisely the same issues as those presented in this cause and that the plaintiffs and their attorney knew that said action was pending at the time of the filing of the complaint herein.

II

That the number of said action is Civil Case No. 32952 of the Court of First Instance of the City of Manila, and a copy of this defendant's complaint herein is hereunto annexed, and hereby made a part hereof, marked Exhibit "A".

WHEREFORE, it is respectfully prayed that the complaint herein be dismissed, and the preliminary injunction herein dissolved, with costs against the plaintiffs.

CROSS-COMPLAINT

By way of cross-complaint against the plaintiff Wm. A. Rogers, Ltd., the defendant alleges:

I

That the defendant H. E. Heacock Company is a domestic corporation duly organized and existing under the laws of the Philippine Islands, with its principal place of business at No. 127, Escolta, Manila, Philippine Islands.

II

That the plaintiff Wm. A. Rogers, Ltd., is a foreign corporation duly organized and existing under and by virtue of the laws of the State of New

York of the United States of America, the other plaintiff, American Trading Co., a domestic corporation duly organized and existing under the laws of the Philippine Islands and with its principal office in the City of Manila, being the local agent or representative for the Philippine Islands for the said Wm. A. Rogers, Ltd.

III

That for a period of upward of twenty years the defendant has been engaged in the importation into and sale within the Philippine Islands of flatware bearing the trademark "Rogers" stamped upon the back of the handles thereof, together with an indication of the material of which said flatware is composed.

IV

That on or about June 27, 1918, the defendant caused a trade-mark to be registered in its name, in the Bureau of Commerce and Industry, consisting of the word—ROGERS—for use upon spoons and other flatware whether nickel, silver-plated, or silver, as well as nickel, silver-plated or silver goods of all kinds save and except cutlery, and ever since that date the said trade-mark has been used extensively by the defendant upon flatware imported and offered for sale by it throughout the Philippine Islands.

V

That the goods to which the said defendant has

affixed the said trade-mark have become generally, favorably and popularly known throughout the Philippine Islands as ROGERS flatware.

VI

That notwithstanding the fact that said plaintiff Wm. A. Rogers, Ltd. was well aware of the ownership of said trade-mark by the defendant and of the use made by the defendant thereof as hereinbefore alleged and of the favorable reputation the flatware imported by the defendant as ROGERS flatware has come to have throughout the Philippine Islands, and that no other dealer in flatware in the Philippine Islands has a right to the use of the word —ROGERS—in connection with the importation and sale of flatware, the said plaintiff in the year 1925 or thereabout began to import and sell within the Philippine Islands flatware of precisely the same designs as that imported and sold by the defendant with the words "Wm. A. ROGERS"—together with an indication of the material of which such flatware is composed, stamped in precisely the same position on the back of the handle thereof as that utilized by the defendant for that purpose.

VII

That the said plaintiff, through the use of said infringing mark of stamp in selling flatware imported by it, has given and is giving said flatware the appearance of the flatware imported and sold by this defendant in such a way as to induce purcha-

sers to believe that the flatware imported and sold by said plaintiff is the same as that imported and sold by the defendant, and such appearance has so induced and is now inducing purchasers within the Philippine Islands to such belief.

VIII

That such imitation of defendant's mark upon the flatware imported and sold by said plaintiff in the Philippine Islands has been effected by the plaintiff for the purpose of deceiving the public and defrauding the defendant of its legitimate trade, and that the public has been and is being deceived and this defendant has been and is being defrauded thereby to its great damage.

WHEREFORE, this defendant respectfully prays:

(a) That Wm. A. Rogers, Ltd. be ordered to render an account of the sales it has made of flatware under the mark "Wm. A. ROGERS" or under any other mark using the word "ROGERS" as a part of it, from the time it began to import and sell the same in the Philippine Islands, and of the profits derived from such sales.

(b) That double the amount of said profits be adjudicated to this defendant as indemnity for the damages suffered by it by reason of unlawful competition carried out by said Wm. A. Rogers, Ltd., with regard to said trade-mark "ROGERS" of the property of this defendant.

(c) That an order issue from this Court forever enjoining Wm. A. Rogers, Ltd., its agents, employees and assigns, from selling nickel, silver-plated, as well as nickel, silver-plated or silver goods of any kind under any mark where the name—"ROGERS"—is used, and from any other means by which the public may be induced to believe that the flatware imported and sold by the plaintiff Wm. A. Rogers, Ltd., is the flatware imported and sold by this defendant and known as "ROGERS" flatware; and

(d) That this defendant be awarded the costs of the present suit.

(G)

To the cross-complaint of the defendant herein contained in its above-quoted amended answer, the plaintiffs herein, through their Attorney filed on or about October 31, 1928, the following reply:—

(HEADING AND TITLE OMITTED)

Comes now Wm. A. Rogers, Ltd., one of the plaintiffs herein, by its undersigned attorney, and in reply to the cross-complaint against it contained in the amended answer of the defendant herein dated October 26, 1928, admits, denies and alleges as follows:—

(1) Admits the allegations of paragraphs I and II of defendant's said cross-complaint.

(2) Denies generally and specifically the al-

legations of paragraph III of defendant's said cross-complaint.

(3) Admits, as stated in paragraph IV of defendant's said cross-complaint, that on or about June 27, 1918, the defendant caused a trade-mark to be registered in its name in the Bureau of Commerce and Industry consisting of the sole word "Rogers" but denies that said trade-mark has ever been used by the defendant upon flatware either imported or offered for sale by it throughout the Philippine Islands and furthermore alleging that the registration of such word alone, said word being a family name and no one having such family name being in any way connected with the Heacock Co., defendant herein, that such registration of said word alone, a family name as it is, null and void and unwarranted by any provision of law.

(4) In answer to paragraph V of defendant's said cross-complaint this plaintiff denies that the defendant, the H. E. Heacock Co., has ever at any time affixed the said trade-mark "Rogers" to any goods of any kind or character whatsoever.

(5) In reply to paragraph VI of defendant's said cross-complaint this plaintiff denies the allegations of said paragraph and in this respect alleges that the importation of flatware and silver [illegible] manufactured by it and bearing its [illegible] were imported into the Philippine [illegible] long before 1926 and it furthermore denies

that its designs are the same as those imported and sold by the defendant. It admits, however, that its trade-mark is stamped upon the back of the flatware manufactured and sold by it in the same manner and in the same position as trade-marks are stamped upon manufactures of every manufacturer of silver plated ware and flatware.

(6) Denies generally and specifically the allegations of paragraphs VII and VIII of defendant's said cross-complaint.

WHEREFORE, this plaintiff respectfully prays the order of this Honorable Court denying defendant's said cross-complaint with costs against said defendant and furthermore prays as in its original complaint on file herein.

(H)

ORAL EVIDENCE

(CAPTION AND TITLES OMITTED)

(JOINT HEARING)

Manila, P. I., August 30, 1928.

(FORENOON SESSION)

Before the Hon. C. A. Imperial, Judge,
There appeared:

Mr. A. Ponce Enrile (of the firm Dewitt, Perkins & Brady), counsel for H. E. Heacock Company;

Mr. J. W. Ferrier, counsel for the American Trading Company and Wm. A. Rogers, Ltd.

Mr. ENRILE. Your Honor: In one of these cases, H. E. Heacock Company is plaintiff against the Manila [American] Trading Company, and in

the other, William A. Rogers, Ltd., and others are plaintiffs against H. E. Heacock Company, and we have agreed to having these two cases tried jointly.

THE COURT. Where is the stipulation?.

MR. ENRILE. It is in the case of H. E. Heacock Company vs. American Trading Company, filed on May 18th.

THE COURT. Have it appear in the record that by stipulation of the parties and their respective counsel, civil cases Nos. 32952 and 32956 are heard and disposed of jointly and the evidence introduced serves for both cases.

Who wants to introduce that evidence?

MR. ENRILE. We shall introduce our evidence first. But before proceeding to introduce our evidence, I shall make a brief statement to the Court of what our cause of action consists of, in order that the Court may have knowledge of these cases before we present our evidence. Our complaint is on a twofold basis, one a trade-mark and the other unfair competition. We thus have two causes of action.

MR. FERRIER. Our answer is that although a name has been registered as trade-mark, that does not matter, because it has been made to appear that it was filed in the name of another.

MR. ENRILE. We agree with Mr. Ferrier that according to a large number of authorities, a trademark cannot be registered in the name of another person; but we maintain that there is a law expressly for that as Trade-mark.

THE COURT. Produce your evidence.

SYDNEY ALLEN PRESBY, 57 years of age, married, a merchant, residing at No. 204 Calle Nebraska, Ermita, Manila, P. I., who, having been sworn in due form, testified as follows: (Interpreted by A. Zulueta)

MR. ENRILE. (Direct examination)

Q You are manager of the American Trading Company?

A I am president.

Q And manager?

A And manager.

Q Since when?

A Since it was organized.

Q When was that?

A I believe it was in 1923 or 1924.

Q The American Trading Company is the exclusive agent in the Philippine Islands of William A. Rogers Ltd., of New York?

A Not of New York.

Q The American Trading Company is the exclusive agent in the Philippine Islands of William A. Rogers Ltd., a company duly organized under the laws of New York, according to the complaint that has been filed here?

A I ask you if you ask me whether I am the exclusive agent of William A. Rogers Ltd., a corporation organized under the laws of New York.

Q Yes.

A Then I answer no, there is no such name of such a corporation that I know of. As regards William A. Rogers about whom you ask me, that corporation is organized under the laws of Canada and is an organization doing business in Toronto, Niagara Falls, New York.

Q The American Trading Company, jointy with William A. Rogers Ltd., are plaintiffs against H. E. Heacock Company in the civil case of this Court numbered 32956. What relations has the American Trading Company with William A. Rogers Ltd?

A We are the exclusive agents in the Philippine Islands.

MR. FERRIER. With the leave of the Court: the whole error consists in the complaint stating that William A. Rogers Ltd. is a Corporation organized under the laws of the State of New York, while it is in reality a corporation organized under the laws of Canada. For this reason I ask that an amendment be authorized in this sense.

THE COURT. Is there any objection?

MR. ENRILE. No objection.

THE COURT. The amendment is admitted.

MR. ENRILE. (Cont.)

Q Since when is the American Trading Company of the Philippine Islands the exclusive agent in the Philippine Islands of William A. Rogers Ltd. of Canada?

A Since 1923 or 1924.

Q From that time until now, what sum, more or less, if you can tell the Court, has the American Trading Company or William A. Rogers Ltd. invested in the Philippines for propaganda and advertisements in newspapers and magazines or otherwise, of the tableware and articles imported here by the American Trading Company as exclusive agent of William A. Rogers of Canada?

MR. FERRIER. I object to the question because it is incompetent, immaterial, and irrelevant. What has been spent for advertising these goods has absolutely nothing to do with these cases.

MR. ENRILE. We wish to know what propaganda has been made with regard to these goods.

THE COURT. What is the object of this question? Why do we want to know how much has been spent for propaganda? That is a matter with reference to damages.

MR. ENRILE. It may be a matter concerning damages, and also because an article can be advertised in that manner.

THE COURT. What section says anything about that? Or what damages has the plaintiff to claim in an action of this kind, according to that section?

MR. ENRILE. It is section 8.

THE COURT. What does it say?

(Mr. Enrile reads section 8.)

MR. ENRILE. Well, I withdraw the question and am going to ask another.

Q Has the American Trading Company or William A. Rogers Ltd. of Canada, since the year 1923 or 1924, made any propaganda in the Philippines of the plated or nickel ware and articles of William A. Rogers Ltd., by means of advertisements in the newspapers, by means of catalogs, or by means of advertisements in magazines?

A Yes, sir.

Q Since when?

A You asked me if it was since the year 1924 and I answered yes.

Q What kind of advertisements or propaganda did the American Trading Company make in this sense?

A Your question is if advertising was done either in catalogs and I said yes.

Q I am asking you another question: what kind of propaganda or advertising of these articles has been carried on by the American Trading Company since 1924 and up to the present writing?

A We have furnished cuts to our customers; we have induced them to print catalogs; they have paid the American Trading Company to send salesman to various places, and all this has cost them considerable money. When I say they or them, I mean William A. Rogers Ltd.

Q So the propaganda made was carried on by

your customer and not by the American Trading Company?

A The American Trading Company is paying salaries to my salesmen, salaries for selling Rogers ware.

Q But the American Trading Company did not advertise these articles in the newspapers or magazines?

A We are manufacturers' representatives; we do not sell to the public, and for that reason we do not advertise in the newspapers; we encourage the persons to whom we sell the goods to make the propaganda, and they get the profits.

Q As a matter of fact, do you know for certain, of your own knowledge, who among your customers, if any, has advertised in the newspapers and in the magazines, induced to do so by the American Trading Company?

A I have never seen any advertisement in the newspapers, but this does not mean that there are not any. The majority of our customers send out catalogs.

Q Who sends catalogs?

A I would have to look at the list of our customers to see whether they have sent any or not. The question is whether they have sent any or not; but in view of the requests for cuts that we have been receiving it is to be believed that many of our customers have sent them. Heacock has subpoenaed many of my customers, and I would suggest that you ask them if they have advertised our goods, I mean, Rogers goods.

Q You said a moment ago that some of your customers advertised by means of catalogs, from which I presume that you had some of them in mind. Could you now mention any of those customers who ordered catalogs from you?

A Your presumption is not correct; I have not any

one especially in mind. I said several of our customers, which does not mean any special firm.

Q So that of your own personal knowledge, you cannot at this moment say that any customer of yours has printed catalogs and sent them to the customers?

A Yes, sir; I can.

Q Who?

A It is impossible to give you a complete list, as I said in my previous testimony.

Q We do not need a list.

A You ask me who; that is why I say I cannot tell you who.

Q I would be satisfied with what you remember positively now. You said you advertised by means of catalogs.

A Levy & Blum, Inc., and many others; but if you desire me to give you a complete list, I would have to find out properly.

Q But at this moment, the only name you can give is Levy & Blum?

A No.

Q Can you give any other?

A Mr. Bernardo, whom you have had summoned.

Q Can you give any other name?

A Bernardo and Sons.

Q Who else?

A S. Salte.

Q Who else?

A Several Chinese whose names I can not remember unless I see the list.

Q When did the catalogs of the persons whom you have mentioned here first appear?

A I have no idea when they began distributing catalogs; all I can say is that I have been furnishing them cuts since 1924.

Mr. ENRILE. That is all.

MR. FERRIER. No cross-examination.

.....

SAMUEL F. GACHES, 50 years of age, married, merchant, residing at No. 700 Calle Wright, Malate, Manila, P. I., who after having been sworn in due form, testified as follows: (Interpreted by A. Zulueta)

MR. ENRILE (Direct examination)

Q Do you know the firm H. E. Heacock Company?

A Yes, sir.

Q What relation have you with that firm?

A I am president and general manager.

Q Do you know since when the firm H. E. Heacock Company exists?

A The present corporation exists since 1909.

Q And was there any other corporation or Company Heacock before that?

A Yes, sir; the successor of H. E. Heacock Company was Heacock & Freer, Manila, established about the year 1901.

Q So that the firm H. E. Heacock Company now established in Manila is the successor of those other companies that you have mentioned, and all together were established in the Philippine Islands or in Manila in 1901 and until this day?

A Yes, sir.

Q Continuously?

A Yes, sir.

Q Do you know the tableware and other plated-ware or silver or nickel ware known in the market by the name of Rogers?

A Yes, sir.

Q Do you know whether or not that mark Rogers is registered?

A It is registered in the Philippine Islands.

Q By whom?

A By H. E. Heacock Company.

Q Since when, more or less?

A Since the year 1918, I believe.

Q And since when has H. E. Heacock Company been importing and selling these articles marked Rogers in the Philippines?

A Since the firm Heacock & Freer was first established in 1901.

Q Do you know if any other firm or person has sold or imported into the Philippines articles similar or equal to them, with the mark "Rogers" or any modification or combination of words containing the word "Rogers"?

MR. FERRIER. I object to the question because the witness is incompetent. The question to be decided by this Honorable Court is whether the things imported infringe the trademark; to prove that, the articles must be presented here with their marks and the Court must decide that.

MR. ENRILE. I ask the witness if anybody has imported that mark Rogers in the Philippines.

THE COURT. He may answer.

MR. FERRIER. Exception.

A Yes, sir.

MR. ENRILE (continues)

Q Since when have those articles been imported by another person or corporation besides H. E. Heacock Company, according to your knowledge?

A I do not remember the exact date; it only came to my knowledge towards the end of last year, 1927; I have been absent from the Philippines most of the time, particularly in the last four years.

Q What marks do the articles bear which H. E. Heacock Company has been selling, according to you, since the year 1901 and up to the present time?

MR. FERRIER. I object to the question because

the witness is incompetent. Some articles bearing the factory mark must be *presented* here; and also because it is not the best evidence; the merchandise with the mark is the best evidence of what they are importing?

THE COURT. He may answer.

MR. FERRIER. Exception.

A The mark "Rogers", followed or preceded by any other word or sign that we care to put.

MR. ENRILE (continues)

Q Those words or signs which you put or use or have been putting or using in combination with the word Rogers on your articles, such as tableware and other articles of silver, silver plated, or nickel, what meaning have they? why are they put jointly with the word Rogers?

A The quality of the article, whether it is Meneses silver, nickel, or Meneses silver of various kinds.

Q So that, as I understand it, those words or sign used jointly with the word Rogers on your articles indicate the quality of the particular article bearing those signs or words?

A Yes, sir.

Q As a merchant who has been engaged in business in Manila and the Philippines in general since the year 1901 until the present date, can you tell the Court what has been the significance, if any, in business in general in the Philippine Islands and in the city of Manila in particular, of the word Rogers used in relation to articles such as silver or plated tableware or toilet articles?

MR. FERRIER. I object to the question because it is incompetent, immaterial, and irrelevant.

THE COURT. He may answer.

MR. FERRIER. Exception.

A It has come to mean tableware sold by H. E. Heacock Company.

MR. ENRILE (continues)

Q How has the word Rogers in the commerce of the Islands acquired that special significance of it being articles of the firm H. E. Heacock; to what is that second meaning of the word Rogers in the commerce of the Islands due?

A It has come to have that meaning because of the extensive advertising campaign that we have been making in our business since 1905, when we began to sell it at retail.

Q H. E. Heacock Company has been advertising that mark Rogers since 1905, according to you; until when?

A We are still advertising it now.

Q In what way have you been advertising it?

A We have been advertising it through the newspapers, weekly and monthly reviews, catalogs, handbills, circulars, and in many other ways.

Q Have you looked up copies of the first advertisements of articles with the trade-mark Rogers published by the firm H. E. Heacock Company?

A Yes, sir.

Q Have you those copies here?

A There is one of the Manila Times of the year 1905. (Showing it.)

Q I exhibit to you this number of the Manila Times of October 4, 1905, page 5, which we mark exhibit "A" for identification. Tell us if you know the advertisement of Rogers that appears here?

A Yes, sir.

Q Whose is that advertisement?

A An advertisement of the Heacock Company.

Q I show you this other advertisement of articles of the make Rogers which appears on page 5 of the issue of the Manila Times of October 7, 1905, which we mark Exhibit "B" for identification. Tell us if you know it and whose

that advertisement is?

A. Yes sir; I know it.

Q Whose is it?

A Heacock Company's.

Q I show you this other advertisement in the issue of the Manila Times of October 9, 1905, on page 5 thereof, where there is an advertisement of Rogers tableware and other articles, which is marked exhibit "C" for identification. Tell us if you know it?

A It is an advertisement of Heacock Company.

Q I also show you this number of the Manila Times of November 8, 1905, on page 1 of which there appears an advertisement of the Rogers tableware and other articles, which we mark exhibit "D" for identification. Tell us if you know this advertisement and whose it is?

MR. FERRIER. I object to the question because it presumes that the advertisement mentions the mark Rogers and there is nothing about the mark Rogers in it.

THE COURT. He may answer.

A I know it; it is an advertisement of Heacock Company.

MR. BRIELL. (continues)

Q Besides the Manila Times which I have shown to you, have advertisements also been placed in other papers?

A That year?

Q From 1905 until the present writing?

A I suppose so, because we advertise in several newspapers, Spanish and Tagalog newspaper.

Q From the year 1905 until this date, while the Rogers tableware and other articles of silver, plated ware, and nickel with the trade-mark Rogers were being advertised, as you have stated here, what sum has the firm H. E. Heacock Company spent for this advertising approximately?

MR. FERRIER. I object to the question as being immaterial and irrelevant.

THE COURT. He may answer.

MR. FERRIER. Exception.

A I don't know how much was spent annually previous to 1909; since 1909, our appropriation for advertising and propaganda of the Rogers tableware and articles has been increased from two hundred pesos (P200) a month in 1909 to five hundred pesos (P500) a month at the present time.

MR. ENRILE. (Continues)

Q More or less, what has been the total amount spent for advertising the mark Rogers from 1909 until the present writing—more or less?

A That question is difficult to answer unless I make a general estimate.

Q Yes, give us an approximate estimate.

A About forty or fifty thousand pesos.

Q From 1909, when you were connected with the firm H. E. Heacock Company, until now, to what class of specific articles has the mark Rogers been applied?

A To all kinds of articles, toilet articles and hollow ware, silver-plated or nickel articles, and to all sorts of plated and nickel tableware.

MR. ENRILE. That is all.

MR. FERRIER. (Cross-questions).

Q Since when have you been connected with H. E. Heacock Company?

A Since 1909.

Q What is the total amount that H. E. Heacock Company spent for advertising in 1909?

A I don't know.

Q A while ago, how much did you say you spent?

A For tableware, for advertising Rogers articles.....

Q Who pays for that advertising, the manufacturer or H. E. Heacock Company?

A H. E. Heacock Company pays.

Q I notice that in these advertisements of H. E. Heacock Company which have been marked "A", "B", "C", and "D", the advertisement covers a variety of articles sold by you in your establishment. How do you segregate the expenses for advertising the Rogers articles from those for advertising the other articles that you sell in your establishment?

A We make an allotment of the expenses for advertising among the several articles that we advertise.

Q And that joint advertisement and the allotment of expenses are arbitrary?

A The allotment from the outset is arbitrary.

Q You have been requested by subpoena to bring some Rogers articles that you are selling. Have you brought them?

A They are here.

Q Will you produce them?

A Yes, sir. (Shows two boxes containing tableware.)

Q Where are your silver articles or samples of silver articles?

A The subpoena reads here: "Any article or object sold by Heacock and Company which bears the mark Rogers."

Q I show you a fork which I have taken from among the several articles that you have brought. Tell us in what part the word Rogers only appears as trademark?

A The mark is not alone, it is coupled with the words "Nickel-Silver"; but the word Rogers is there, which is our mark.

Q What is the trade-mark that you registered?

A Rogers.

Q Only?

A Yes, sir; Rogers.

Q Does the Heacock Company manufacture this

tableware or this fork which I have just shown you?

A No, sir.

Q By whom is it manufactured?

A By the International Silver Company.

Q Of the United States?

A Of the United States.

Q Do you know if the International Silver Company has any trade-mark registered in the United States?

A Yes, sir; it has.

Q Had they registered it there before you registered your trade-mark here in the Philippine Islands?

MR. ENRILE. I object to the question as immaterial. We shall not enter upon an investigation of all the marks of the International Silver Company of which there are very many.

THE COURT. He may answer.

MR. ENRILE. Exception.

A Yes, sir; half a century ago—over fifty years ago.

MR. FERRIER (Continues).

Q You said this word Rogers was used jointly with other symbols or words indicating the quality of the merchandise. Is it not true that the most famous mark that Rogers, made by the International Silver Company, has had, is known as Rogers, 1847?

A It is the article most extensively advertised as "Rogers 1847".

Q What quality does the figure 1847 indicate?

A It is the highest quality of the silver-plated articles manufactured by the International Silver Company.

Q Is it not true that it was in 1847 when they began to manufacture those articles?

A I don't know.

MR. FERRIER. I ask that this advertisement

be marked as exhibit "1".

THE COURT. Mark it.

MR. FERRIER. (continues)

Q I ask you whether or not this is an advertisement of your company, this exhibit "1"?

A Yes, sir.

Q Do you not state specifically in this advertisement that the year 1847 is a very lucky year because in that year 1847 Rogers Brothers Silver Plate was born?

MR. ENRILE. I object to the question because the witness is asked what appears in the paper.

THE COURT. He may answer.

A So it appears here.

MR. FERRIER (continues)

Q You did not know that when you answered my question a while ago?

A No, sir, I did not see what the newspaper says now.

Q Is it not true that your 1847 advertisement also plays the most prominent part in the advertising of these silver articles?

A In the 1847 Rogers Brothers advertisement, that part in particular.

Q And that is one of the trade-marks?

A It is one of the registered trade-marks.

Q That is one of the registered trade marks under which the International Silver Company manufactures and sells its articles?

A That is one of the trade-marks of the International Silver Company.

Q Is it a fact that each mark registered by the International Silver Company, the products of which the N. E. Hencock Company is selling, has in combination with the word Rogers some additional words or figures related with that word Rogers?

A Yes, sir.

Q You said that it was only at the close of the year 1927 that you learned that the silver nickel or plated tableware and articles with a trade-mark of which the word Rogers formed part were being sold in Manila. Are you sure of that?

A According to my best recollection, it was then when I first learned of it.

Q Do you know anything about the organization of the International Silver Company?

MR. ENRILE. I object because the question is not proper.

THE COURT. He may answer.

A I am not familiar with the history of Rogers Brothers.

MR. FERRIER (continues)

Q Did you know prior to the year 1927 that there was a company known as William A. Rogers Ltd.?

A Yes, sir; I knew.

Q Do you also know that this company was engaged in the manufacture of plated and nickel tableware and articles?

A Yes, sir.

Q And you also knew that they sold these articles using the name Rogers as part of their trade-mark?

MR. ENRILE. I object to the question unless it be specified to what reference is made, whether they were being sold in the Philippine Islands or in the United States or in Belgian Congo.

THE COURT. He may answer.

A Yes, sir.

MR. FERRIER. (continues)

Q Since how long ago do you know this?

A I couldn't tell you.

Q Is it not true that you knew this prior to the year 1927?

A Yes, sir.

Q Is it not true that you knew it in 1905?
A No, sir.
Q Did you know it in 1909?
A I don't know.
Q How long have you been in the jewelry business?
A Eighteen years.
Q Do you know if besides H. E. Heacock Company and the American Trading Company there are any other persons or firms in Manila who import the silverware or plated or nickel ware with the word Rogers as part of their trade-mark?
A What do you mean by "import"? Do you include in that persons who introduce articles of that kind in the Philippines ordered through the American Trading Company, or who are properly speaking distributors, or not, such as Levy & Blum, for instance?
Q No, nor do I mean by importers those who introduce the articles through the H. E. Heacock Company.
A Then I don't know anybody else now.
Q Do you not know whether or not F. Zuellig & Company have been importing these articles or merchandise for some time?
A I don't know.
Q Nor Wise & Company?
A Neither.
Q Nor Inhelder Walch Company Ltd., either?
A No, sir.

MR. FERRIER. That is all.

THE COURT. We shall continue the hearing of this case on the 7th of this month, at two in the afternoon.

I CERTIFY: That the foregoing is a true and correct transcript of the stenographic notes taken by me in the forenoon of August 30, 1928, at the first hearing of these cases.

(Sgd) SANTIAGO GUISANDI,
Official Stenographer.

Manila, P. I., September 7, 1928.

(FORENOON SESSION) (CONT. OF THE HEARING)

There being present the same parties and their respective counsel before the Hon. C. A. Imperial, presiding Judge of the session, the hearing of these cases was continued.

SAMUEL F. GACHES continues testifying under the oath taken by him in due form; his personal circumstances appear in the record. (Interpreted by A. Zulueta)

MR. FERRIER. With the leave of the Court, I shall ask Mr. Gaches a few more questions.

THE COURT. Go on.

MR. FERRIER. (con. of cross-examination).

Q Mr. Gaches, the merchandise which you advertised according to those advertisements exhibits "A", "B", "C", and "D", in the year 1905, by whom was that merchandise manufactured?

A By the International Silver Company.

Q In the United States?

A In the United States.

Q And the merchandise which you are selling now and which according to you is Rogers ware, is manufactured by the same factory?

A Yes, sir.

Q Do you know whether or not that company has registered its trade-mark in the United States?

MR. ENRILE. I object to the question as immaterial.

THE COURT. He may answer.

MR. ENRILE. Exception.

A It has.

MR. FERRIER (continues)

Q And that mark they have registered in the United States with the word Rogers only, or is there any symbol or sign besides?

MR. ENRILE. The same objection; it is immaterial.

THE COURT. The same decision.

MR. ENRILE. Exception.

A It is registered with other symbols.

MR. FERRIER (continues).

Q Is it not true that the word Rogers is a family name?

A I believe so, I presume so.

Q Don't you know it?

A I don't know anything about that.

Q Don't you know anybody by the family name of Rogers?

A Yes, sir; that is another thing.

Q Has the H. E. Heacock Company relations with any other person by the name of Rogers?

A No, sir.

Q The H. E. Heacock Company is the only firm representing the International Silver Company here in the Philippine Islands?

A With the exception of one mark which is not Rogers.

Q If the International Silver Company should take the representation away from the H. E. Heacock Company, would your company insist upon making its mark Rogers prevail against the International Silver Company?

MR. ENRILE. I object to the question for two reasons: in the first place, because the opinion of the witness is requested, and in the second place, because the question is a hypothetical one and it has not been established that the basic facts of the hypothesis are correct.

THE COURT. He may answer the question.

MR. ENRILE. Exception.

A Since the International Silver Company knew

of and consented previously to the registration of that trade-mark, we would probably consider it necessary to leave that mark to them.

MR FERRIER. (continues)

Q What proof have you that the International Silver Company knew that you registered that mark, and that it consented to your registering the same?

A They have full knowledge of what is going on now and of the existence of this suit.

Q How did they get that information?

A We advised them of the particular.

Q Has there been an answer?

A Yes, sir.

Q I would like to have you exhibit that answer in which they permitted you to register that mark. Can you produce it?

A I have not the papers with me now.

Q Have you the papers in the office of H. E. Heacock Company?

A I have papers which show that they know of these cases that are being heard now.

Q Have you the papers in which they state that they consent to your having that mark registered?

A They had knowledge of it, and I believe that all the papers relating to that matter were destroyed in the fire of 1924.

Q Is it not a fact, Mr. Gaches, that your papers on that particular were not destroyed in that fire?

A It is a fact that they were destroyed.

Q Has H. E. Heacock Company sold one article marked only Rogers, without any symbol whatever?

A All the silver or plated tableware bears the word Rogers with other symbols or words, as for instance "Rogers Brothers 1847" and "William H. Rogers Sons 1847."

Q Mr. Gaches, please examine these advertisements which have been marked exhibits "2" and "3", the first being an advertisement which appears in the Saturday Evening Post of July 29, 1922, and the other one which appears in the same paper of August 18, 1928, and tell us whether or not these are advertisements of the objects or articles which you sell or which H. E. Heacock Company sells, and which according to you are of the same make "Rogers."

A These exhibits are advertisements of the International Silver Company and are the same articles which I am selling here in the Philippines with the mark "1847 Rogers Brothers."

Q And you allege that the articles appearing in these advertisements are the articles which you have registered and which you are selling under the mark "Rogers" registered by you?

A Yes, sir.

Q Has the H. E. Heacock Company manufactured any silver article bearing the mark Rogers?

A No, sir, it has not manufactured any.

MR. FERRIER. That is all.

Mr. ENRILE (Re-direct)

Q You said that the International Silver Company knew that the H. E. Heacock Company had registered or was going to register the mark Rogers in the Philippines. Having this knowledge, has the International Silver Company ever protested or objected to the registration of the mark Rogers by the H. E. Heacock Company in the Philippines?

A No, sir, on the contrary, they knew it and did not protest.

Q You said, when you testified the other day, that you know that H. E. Heacock Company knew that [illegible] Rogers Ltd. were selling or importing their articles in the Philippines.

Since when does H. E. Heacock Company know that?

A I don't know about H. E. Heacock Company but I did not know it until last year.

Q The articles with the mark Rogers which the firm Heacock is selling in the Philippines are exactly the same articles which the International Silver Company is selling under its trade-marks in the United States, as regards weight, size, etc., are the same articles which the International Silver Company of the United States is selling?

A Yes, sir.

Q They are of the same size as those sold by the H. E. Heacock Company?

A The sets are different, for instance, different in proportion; but the articles are the same as those manufactured in the United States.

Q The size of the tableware manufactured by the International Silver Company which the H. E. Heacock Company sells is like the size of that sold by the International Silver Company in the United States?

A Yes, sir.

Q The size of the spoons and forks with the mark Rogers, sold by the H. E. Heacock Company, is equal to the size of the spoons and forks manufactured by the International Silver Company which are sent here from the United States? Or better, are the spoons and forks of a size expressly manufactured for Heacock Company, or of the same size manufactured in the United States?

A They make the same in the United States for the dealers there; but the sizes that we use in the sets are also very acceptable to the people in the Philippines.

Q What I wish to ask is whether the size used by the H. E. Heacock Company is a size expressly manufactured for Heacock, or whether

it is the same size manufactured and generally used in the United States?

MR. FERRIER. In view of the fact that the witness has already testified that what is sold there and what is sold here are manufactured alike, I object to the question; moreover, it is a leading question.

THE COURT. He may answer.

A The articles they send here making up a set are equal to the articles which are sold in the United States; but the sets are made up so that the set of twenty-six pieces, which is an ordinary set, pleases the Filipinos; the set of fifty-one pieces, however, is a set made expressly for us.

MR. ENRILE (continues)

Q In selling these articles manufactured by the International Silver Company in the Philippines, has the firm H. E. Heacock Company been selling them under the trade-marks of the International Silver Company or under the trade-mark of the firm H. E. Heacock Company?

MR. FERRIER. There is no doubt about that; if these goods bear the registered trade-mark of the International Silver Company, they are also sold under that trade-mark; they cannot be sold otherwise.

THE COURT. He may answer.

A They are sold under the symbol Rogers, which is the name we have been advertising for nearly twenty-three years in connection with nickel or plated tableware and which is so well known throughout the Philippines as articles sold by H. E. Heacock.

MR. ENRILE (continues).

Q How has the public acquired that knowledge that the word Rogers on these articles is a symbol indicating precisely that the products come for the firm H. E. Heacock Company?

A By the extensive publicity and advertising of those articles.

Q When the H. E. Heacock Company sells these articles marked with the words Rogers and other words or symbols, what guaranty does it give to the public, if any, or what does the word Rogers mean to the public, as regards the quality of the articles sold?

MR. FERRIER. I object to the question because the witness is not competent to say what meaning an advertisement can have to the public.

THE COURT. He may answer.

MR. FERRIER. Exception.

A Of course, the public has confidence in this trade-mark, or in this name as a trade-mark, because of the guaranty represented by the firm Heacock which has been selling these goods all this time in this country.

MR. ENRILE. That is all.

MR. FERRIER.

Q That is an opinion of yours?

A It is not an opinion; it is a fact.

Q How did you come to know what the public is thinking?

A Because the public, when it gives an order, orders Rogers ware or articles.

Q Is it not true that sometimes articles are ordered from you which you have not advertised?

A Very seldom.

Q You do not know how many orders of that kind of merchandise have been given on account of the advertisements of the International Silver Company, not as a result of the advertising or publicity by the H. E. Heacock Company?

A The United States magazines have never had extensive circulation in the Philippines and the advertisements appearing in the newspapers and publications of the United States do not reach the consuming public or the mass of

the consuming public in the Philippine Islands like the advertisements published in the local press.

Q Is it not true that the Saturday Evening Post, of which exhibits "2" and "3" are specimens, is a periodical more widely circulated in the United States than any periodical or publication published in the Philippine Islands?

MR. ENRILE. I object to the question because the witness is apparently incompetent.

THE COURT. He may answer.

A I don't know.

MR. FERRIER (continues).

Q Do you know what is the circulation of the Saturday Evening Post in the Philippines?

A It has not a circulation of ten thousand.

Q Are you quite sure of that?

A The last statistics I saw gave it much less than that.

Q Of what year were those statistics you saw last?

A As I recollect, of the year 1925.

Q And you have no idea of the increase there has been in the last three years?

A No, sir.

Q What publication is there in the Philippines with a circulation of ten thousand?

A But, what do you want me to say? The Liwayway, the Graphic, and the Free Press, there are already three. If you wish to know it exactly, Liwayway has a weekly circulation of sixty thousand, of forty to fifty thousand weekly, and Free Press of thirteen to fifteen thousand copies weekly. You can call them up by telephone and find out.

MR. FERRIER. Nothing more.

MR. ENRILE.

Q You being the representative of the International Silver Company or the distributor of the International Silver Company in the Philip-

pines, do you know whether the International Silver Company has ever advertised its products with its trade-marks in any publication in the Philippine Islands?

A Not that I know of.

MR. ENRILE. That is all.

MR. FERRIER.

Q But the H. E. Heacock Company has done the advertising for them?

A No, sir; the H. E. Heacock Company has advertised the Rogers brand at its own expense.

Q I did not ask you who paid for the advertisements; I ask you whether the H. E. Heacock Company has not been advertising the trade-mark of the International Silver Company in the Philippines?

A Yes, sir.

MR. FERRIER. That is all.

. . . . . .

MANUEL COUTO, 29 years of age, single, merchandise broker, a resident of Manila, P. I., who, after being duly sworn, testified as follows:

BY MR. ENRILE (Direct examination).

Q Where is your office?

A In the Cosmopolitan Building, No. 1518.

Q Are you in business for yourself or are you a member of any association or company?

A I am a member of the partnership Couto Hermanos.

Q Is that partnership Couto Hermanos the successor of any other partnership?

A Yes, sir, of M. Couto e Hijos.

Q When was the partnership M. Couto e Hijos established?

A In 1914, when my father established the business.

Q Since when have you been engaged in the business of merchandise broker?

A Since 1918.

Q As merchandise broker, to what parts of the Philippines have you gone in the pursuit of your business?

A With the exception of the provinces bordering on Manila, the whole Philippines, from North to South and East to West.

Q What provinces are those through which you have not traveled?

A Tayabas, Bulacan, Pangasinan, the whole island of Luzon.

Q During that time, have you had dealings with wholesale or retail merchants in all the provinces of the Philippines, with the exception of those bordering on Manila?

A Yes, sir.

Q During that time, from 1918 until now, have you become acquainted with the trade-mark Rogers?

A Yes, sir.

Q In connection with what articles?

A Plated tableware and articles.

Q According to your knowledge, what meaning, if any, has the word Rogers in connection with plated tableware in the Philippine market, in the several parts of the Archipelago where you have followed your occupation of merchandise broker?

A When one says Rogers, it is understood to be from Heacock and it is so sold. A dealer ordering Heacock articles says "Bring me Heacock articles", because he knows that it is Rogers.

Q In the provinces of the Archipelago where you have been since 1918, have the Rogers goods or the word Rogers ever been known or spoken of in connection with tableware, toilet articles or plated or nickel ware without referring to the firm Heacock?

MR. FERRIER. I object to the question.....

THE COURT. He may answer.

A Yes; they referred to the Heacock tableware.

MR. ENRILE. (continues)

Q Have you ever known or has there ever been known in the provinces among the dealers, wholesale or retail, any Rogers tableware other than that sold by the firm Heacock?

A Only quite recently it was known that the firm Levy & Blum is selling much cheaper articles.

Q When was that?

A At the close of 1927.

Q And was any Rogers tableware other than Heacock's known in the provinces before that of Levy & Blum?

A Before Levy & Blum's, only that of Heacock was known.

MR. ENRILE. That is all.

MR. FERRIER. (Cross-examination)

Q Are you engaged in selling merchandise of H. E. Heacock Company?

A Yes, sir; I am a commission man of the firm Heacock.

Q And the only complaint you have is that Levy & Blum sell this class of merchandise at a lower price than Heacock?

A When there is demand for a mark as there was for the mark Rogers, and there is another who offers goods with the same mark or the same name that are cheaper, a dealer prefers the cheaper goods.

Q And the reason why you have complained is that Levy & Blum sold these same goods cheaper than the H. E. Heacock Company?

MR. ENRILE. I object to the question because it presumes a fact that is not established.

THE COURT. He may answer.

A I do not complain; it is the dealer who refuses to buy.

MR. FERRIER. (Continues)

Q Did you not complain of Heacock because you were unable to sell the goods?

A Heacock was astonished that while formerly they sold much tableware, there were so few sales lately, and I had to tell them the reason why so little was sold.

Q Why, don't you know that when there is competition in merchandise of the same class, it happens that some sell goods of the same class cheaper than others?

A Yes, sir, if the brand is not exclusive, of course.

Q When did you become an expert in marks?

MR. ENRILE. I object to the question because the witness did not say that he was an expert in trademarks, nor does he claim to be one.

THE COURT. He may answer.

A It is the experience I have, because I am selling other goods; I also import goods.

MR. FERRIER. (Continues)

Q And on one occasion you met other persons who were selling the same goods cheaper than you were?

A And dearer, to.

MR. FERRIER. That is all.

MR. ENRILE. (Re-direct)

Q You say you are selling on commission for the H. E. Heacock Company; besides selling on commission for the H. E. Heacock Company, you have been and now are selling goods of other firms?

A Yes, sir; I represent eighteen commercial firms.

Q Besides importing goods on your own account?

A Yes, sir.

Q You said that lately your sales of Rogers tablewares which bear the word "Rogers," of Heacock, have decreased. Can you tell the reason why?

A Because there were cheaper offers.

Q By whom?

A By the firm Levy & Blum.
Q Of what kind of table-ware?
A Nickle-Silver.
Q Of what trade-mark, if there was any?
A Rogers.
Q When you say "Rogers", do you mean of William A. Rogers Ltd.?
MR. FERRIER. One moment, will you tell the witness what you wish him to answer?
THE COURT. Amend the question.
MR. ENRILE. (Continues)
Q When you say "Rogers", speaking of the table-ware sold by the firm Levy & Blum, do you mean to say that that table-ware is marked only with the word "Rogers" or what mark does it bear?
A It bears letters or signs.
Q And you, as commission salesman of the firm Heacock, were unable to convince the dealers that that table-ware sold by the firm Levy & Blum is not the table-ware of Heacock?
A No, sir, because they do not pay attention to the initials, they pay attention to the word Rogers.
MR. ENRILE. That is all.
MR. FERRIER.
Q And is it not true that the goods that you are selling for the firm Heacock bear other initials or symbols in addition to the word Rogers?
A Yes, sir.
MR. FERRIER. That is all.

SANTIAGO VARELA, 47 years of age, married, a merchant, optician, and watchmaker, No. 84 Calle Rosario, Binondo, Manila, P. I., who, being duly sworn, testified as follows:
BY MR. ENRILE (Direct exam.)
Q Since when are you a merchant?
A Since the close of 1918 or 1919, I mean, since

the beginning of the year 1919, I am a merchant, not a clerk, a merchant.

Q Where is your establishment?

A At the beginning of 1919, on Calle Azcarraga, corner of Benavides, I don't remember the number; a year later we removed to 85-87 Calle Rosario, our partnership being Bernardo & Varela; five years after that we dissolved the partnership and I removed to No. 84 on my own venture.

Q Since when have you been in business for yourself alone?

A Since January 1926.

Q On Calle Rosario?

A At 84 Calle Rosario.

Q Have you your establishment there?

A Yes, sir, still now.

Q In what business have you been engaged in those several places since 1918 and up to the present writing?

A Exclusively in jewelry, optical goods, and watches.

Q In that jewelry, optical, and watch business, have you from 1918 until the present writing been selling silver plated or nickel goods, such as table-ware?

A Yes, sir.

Q Do you know the trade-mark or the articles or table-ware known as Rogers which are being sold in the market?

A Yes, sir.

Q Since when have you known those articles?

A Since a long time ago, before we opened our store.

Q And is that mark known by the public as "Rogers" as regards table-ware, or is it not?

A What I can say with reference to the mark Rogers is that when I was still in Tacloban and Leyte, from 1906 to 1914, th

was already much mentioned. A proof of it is that what we were using at our home in Leyte was Rogers ware which we had bought at the store of a Turk at Tacloban and which bore the mark Rogers.

Q But since you are in business, from 1918 to the present date, with reference to that mark Rogers or the name Rogers in relation to silver-plated or nickel table-ware, to what articles was it generally applied in business in this city, to goods from whom, if you know?

A Of the mark Rogers, referring to the store I have?

Q Yes.

A There are many who are selling Rogers ware, but it was probably since those times when the firm Heacock established agencies.

Q When Rogers table-ware and other goods are spoken of in business or between buyer and seller, to what articles does the public generally refer?

A Speaking of table-ware and of table silver or sets, the majority of the consumers prefer the mark Rogers to any other mark.

Q Do you know to what goods the public and the dealers refer when they speak of Rogers table-ware, as regards the place where it comes from?

A Well, they refer to the mark Rogers which the firm Heacock used to sell.

Q And now?

A Now I could not tell you with certainty, because we are getting our table-ware of the Rogers mark from another firm; only the people always used to ask for the Rogers table-ware by the number in Heacock's catalog and the name in the catalog, that is, Rogers ware, nickel-silver, number 37, or something like that, and there was no such de
very different from what i

William A. Rogers Ltd.

Q So that in your business you receive orders of Rogers table-ware from the provinces which orders refer to numbers in the catalog of the firm Rogers?

A Sometimes.

Q Does this happen often?

A Not often; but it happens sometimes, because most of those who know us merely say, send goods with the mark Rogers.

Q There has also been the practice of merely ordering table-ware with the name Rogers?

A Since a long time ago, since I was manager of the firm Bernardo & Varela, beginning with the year 1920.

Q And when the purchasers asked merely for tableware by the name Rogers, did you know to what goods they referred?

A To the trade-mark Rogers which is well known, in the beginning, when we ordered the other brand, that is, the trade-mark William A. Rogers, of another factory, which we got from the American Trading Company; in the beginning the majority of the buyers asked for table-ware of the firm Heacock; that is what they always want to buy.

Q Answer my question. I ask you if when you received orders for table-ware and they did not say that they were orders for Rogers ware, did you know to what goods those orders referred?

MR. FERRIER. I object to the question because it assumes a thing that has not been established, as there is at present no evidence of orders having been received with only the name Rogers.

THE COURT. He may answer:

A Sometimes they refer to table-ware of the firm Heacock.

MR. ENRILE. (Continues)

Q And at other times?

A And at other times only with the name Rogers without mentioning them as table-ware of the firm Heacock.

Q Since when do you know the Rogers table-ware manufactured by William A. Rogers Ltd.?

A Since 1927, beginning with the order from the American Trading Company.

Q Beginning with before 1923, you received many orders for tableware in which the buyer merely asked you to send Rogers ware?

A Yes, sir.

Q I ask whether you did or did not receive orders prior to 1923 in which the buyer merely asked you to send him Rogers tableware?

A Yes, sir, we received orders long before that.

Q And when you received those orders in which the buyer asked you for table-ware of the mark Rogers in those years before 1923, did you know to what goods those orders referred?

A They referred to Rogers table-ware from the firm Heacock.

Q Could they not have referred to Rogers table-ware from some other firm than Heacock?

A No, because at that time there was no firm selling Rogers ware other than the firm Heacock.

Q And you said that since 1923 you have been receiving orders mentioning only the word Rogers and mentioning the corresponding number of Heacock's catalog?

A Well, I do not remember very well if before or after, but the majority of the orders that arrived were that way, because they always prefer the mark Rogers, because the catalog of the firm Heacock is much in circulation in the provinces and they take from it the number and pattern of the Rogers nickel-silver-ware which appears in the catalog of the firm

Heacock, and that is how they ordered the Rogers ware.

Q Mentioning the catalog of the firm Heacock?

A Yes, sir, and as the pattern and the record, which I don't remember, of the firm Heacock are similar, especially the pattern, I send it and they pass it.

Q And from whom are the goods which you sent to persons asking you for Rogers table ware, specifiying the number in the catalog of the firm Heacock?

A Those are orders placed by them directly through the American Trading Company, that is, through Mr. Presby.

Q You regularly order table ware from the American Trading Company?

A Yes, sir; I still have an order twelve inches long payment of which to the Bank is going to be due this month, which I have received through the American Trading Company.

Q Have you ever advertised the Rogers tableware which the American Trading Company has been selling you, by advertisements and newspapers and magazines?

A When I was still with the old partnership of Bernardo & Varela, beginning with the year 1921, until 1925, we made catalogs and sent orders to the American Trading Company which furnished us the cuts, and now there is a small circular because we cannot spend much for advertising.

Q Who paid the expense of printing those catalogs, the American Trading Company?

A No, sir, Bernardo & Varela; but they furnished the cuts.

Q Were those William A. Rogers sets of tableware which were sold to you or to Bernardo & Varela by the American Trading Company and for which cuts were furnished by the American Trading Company, in the catalog?

A Yes, sir.

Q During the time when you were connected with Bernardo & Varela, and since you have been in business for yourself, have you received Rogers table ware with catalogs, mentioning the corresponding number?

A Yes, sir, sometimes, and at others also the catalog of the firm Heacock.

Q And in all those cases you furnished goods of William A. Rogers Ltd.?

A Yes, sir, because we have not the table-ware which the firm Heacock gets from Rogers.

Q When you published those catalogs of Bernardo & Varela in which you advertised table ware imported by the American Trading Company, for which purpose you used the cuts furnished by the American Trading Company, was it specified in those catalogs that that table ware was not the same sold by the firm Heacock?

A We put nothing there representing it to be the same; we only advertised the name Rogers.

Q When did you first buy goods or table-ware from the American Trading Company?

A I recollect that we were the first dealers in Manila who ordered direct through the American Trading Company, because at that time, during the first days we always bought from the firm Heacock; but as we found an agent who would furnish them at a lower price it was enough for us that it was the mark Rogers and we bought it, because we know that one can do good business with the Rogers ware.

Q How did you know before you bought those goods sold by the American Trading Co. that you would be able to do good business with the name or mark Rogers?

A Yes, sir, because that name is well known in the Philippine Islands; it is known by every-

body who is using table-ware; they all know what the Rogers ware is.

Q If instead of bearing the mark William A. Rogers, the table ware of the American Trading Company bore the mark W. Smith, would you have purchased the mark Rogers from the H. E. Heacock Co.?

A No, sir, because we know the patterns sold by the firm Heacock and we can find this mark in competition with the firm Heacock.

Q Since 1923, when Bernardo & Varela, of which firm you were a member, began to get table-ware from the American Trading Company, have you been selling, or has Bernardo & Varela been selling since then goods from the firm Heacock, or did you quit buying from the firm Heacock?

A In the beginning, in order not to show the firm Heacock that we were trading with another firm, we ordered little at a time; but I did this as manager in order not to have any disagreement with the firm Heacock; but subsequently we quit the firm Heacock completely and traded with the American Trading Company.

Q And you continued just the same selling and filling orders that you received with Heacock's catalog numbers?

A Yes, sir; I do this sometimes, using Heacock's catalogs.

Q When did you cease entirely buying table-ware from Heacock?

A Towards the end of the year 1923, I believe, or at the beginning of 1924.

MR. ENRILE. That is all.

MR. FERRIER. (Cross-examination).

Q Were the catalogs published by you published under your own name?

A Under the name of the firm Bernardo & Varela.

Q And in these catalogs there appeared designs of the goods sold by you?

A Yes, sir.

Q And the persons ordering goods from you from the provinces sent those orders in accordance with your catalogs?

A Sometimes.

Q Mr. Varela, can you examine this exhibit "4" and tell us whether or not it is equal to the goods which you sell, ordered from the American Trading Company?

A The design as it is here we have; but there are two classes of this, "silver-plated", which is marked Cross W. R., which means silver-plated, meaning that it is plated on a nickel-silver base, then there is another class of the same pattern which is marked William A. Rogers Nickel-Silver, which is called "solid nickel-silver," and therefore I cannot tell, as the pattern is; but here appears W. R., which is different from what we receive; but the pattern is the same.

Q Do you remember what was the mark of the goods that you received from the American Trading Company?

A Yes, sir; I remember especially the sets of twenty-six pieces and those of fifty-one pieces. The Rogers nickel-silver table-ware is number 088, which is called "Windsor", number 044 which is called "Tipped", number 045, number 056, number 058; all these numbers are of the mark William A. Rogers nickel-silver. In the other items there is number 1881 Rogers which is what we call "plata-Rogers" (Rogers silver) and other silverware for presents, as for example table sets, etc.—I can not mention all because there are various articles.

Q Please examine these two spoons which have been marked as exhibits "5" and "6" and tell

us whether or not you have received through the American Trading Company any merchandise bearing the same mark as these spoons?

A Well, not that, that is to say, the quality, yes, sir; we have frequently received those of Rogers silver, as we call it; now, the pattern is different from the one that we are receiving.

Q But I am asking you only about the marks; have you received any mark that appears here on the back of this table-ware?

A Yes, sir, "1881 Rogers all".

MR. FERRIER., The witness refers to exhibit "6".

Q (continued) And this other exhibit, "5", have you received any goods through the American Trading Company bearing this mark, William A. Rogers?

A Yes, sir; we have received "William A. Rogers S X R."

Q Is it not true that the order you gave was direct to William A. Rogers Ltd., through the American Trading Company?

A Yes, sir.

Q And that William A. Rogers has been sending the goods to you direct?

A Yes, sir; but on one occasion the American Trading Company had some in stock which had been ordered by a firm the name of which I cannot mention but which was unable to pay at the Bank, and then the American Trading Company got it from the Bank and sold it to us.

Q But with that sole exception, you always order direct from the factory in the United States, through the American Trading Company?

A Yes, sir.

Q And the goods come direct to you from America?

A Yes, sir.

Q And the factory in America likewise collects the price of the orders direct from you?

A Yes, sir, through the bank.

Q Have you had any correspondence with William A. Rogers Ltd., before you placed orders with them through the American Trading Company?

A No, sir, only when we ordered through the American Trading Company.

MR. FERRIER. That is all.

MR. ENRILE. (Re-direct).

Q Whenever you placed an order, from the beginning until now, to whom did you address it, to the American Trading Company or to William A. Rogers Ltd.?

A To the American Trading Company, because they have catalogs for purchases and I am exclusive salesman on commission or agent of the Rogers factory.

Q When you were still a partner of the firm Bernardo & Varela and were acting as its manager, from whom came the offer as regards the purchase of those goods, who made you that offer, what firm?

A The American Trading Company.

Q Who of the American Trading Company made you that offer?

A I believe it was Mr. Naftaly, one of Mr. Presby's partners.

Q And what did Mr. Naftaly tell you on behalf of the firm with reference to this table-ware which he was trying to sell you?

A He said: "This is your chance, because you know that the Rogers Trade-mark is famous and you can do good business."

Q Did Mr. Naftaly tell you, on behalf of the American Trading Company, that that table-ware was not of the same mark as that sold by Heacock?

A No, sir; they represent as agents only; there

was the sample in the catalog and they order through them.

Q Do you know any official of William A. Rogers Ltd.?

A No, sir. I am from Batangas and have not been here in Manila very long, and I have never been in America.

Q These articles which have been shown to you, which are marked as exhibits "4", "5", and "6", these, exactly, are the same goods, with the same trade-mark and these same designs; do you know if they have ever been sold in this city?

A To what number do you refer, to number "5" or exhibit "5"?

Q To all; do you know if these same goods with these same trade-marks and these same designs have been sold?

A Yes, sir. All these, with the same mark as these three samples (indicating the mark on the back of each article) have passed through my hands.

Q In these exhibits "5" and "6", these symbols appearing there in addition to the words "William A. Rogers" in exhibit "5", and in addition to the word "Rogers" only in exhibit "6", do you know what these symbols mean?

A Their meaning, I understand, is with reference to the quantity of silver with which the white metal that is inside is coated. The meaning of "S X R" is that there is a double coat of silver, or that it has been silver-plated twice, and it seems that number 1881 has three coats. That is what this means.

Q Who has explained this meaning to you?

A The catalog sent by William A. Rogers of Niagara Falls, and also the agent who showed me this and taught me the meaning.

Q Whose agent?

A Of the William A. Rogers factory, that is, the American Trading Company.

Q When the buyers came to Bernardo & Varela's establishment while you were connected with that establishment, and now in that establishment of yours, in purchasing table-ware, do the buyers pay attention to all the words and all the marks appearing on the table-ware, or only to the word Rogers?

A As a rule, the majority of the buyers, upon entering, ask for Rogers table-ware; of one hundred buyers, barely seven or ten ask for any other make; they ask for nothing but Rogers, always the trade-mark Rogers.

Q And do the people make a distinction as to whether it is Rogers Brothers or William A. Rogers Ltd.?

A No, sir, the people only notice "Rogers."

MR. ENRILE. That is all.

MR. FERRIER.

Q In your store, the trade-mark Rogers indicates goods manufactured by William A. Rogers Ltd?

A Yes, sir; lately, but in the beginning it was Rogers of the firm Heacock.

MR. FERRIER. That is all.

.....

JOSE M.a TUPAS, 42 years of age, widower, silversmith and jeweler, residing at 1420 Calle Herran, Paco, Manila, who, having been sworn according to law, testified as follows:

BY MR. ENRILE. (Direct examination.)

Q In what business are you engaged?

A In the jewelry business; I have a silversmith and watch store.

Q Since when have you been in that business?

A Since 1915.

Q And what were you doing before that?

A I was agent for the firm Lanza.

Q Since when?

A Since 1910, 1911, until 1914.

Q What was the business of the firm Lanza of which you were the agent?

A Many articles, because we were selling those articles.

Q But did you sell groceries, for instance?

A No, sir, jewelry and other kinds of merchandise.

Q Since 1915 you have been dealing on your own account in jewelry, silverware, and watches?

A Yes, sir.

Q Do you know the table-ware which the firm Heacock is selling and has been selling for some time past?

A Yes, sir.

Q By what name has that table-ware sold by the firm Heacock always been known?

A Rogers.

Q Is it known by any other name or symbol or any other word?

A "Rogers".

Q Nothing more than Rogers?

A Yes, sir.

Q By the public as well as by the dealers?

A Yes, sir.

Q Since when do you know the table-ware that the firm Heacock is selling?

A Since 1911, when I was still an employee of Mr. Lasa, [Lanza] No. 97 Calle Rosario.

Q Has there ever been, from then until now, any table-ware other than Heacock's known in the market, by the public as well as by the dealers, by the name Rogers?

A What I can say is, that from the time that I was an agent until now, I have understood that the sole importer of the Rogers table-ware is the firm Heacock, according to what I understand.

Q But have you learned at any time of their be-

ing any other Rogers table-ware in the market outside of Heacock's?

A Yes, sir; I am astonished now because they say in the provinces that the other Rogers ware is cheaper and that Heacock's Rogers is dear.

Q Since when have you been receiving those complaints from the provinces?

A Since 1927 they have been complaining in Ilocos, because they say: "Those Rogers are cheaper than those you sell."

Q Have you been selling any Rogers of a make not Heacock's?

A I formerly sold from the firm Salting, because Mr. Salting said: "Mr. Tupas, see if you can sell this Rogers table-ware; it is of good quality, of the trade-mark Rogers." I then said: "Why, can I sell that though it is not from the firm Heacock?" He said: "Yes, but it is good quality, it is from Rogers."

Q What mark did you see besides Rogers?

A Only Rogers.

Q But are those goods marked Rogers which the firm Salting is selling of good quality?

A They seem to be of good quality, because the people come to my place and ask: "Have you that Rogers table-ware?", and I show it to them.

Q But do you know, in view of your personal knowledge and your experience with regard to table-ware, that the cheap table-ware which you have been selling recently for the firm Salting is the same that comes from the firm Heacock or that the firm Heacock has been selling?

A All I can say is that my experience has been about the same, nothing more than that I have purchased from Mr. Salting because it was cheaper than Heacock's Rogers; but I

cannot tell you what amount, nothing but spoons.

Q But, do you know if that is the same Rogers ware that Heacock is selling, or other ware?

A Apparently it is the same; only it says Rogers; but I cannot say anything else; I buy it because it is cheap.

Q Did Mr. Salting tell you from what firm he got it?

A Nothing more than that he had cheap Rogers ware.

Q Did he tell you that he had Rogers ware like the Rogers ware of the firm Heacock?

A Yes, sir.

Q But cheaper than that of the firm Heacock?

A Yes, sir, and that I would have a chance to sell because it was cheaper.

Q And how did you sell that table-ware to the public?

A As Rogers ware.

Q Did you advise the public whether or not it was Rogers ware of the firm Heacock?

A No, sir, because if you say that, they are not going to buy from you but will go direct to Heacock's; they only ask: "Have you any Rogers table-ware?", and I say yes, I have some here.

Q When was it that you bought that table-ware from Salting?

A The first time I bought some in February this year and the second time a few weeks ago.

Q How many weeks ago?

A I am sure it was last month.

MR. ENRILE. That is all.

MR. FERRIER. (Cross-examination).

Q You have recently bought nickel-silver table-ware from Heacock?

A Yes, sir.

Q Recently?

A Since last December.

Q 26-piece sets?

A 26 and 51 piece sets.

Q Do you remember how much you paid for a set of 26 pieces?

A I don't remember the set, but I have invoices.

Q Do you remember, more or less?

A Excuse me, but being so busy I don't recollect; but I have the invoices there and can find out the price by looking at the invoices.

Q Have you seen any goods of the H. E. Heacock Company marked with only the word "Rogers" as trade-mark, without any other word or symbol besides the word "Rogers" alone?

A Yes, sir.

Q When?

A Years ago.

Q I don't think you have understood the question very well. Please examine this exhibit "6" in which there appears "1881", a symbol "Rogers", another symbol "A-1", and you can see there the word "Rogers" together with other numbers and symbols. I now ask you whether you have seen any merchandise coming from Heacock on which the word "Rogers" appears without any other symbol or number?

A Do you know that because I am a merchant, I have confidence in the firm Heacock. One asks: "Give me Rogers of the best class," but he does not bother to look at the number it has; he merely says: "Give me first—or second-class Rogers; when he sees the mark "Rogers", he sees the mark "Rogers" and nothing else; but he cannot tell you anything else.

Q You cannot say, either, what trade-mark there is on the merchandise?

A No, sir, nothing more than "Give me first class or second class."

MR. FERRIER. That is all.

THE COURT. The hearing of this case will be

continued on October 3rd, at half past eight in the morning.

MR. ENRILE. We would like to know from Mr. Ferrier whether he needs Mr. Gaches as a witness, as he has just told me personally, because Mr. Gaches is going to leave for Japan.

MR. FERRIER. It matters little to me that he is leaving for Japan, provided some one from the firm Heacock brings the samples here which have been requested and which Mr. Gaches has promised to bring when they are needed.

I CERTIFY: that the foregoing is a true and correct transcript of the stenographic notes taken by me on September 7, 1928, during the continuation of the hearing of this case.

(Sgd) SANTIAGO GUISANDI,
Official Stenographer.

Manila, P. I., October 3, 1928.

(Forenoon Session) (Continuation of Hearing)

The same parties and their respective counsels being present before the Hon. C. A. Imperial, the presiding Judge, the hearing of this case was continued.

MR. ENRILE. Your Honor, I have found a few errors in the transcript of the stenographic notes of the last session with reference to these cases; but instead of requesting that the same be corrected, I shall now call back the witness Santiago Varela in order that he may make these corrections on page 22, in a question asked by me, as follows:

"Q. So that in your business you receive

orders for Rogers table-ware which orders refer to numbers in the catalog of the firm Rogers?".

I did not say that; I said: "refer to numbers of Rogers of the firm Heacock." And on page 23 there is another similar error, the words "Rogers of the firm Heacock" being omitted, and so on.

MR. FERRIER. I object to the introduction of such evidence because the witness may have said it or he may not have said it. However, we have no objection to the correction being made on page 22, because I believe it makes no difference whether the witness said "Rogers" or "Heacock".

THE COURT. Propose the amendments and we shall see.

MR. ENRILE. On page 23, line 12, between the words "for" and "table-ware", the word "Rogers" should be inserted; and in the next line, the word "Rogers" should be replaced by "Heacock".

MR. FERRIER. I do not agree to this, because I believe that the question appears in the transcript as it is. If you want to add the word "Rogers" there, I have no objection.

MR. ENRILE. Then I am going to recall the witness.

MR. FERRIER. The former question and the answer to it plainly show that it should not be changed in the manner requested by Mr. Enrile.

THE COURT. Call the witness.

* * *

SANTIAGO VARELA was called back to continue testifying under the oath previously taken by him according to law; his personal data appear in the record.

BY MR, ENRILE (direct examination).

Q When you were testifying here previously, you said that you sometimes received orders for Rogers table-ware. Did you say that?

A Yes, sir.

Q When you received orders for Rogers table-ware without the order specifying that goods from the firm Heacock or any other firm were requested, did you know to what articles they referred?

A The Rogers mark.

Q Do you understand my question right? When there was an order for table-ware and the order merely said that you were to send Rogers table-ware, did you know to what goods that order referred?

A Well, in some cases we received orders for table-ware other than that appearing in the catalog of the firm Heacock, which is the Rogers trade-mark, called "Rogers Nickel Silver;" but in some cases in which we received orders it was sufficient to mention the name Rogers.

Q When you received such an order, mentioning only the name Rogers, to what article did the buyer refer?

A Those mentioned, because not only once, but many times they ordered Rogers ware from us, and they also ordered Rogers ware from the firm Heacock, by means of the catalog of the firm Heacock.

Q When no mention is made in the order that it is from the firm Heacock, only the word Rogers is mentioned, a set of Rogers table ware, and then you know to what ware the order refers?

A Of the firm Heacock.

Q Of what firm?

A I have already answered that.

Q Answer again.

A Well, some orders, according to the order, some-

times the sets of the firm Heacock are mentioned, because, really, I cannot deny that sometimes when they order from us it is sufficient to say Rogers brand, because what do you call it, the majority of the orders is with the name of Rogers of the firm Heacock.

Q But when you receive orders not mentioning that it is from the firm Heacock, but only the name Rogers, how do you understand that order?

A Table-ware of the trade-mark Rogers.

Q But there were several firms who imported Rogers table-ware, were there not?

A Yes, sir; Heacock and the American Trading Company.

Q And when you receive an order not mentioning that it is for Heacock's Rogers table-ware?

A I give them the table ware I bought from the American Trading Company.

Q When you bought or ordered table-ware of William A. Rogers, Ltd., for the first time from the American Trading Company, why did you order it or why did you buy it?

MR. FERRIER. One moment. It was my understanding that this witness was called only to make certain corrections in the transcript.

MR. ENRILE. Exactly; there is another error.

MR. FERRIER. But you now begin with something else.

MR. ENRILE. There is another error on page 28, line 4.

THE COURT (to Mr. Enrile). Go on.

MR. ENRILE. (continues) What induced you to order that Rogers table-ware from the American Trading Company?

THE COURT. Is there any objection?

MR. FERRIER. Yes, sir. I object to this question as being incompetent, immaterial, and irrelevant.

THE COURT. He may answer.

MR. FERRIER. Exception.

A On account of it being cheaper, compared with the prices of the firm Heacock.

MR. ENRILE. (Cont.)

Q For any other reason besides?

A I don't remember now if there is any other reason.

Q If that ware which according to you was offered by the American Trading Company had been marked W. Smith or W. Harris instead of William A. Rogers, would you have ordered any of that Rogers brand?

MR. FERRIER. I object to the question because there is no ware with those brands.

THE COURT. He may answer.

Q No, sir, I would not buy any with another brand because the public does not know it.

MR. ENRILE.

Q And what was the name that the public knew and that induced you to place those orders for the first time with the American Trading Company?

A The brand Rogers.

Q The word Rogers, you mean?

MR. FERRIER. I object to this question as being suggestive.

THE COURT. Amend the question.

MR. ENRILE (continues).

Q What do you mean by the brand Rogers when you say "brand Rogers?"

A It refers only to silverware for presents, such as Rogers sets.

Q If any word other than the word "Rogers" had appeared on the ware offered to you for the first time by the American Trading Company, would you have ordered any?

A No, sir.

Q Why not?

A Because we do not need any other brand, as we know that we can not do any business with other brands in the market here, for the reason that they are not known.

MR. ENRILE. That is all.

Q Have you seen any article of silverware with only the word Rogers on it, without any other symbol or any other mark or brand?

A What I can say is, that all the silverware that we call Rogers silver, which is plated, is sometimes marked with the words "Rogers Bros." and a number 1874, something like that, and sometimes 1881 Rogers, which is well known, and other similar marks; but it always bears the word Rogers.

Q And does it also bear another symbol joined to the word Rogers?

A. Yes, sir.

MR. FERRIER. Nothing more.

.....

ANDRE BERNARD, 35 years of age, married, merchant, residing at No. 2 Pasage del Carmen, Malate, Manila, P. I., having been sworn in due form, testified as follows:

BY MR. ENRILE. (Direct examination).

Q Do you know the firm Levy & Blum, Inc.?

A Yes, sir.

Q Is it a *sociedad mercantil colectiva* doing business in Manila?

A Yes, sir.

Q What is your relation with that firm?

A I am its manager.

Q Do you know the plated cutlery and ware of the firm William A. Rogers, Ltd?

A Yes, sir.

Q Has the firm Levy & Blum, Inc., sold or imported this ware?

A Yes, sir.

Q Did Levy & Blum, Inc., buy them from the American Trading Company?

A We ordered by indent.

Q In what year did the firm Levy & Blum, Inc., begin to place these orders?

A About four or five years ago.

Q Do you know for what reason the firm Levy & Blum, Inc., decided to order this ware from the American Trading Company?

A Because this ware is in our line and we desired to increase our sales, and an agent of the American Trading Company came and offered us the Rogers ware, and we gave an indent by way of trial, and as it was a success, we gave other indents.

Q What was the principal reason for your placing those orders with the American Trading Company?

A Because they came and asked us.

Q If the ware which they offered you had borne any other brand without the word Rogers, would you then have ordered any?

A Probably not.

Q Why?

A Because the word was known in Manila and we were able to sell the ware here.

Q Is the word Rogers favorably known?

A Yes, sir.

Q Do you know through whom the word Rogers has become so favorably known?

A I suppose because it is good ware or owing to the propaganda made, or something like that.

Q And did you sell much of this ware?

A Well, it is rather difficult to say whether we made good sales.

Q Throughout the Philippines?

A Yes, sir, throughout the Philippines.

MR. ENRILE. That is all.

MR. FERRIER (Cross Examination).

Q You advertised this table-ware, did you not?
A Yes, sir.
Q By means of catalogs?
A By means of catalogs and circulars.
Q Have you seen any of this ware with only the word Rogers?
A No, sir.
Q What was there besides the word Rogers?
A "W", I believe; I do not remember exactly.
Q In other words, besides the word Rogers, there was on this ware some other additional word or symbol?
A I don't understand your question.
Q Did you ever see on the silverware the number 1847 with the word Rogers Bros?
A No, I don't remember.
MR. FERRIER. That is all.
MR. ENRILE (Re-direct).
Q So that, although you are an importer of the table-ware of William A. Rogers, Ltd., which you ordered by indent from the American Trading Company, all that you remember at this moment of the brand on that ware is the word Rogers?
A Yes, sir.
Q You say you advertised that ware by means of catalogs and circulars?
A Yes, sir.
Q But before you advertised it, as you said before, the word Rogers was already known?
A Yes, sir.
Q Can you tell the Court, more or less, what sums you spent for advertising each year during those four or five years?
A It is very difficult for me to say how much, because the page of that Rogers circular book was together with many other catalog pages and I really cannot tell you.

Q But an estimate of the page of the catalog referring to the ware?
A Very little.
Q How much, more or less, each year?
A Some hundred pesos (₱100.00) per annum.
Q Including circulars and catalogs?
A Yes, sir.
MR. ENRILE. That is all.
MR. FERRIER.
Q Despite the fact that you do not remember any additional word to the word Rogers, you recollect that there was another word following it?
A Yes, sir.
MR. FERRIER. That is all.

VICENTE SANTO DOMINGO BERNARDO, 41 years of age, married, a merchant, residing at No. 612 Calle Azcarraga, Manila, P. I., who, after being duly sworn, testified as follows:

BY MR. ENRILE (Direct examination).
Q What is the style of the firm of which you are a member?
A Bernardo and Sons.
Q Where is your establishment?
A Nos. 85-87 Calle Rosario.
Q Since when does this firm Bernardo and Sons exist?
A It was changed; it was formerly Bernardo & Varela, in 1921, and was changed to Bernardo and Sons in 1926.
Q Do you know this box of tableware which we request be marked Exhibit "E" for identification?
A Yes, sir.
Q Do you know from whom Heacock & Co. bought this box of tableware?
A From us.
Q What was the price for which they bought it?
A I don't remember.

Q Of how many pieces does it consist?
A Fifty one pieces.
Q Do you sell these sets regularly?
A Yes, sir.
Q And, besides, other boxes with ware of the same make or brand, William A. Rogers, Ltd?
A Yes, sir.
Q Since when have you been dealing in this tableware of William A. Rogers, Ltd?
A Since the time of the old firm in 1922 or 1923, when we began ordering goods from the Manila Trading Company, I believe.
Q Manila Trading or American Trading?
A American Trading.
Q And you have been giving them orders from them until the present?
A Yes, sir.
Q Have you been selling many of these sets?
A Yes, sir.
Q In all the provinces of the Philippines?
A Yes, sir.
Q Were you already selling Rogers ware then, before 1922 or in 1923?
A Yes, sir.
Q From whom?
A From the firm Heacock.
Q Did you buy from them?
A Yes, sir.
Q And when you began to order from the American Trading Company, did you cease ordering from Heacock?
A Yes, sir.
Q What is the principal, if not the only reason, why you decided to order these William A. Rogers, Ltd., sets from the American Trading Company?
A Because those of the American Trading Company were marked with the brand Rogers, like Heacock's.

Q And was that mark Rogers, known favorably in the market then, or was it not?

A It was favorably known throughout the Philippine Islands.

Q Why was it so favorably known; do you know?

A Perhaps because of the advertising done by the firm Heacock.

Q Was that mark very widely advertised?

A Yes, sir.

Q If those sets offered to you by the American Trading Company had born any mark or symbol or any combination of words or symbols in which the word Rogers did not appear, would you have ordered any?

A No, sir.

MR. ENRILE. That is all.

MR. FERRIER. (Cross examination)

Q Did you see any of this silver ware or plated ware with only the word "Rogers", without any additional word or symbol?

A They were of Rogers silver and of silver; there is a difference which I noticed; those of the American Trading Company were marked 1881, I believe, and those of Heacock were marked 1847.

Q Take a set or a fork from this Exhibit "E" and please examine it and tell us what marks or signs there are?

MR. ENRILE. I object to the question because the mark is on the fork and the mark is the best answer.

COURT. Let him answer.

[illegible] Silver", "W. A. Rogers

[illegible] bearing only the [illegible] mark?

[illegible] [illegible] [illegible] [

symbol.

Q When you bought from the American Trading Company, as you said, what you did was to order by indent, did you not?

A Yes, sir.

Q From William A. Rogers, Ltd., did you not?

A I do not see anything in the order, if it also contains the words W. A. Rogers; in our order, only the word Rogers appears.

Q The draft from the United States for payment was addressed to you, was it not?

A Yes, sir, the draft was directly against us, through the Philippine National Bank.

Q And you paid the amount to the Philippine National Bank and not to the American Trading Company?

A No, sir.

Q What do you mean by no?

A We did not pay directly to the American Trading Company but we paid directly to the Philippine National Bank.

MR. FERRIER. That is all.

MR. ENRILE (Re-direct)

Q Then, although you are an importer of William A. Rogers, Ltd. tableware, which you have been ordering through the American Trading Company since 1922 and up to the present time....?

A Yes, sir.

Q Although you have sold a large number of this tableware, you have not yet stocked the symbol which that ware bears, but only the word Rogers?

A As I am not interested in any symbols other than the word Rogers, the word Rogers alone [illegible] I presume that very well.

MR. ENRILE. That is all. I ask that this box [illegible] of fifty-two [illegible] Rogers Nickel [illegible] for the pur-

poses of the stipulation which we are going to make now.

THE COURT. Mark it.

MR. ENRILE. The parties agree that this box of tableware marked Exhibit "F", composed of 51 pieces is a specimen of what the firm H. E. Heacock Company has been selling regularly since it exists.

MR. FERRIER. That is all right; but I would like it to appear in the record that the boxes containing that tableware are made in Manila, Exhibit "E" as well as Exhibit "F", and that neither of these two containers Exhibits "E" and "F" is sold exclusively by H. E. Heacock & Co. or by the American Trading Company; but that they are bought by H. E. Heacock & Co. for use as container or box for the tableware sold by H. E. Heacock & Co. and the other importers, such as Bernardo & Sons, for instance.

MR. ENRILE. We accept these modifications, with the clause that the b[illegible] that forms part of Exhibit "F" is sold by Heacock just as Exhibit "F" is, both the box and the contents, and they have been selling it that way.

MR. FERRIER. That is all right; but what I desire to say is that Heacock and the American Trading Company sell the boxes containing tableware separately, and likewise, that the tableware is not imported packed in those boxes.

MR. ENRILE. Agreed.

MR. FERRIER. And also, that these cases are made in different colors.

MR. ENRILE. I agree. And we ask that this certified copy issued by the Bureau of Commerce and Industry be marked as Exhibit "G". We now offer as evidence Exhibits "A", "B", "C", "D", "E", "F", and "G", and ask the Court for leave to replace Exhibits "A" and "D" by photographs of said exhibits, which are the

advertisements in the "Manila Times."

MR. FERRIER. No objection.

THE COURT. All the exhibits are admitted; and make it appear in the record that Mr. Ponce Enrile is taking with him exhibits "A", "B", "C", and "D", consisting of a collection of several numbers of the newspaper "The Manila Times", in order to have the photographs made of them which he has announced he will offer as substitutes for said exhibits.

MARIANO JAVIER, 43 years of age, married, a merchant, residing at 1185 calle A. Mabini, Malate, Manila, P. I., who, after being duly sworn, testified as follows:

BY MR. ENRILE. (Direct exam.)

Q Are you employed by the firm Heacock?

A Yes, sir.

Q Since when?

A Approximately twenty-three years, since 1906.

Q What position do you hold, if you hold any now with the firm mentioned?

A Chief of the wholesale department.

Q I exhibit to you these documents or papers which we have marked exhibits "H-1" to "H-7" for identification purposes. Tell us what they are and if you know them?

A They are letters or orders of Rogers tableware from the provinces.

Q Did you bring these documents?

A Yes, sir.

Q Are these the only orders of Rogers tableware there are in the files of the firm Heacock?

A There are many others, but these have been taken from the files of various provinces; they are wholesale orders and do not include orders of the retail department.

Q Are there other orders like those exhibits "H-1" to "H-7" in your files, or aren't there?

A There are many.

Q And why did you pick out these?

A Because there are so many that it would be necessary to bring the files of the firm here.

Q These are samples of what there is in the files?

A Yes, sir.

Q Have you here samples of the several articles of the brand Rogers that the firm Heacock has been selling for many years?

A Yes, sir; the Rogers tableware and some of what we call "Holloware".

Q Have you brought that tableware here, besides this box which is marked exhibit "F"?

A I have brought two articles of the many we have, two pieces I have brought.

Q Have you those articles here?

A Yes, sir; they are here (pointing them out.)

Q What is this, a sugar bowl?

A Yes, sir, a sugar bowl.

Q I show you this sugar bowl which we mark exhibit "I" for identification. Tell us whether it is one of the articles of the mark Rogers which the firm Heacock has been selling since some time ago?

A Yes, sir, it is.

Q I show you this article which we mark Exhibit "J" for identification. Tell us if it is also one of those articles?

A Yes, sir.

Q I show you this set which we mark as exhibit "K" for identification. Tell us if it is one of the articles that the firm Heacock has been selling?

A Yes, sir, No. 1847.

Q I show you this other set of table-ware which we mark exhibit "I" for identification. Tell us if this is also a specimen of the articles that the firm Heacock has been selling since a long time ago?

A Yes, sir.

Q And this other specimen which we mark as exhibit "M" for identification; tell us if it is also one of the articles that the firm Heacock has been selling since a long time ago?

A Yes, sir.

Q Since when has the firm Heacock been selling all these articles marked exhibits "F", "H", "I", "J", "K", "L", and "M"?

A Since the organization of the firm Heacock.

Q Since before 1906?

A Yes, sir, a long time before that.

MR. ENRILE. That is all.

MR. FERRIER. (Cross-examination).

Q Since when have you been working for the firm Heacock?

A Since about 1906.

Q Where were you born?

A Here in Manila, in Malate.

Q These letters, exhibits "H-1" to "H-7", I see here, for instance, in this exhibit "H-2", the following: "One Rogers school set No. 670 F". To what refer those figures?

A They refer to the set number.

Q In your catalog?

A Yes, sir.

Q It is your catalog number?

A Of the school set catalog.

Q It is the number of your catalog?

A Of the firm Heacock.

Q And this number 809 F which appears in exhibit "H-2", is that also the number in your catalog or Heacock's?

A Yes, sir.

Q And is it the same in all the exhibits "H", up to "H-7"—when there is a number, it is the number of the firm Heacock?

A That depends, because by these numbers we fill the order and according to them we send the table-ware ordered.

Q For instance, in this exhibit "H" which says "No. 793 F", is that the number in Heacock's catalog?

A Yes, sir.

Q And the number 792 F which appears in the letter dated May 26, 1928, which forms part of the exhibits "H-1" to "H-7", was also a catalog number of Heacock Company?

A That agrees with the name of the table-ware which was "Montrose."

Q And the same was the case with all exhibits?

A Yes, sir.

Q I note that exhibit "I" which is the sugar bowl marked "1847 Rogers Bros.", and exhibit "J" bear the same numbers and words?

A Yes, sir.

Q And exhibit "M" bears the mark "W. Rogers and Sons E. E.", does it not?

A Yes, sir.

Q And that the articles forming exhibit "L" bear the words and letters "William Rogers & Sons E. E." Please tell us whether or not any of these articles has been manufactured by H. E. Heacock Company?

A No, sir.

Q From where did these come?

A From the International Silver Company.

Q From where?

A From the United States.

Q And do they bear these words and marks when they are imported into the Philippine Islands?

A Yes, sir.

Q And you said that the firm Heacock has been importing these articles since when?

A When I came to the firm Heacock they were already importing those articles.

Q Since 1906?

A Much longer.

Q As far as you know?

A As far as I know, sir.

Q Since 1906?

A They were importing them in 1906, but long before that—I don't know how long.

Q Since that time, these articles have been bearing the same or similar marks as they bear now?

A Yes, sir, they have.

Q Heacock Company have never put the word Rogers on any thing or article, as far as you know?

A Put there, no.

MR. FERRIER. That is all.

MR. ENRILE. (Re-direct)

Q Besides these samples that you have brought here, marked as Exhibits "F", "I", "J", "K", "L", and "M", is there any article of the same kind sold by Heacock?

A Yes, sir.

Q And the difference consists in the patterns being different?

A Yes, sir.

Q But these articles exhibited here show the different grades of all those articles?

A According to the mark they bear.

Q Yes?

A Yes, sir.

Q According to this sample that you have brought here, the symbols indicate the quality of the article?

A Yes, sir.

Q And these samples here, for instance "A. A. 1847", and the word "Bros. 1847", in addition to the word Rogers, what do they indicate in this article?

A That is the difference in quality, that is, in the grade of the article, as 1847, 66, the A. A. followed by other names like "Nickel-Silver, 66 Silver", according to the different articles or the quality of each article.

Q You mean that those symbols or words "66 A. A." and other symbols or words indicate the specific quality of each article?

A Yes, sir.

MR. ENRILE. Nothing further.

MR. FERRIER.

Q Have you anything to do with the advertisements of the Heacock Company?

A No, sir.

Q What quality does the number 1847 indicate on any of those silver or silver-plated articles?

A As far as I know, 1847 is the best grade of silver-plated Rogers ware.

Q Is it not true that that figure 1847 means the year when Rogers began to manufacture silver table-ware or silverware?

A I don't know,

MR. FERRIER. That is all.

MR. ENRILE. We introduce in evidence all these additional exhibits which we have marked, that is, "H-1" to "H-7", and exhibits "I", "J", "K", "L", and "M".

THE COURT. Is there any objection?

MR. FERRIER. No objection.

THE COURT. Admitted without objection.

MR. ENRILE. With this we close our evidence, and inasmuch as this is a joint hearing of two cases in which both parties are reciprocally plaintiffs and defendants, and as in one of them the H. E. Heacock Company is the defendant and the American Trading Company the plaintiff, and as we have been unable to sue William A. Rogers Ltd., because they have no office here, and, on the other hand, in view of the evidence that the American Trading Company was not selling these articles but introduced them by indent order, as representative of William A. Rogers, and this being a joint hearing, I am going to ask the Court for

permission to amend our answer to the complaint of William A. Rogers Ltd. and the American Trading Company against the Heacock Company, civil cause No. 32956, in order to file or include in our answer a counter-complaint against William A. Rogers Ltd., petitioning against them for the same affirmative remedy that we ask against the American Trading Company.

MR. FERRIER. According to the law you cannot obtain it because the law provides that any person who has a trade-mark registered in the United States can import his merchandise into the Philippine Islands without hindrance. There is another objection to the amendment of the answer to the complaint at bar, because if William A. Rogers was here in court, it was when his complaint was filed, and the defendants have made an answer to that complaint and can file any counter-complaint at any time, and the excuse that this new evidence has been discovered does not change the right he had to present that counter-complaint at the proper time, that is, at the time when they filed the original answer they had the same right that they have now.

MR. ENRILE. Our petition is based only on the fact that the allegations must conform to the facts proved. We have shown that the American Trading Company imported these goods; but the cross-examination of the adverse party has brought out the fact that it imported them as "indent order" or as agents of William A. Rogers Ltd., and since William A. Rogers Ltd. is a party here as plaintiff, in view of the evidence now in the record, it is just that we should be permitted to amend the answer, inasmuch as they have brought this proof in court, and it is not just that after that evi-

dence has been introduced, we should be stopped and prevented from filing a complaint against William A. Rogers Ltd.

MR. FERRIER. They had that right since that complaint was filed.

THE COURT. Five (5) days are granted for filing the amended answer.

MR. FERRIER. Exception.

THE COURT. Evidence of William A. Rogers Ltd. and the American Trading Company.

MR. FERRIER. Your Honor, I have asked Messrs. Heacock Company to produce certain documents and have asked them to present a list of the persons to whom they have sent letters, addressed to various persons about the end of December, 1927, relative to the sale by them of merchandise manufactured by William A. Rogers Ltd.

MR. ENRILE. Answering the subpoena duces tecum to which Attorney Ferrier refers, we desire to inform the Court that the subpoena duces tecum requested by Mr. Ferrier was received only yesterday at about four o'clock in the afternoon by Mr. Schleipen, vice-president of the Heacock Company, and in reply to that subpoena duces tecum we have brought the things requested and have already presented them here as evidence, as exhibits "F", "I", "J", "K", "L", and "M". As to the list referred to in the subpoena duces tecum, I have here a list of the persons to whom letters relative to that Rogers ware were sent on December 28, 1927, and we place the same at the disposal of the adverse party. As to the account book of the firm Heacock Company showing the expenses of said firm for advertising during the last five years, the accountant, Mr. Guzman, is here and has brought the book, which is likewise at the disposal of the adverse party. As

to the correspondence between the International Silver Company and the H. E. Heacock Company relative to the case at bar, we desire to state that we cannot produce it now, nor do we know where it is, because Mr. Gaches is not here, he being probably in Japan, and it is possible that Mr. Gaches has it in his safe. If it had been requested while Mr. Gaches was here, during the last two days of hearing, Mr. Gaches could have said whether he had it or not, and if he had it, I could have answered. This is all we can say as to the subpoena issued by the Court.

MR. FERRIER. What we can say in reply is that exhibits "I", "K", "L" and "M" have not been produced as commanded in the subpoena duces tecum, because in that subpoena duces tecum it is required that any silver-plated article manufactured or sold by H. E. Heacock Company be brought here, and I invite the attention of the Court to the fact that all these articles are marked "Rogers", which is their trade-mark. I also desire to know whether or not this list furnished here is the list of all the persons to whom H. E. Heacock Company has sent letters on December 28, 1927?

MR. ENRILE. We have been asked for a list and we present a list here, and if Mr. Ferrier desires to know more he will have to call us as witnesses.

MARIANO JAVIER was recalled to testify as witness of the American Trading Company and William A. Rogers Ltd., under the oath taken by him according to law; his personal data appear in the record.

MR. FERRIER (direct examination)

Q What is your connection, if any, with the Heacock Company?

A I am manager of the wholesale department.

Q Have you prepared this list which has been marked exhibit "14" of the defense?

A I directed the stenographer to make a list of the letters sent to which the subpoena refers.

Q It was prepared under your direction then?

A Yes, sir.

Q And do you mean to say that this is a complete list?

A That list was made out from the receipt signed by these persons.

Q But you don't know whether it is complete or not?

A I don't know.

Q Don't you keep copies of the letters you sent in your office?

MR. ENRILE. I object to the question as immaterial.

MR. FERRIER. But it is assumed that we know the business of Heacock Company.

THE COURT. The objection is sustained.

MR. FERRIER (continues)

Q Do you know whether or not the Heacock Company sent a copy of this letter to Levy & Blum Inc.?

A I don't know; all I know is in the list exhibit "14".

Q Don't you know if they sent one to the American Trading Company?

A I don't know.

Q So that all you know is the contents of this exhibit "14", which was prepared by your stenographer?

A Yes, sir; taken from the receipts signed by these gentlemen.

MR. FERRIER. I ask the firm Heacock Company to produce the copy, if they have any, of the letter of January 11, 1922, addressed to the "National Store", Escolta, Manila. It is impossible to produce the original of this letter

because that "National Store" no longer exists, as it was declared insolvent, and I don't know where the members of it are at present.

MR. ENRILE. I object because it is immaterial, supposing that there was a copy of that letter, unless it be proved that the original cannot be produced here, because the "National Store" on the Escolta was owned by Mr. Rafael Rebullida and that gentleman is living in Manila. There are insolvency proceedings against Rafael Rebullida, and the book must be with the record. I personally do not know whether such a letter exists.

MR. FERRIER. (continues)

Q Have you any stenographer or employee of the H. E. Heacock Company whose initials are D. V.?

A Yes, sir.

Q Who is he?

A I don't know if it is the same; but there is one person there who has those initials, Donato Valenzuela.

Q Since when is he there?

A I don't know; I have not any idea, but he must have been there about ten years; I don't remember exactly.

Q Is he Mr. Gaches' personal stenographer?

A If he is the same person, Donato Valenzuela, yes.

MR. FERRIER. I then ask Your Honor to give me sufficient time to secure the original of this letter, and if I cannot secure the original, I shall ask permission from the Court to produce a copy here.

THE COURT. Granted.

FORTUNATO R. GUZMAN, 44 years of age, married, chief accountant of the firm H. E. Heacock Company, residing at No. 181 Marques de Comillas, Paco, Manila, P. I., who, after being sworn according to law, testified as follows:

BY MR. FERRIER. (Direct examination).

Q Have you brought the books of the Heacock Company with you?

A Yes, sir.

Q Where are they?

A Here they are (pointing).

MR. ENRILE. We object to Mr. Ferrier making an examination of the books of the Heacock Company unless he do so by means of questions to the witness, in order that those parts may be seen which the adverse party desires to see. This is not a time for Mr. Ferrier to see all the entries in the books of the firm Heacock Company.

THE COURT. The objection is sustained.

MR. FERRIER. (continues)

Q Show me the advertising account in these books?

A It is here (showing account No. 19, pages 16 to 108, and account 19-A, folios 1 to 12).

Q What is the meaning of the letters O. E. D. after the word "Advertising"?

A Account 19-A, folios 1 to 12, with the heading "Advertising O. E. D." refers to the "Office Equipment Department."

Q And has nothing to do with the advertising of silverware?

A No, sir; I was asked for advertising accounts.

Q And can you tell me, on pages 80 to 108 of Account No. 19, under the heading "Advertising," what is the merchandise advertised and for which advertisements have been paid, each entry there?

A No, sir, all the advertising is lumped together there.

MR. FERRIER. That is all.

MR. ENRILE (Cross-examination)

Q To what year refers this account which you have shown in answer to Mr. Ferrier's ques-

tion, that is, account No. 19, on pages 60 to 108?

A From January 8, 1923, to September 22, 1928.

Q And according to you, all the advertising of the firm Heacock Company is lumped together in these accounts?

A Yes, sir.

Q With the exception of the office equipment department?

A Yes, sir.

Q What annual sum do these advertisements in account No. 19 show for those years?

A In the year 1923, the disbursements for advertising amounted to nineteen thousand and fifty-five pesos and seventy-three centavos (P19,055.73), in the year 1924, to twenty thousand two hundred and seventy-six pesos and ninty-seven centavos (P20,276.97), in 1925 to twenty-five thousand one hundred and sixty-eight pesos and forty-one centavos (P25,168.41), in the year 1926 to twenty-eight thousand one hundred and twenty-three pesos and sixty-six centavos (P28,123.66), in the year 1927, to twenty-eight thousand one hundred and twenty-eight pesos and fifty-eight centavos (P28,128.58), and in the year 1928, to the entry of September 22nd, there is a total of twelve thousand three hundred and thirty-seven pesos and fifty-eight centavos (P12,337.58).

Q Until September 22nd of this year?

A Yes, sir.

Q This amount that you have just given here as advertising expenses of the firm Heacock Company from the year 1923 until the present writing does not include the advertisements of the office equipment department?

A No, sir.

Q That is separate?

A Separate.

Q These expenses which you have given here include the expenses for advertising the Rogers ware?

A All goods sold by the firm.

Q Including Rogers?

A Including Rogers.

MR. ENRILE. That is all.

MR. FERRIER.

Q I notice among the entries here one dated August 8, 1928, which reads "Sunday," and another item on August 10th which reads "Benefit tickets." Did you advertise those benefit tickets that you bought to the public?

A This is a means of attracting the public towards the firm.

Q In other words, it is propaganda and not advertising?

A I consider it as advertising.

Q I also find here an entry dated August 29, 1928, "Box presented to Mayor". Is that also advertising the things that Heacock Company are selling?

A Another means of attracting the public, in order that it may be known that we give favors in exchange for the sales, that is, that we favor those who favor us.

Q Then under the word "Advertising" you have included all expenses for propaganda, advertisements, and other things?

A Not all things, only what concerns advertising in the sense either of publicity or of the exhibition of articles in the show window by way of advertisement.

Q I also find here in your book, under the date of April 30, 1928, the following: "C. C. McKining P6.00". Do you remember what advertisement that is?

A I don't remember this moment whether it is a program or some weekly.

Q. Do you know C. C. McKining?

A I don't know him personally; but I know that all these sums charged against advertising are accounts pertaining to advertising.

Q I also find here, under May 19th "Contribution Memorial Day". Is that advertising, too?

MR. FERRIER. That is all.

MR. ENRILE.

Q That box which was presented to the Mayor of the City was to contain the key of the City, was it not?

A Yes, sir.

MR. ENRILE. That is all.

MR. FERRIER.

Q Is there no means of telling by this book how much has been spent or what it has cost to advertise each article sold by the firm Heacock Company?

A No, sir. Here only all expenses for advertising are charged; but Mr. Gaches, who approves all bills before they are paid, makes his personal notes of what belongs to each article or line of articles advertised.

Q But nothing of that is put down in this book?

A No. Here there are only the bills presented for advertising expenses.

MR. FERRIER. That is all.

S. ALLEN PRESBY, 58 years of age, married, merchant, residing at No. 204 Calle Nebraska, Malate, Manila, P. I., who, after being sworn according to law, testified as follows: (Interpreted by A. Zulueta)

MR. FERRIER. (Direct examination)

Q What is your connection, if any, with the American Trading Company?

A I am president and general manager.

Q The American Trading Company has charge of the sale of the articles manufactured by William A. Rogers Ltd. in the Philippine Islands?

A Yes, sir, I have charge of it.
Q In what form?
A As an agent.
Q Explain the manner in which it is done.
A We have the agency of William A. Rogers Ltd.; we sell the goods on commission, and sometimes we import it at the price C. I. F. C. I. F. means the cost price, freight, and insurance, which is the price put down in the warehouse.
Q Whose warehouse?
A The buyer's.
Q Are the orders for the merchandise sold by the American Trading Company placed direct with the American Trading Company?
A oI don't understand you.
Q You get your orders from the manufacturers direct?
A In the majority of cases, the American Trading Company solicits and takes the orders, which are sent direct to the factory, and the factory ships the goods direct to the customer and receives payment from the customer through the banks, except that it is the American Trading Company which puts the price C. I. F.
Q Is that the manner in which you handle the products manufactured by William A. Rogers Ltd.?
A Nearly ninety-five per cent (95%) is sent direct by the manufacturer to the customer, and five per cent (5%) on the price C. I. F.
Q Do you know whether any other manufacturer of silverware and table-ware uses the word "Rogers" as part of his trade-mark, besides William A. Rogers Ltd.?
MR. ENRILE. I object to the question as it is, because it is immaterial, unless it is circumscribed to the Philippine Islands, whether there exists here in the Philippines any other facto-

ry or any other importer, because rights acquired in the United States are not automatically acquired here. The Trade-Mark legislation of the United States is not applicable here in the Philippines, and it not being applicable here, unless you say in your question that you refer to the Philippine Islands, if it refers to any place outside of the Archipelago, it is immaterial.

MR. FERRIER. I greatly regret to say that my colleague is a little behind the times as far as laws are concerned. The Act of Congress which provides for the registration of trade-marks in the United States provides specifically that the words "United States" as used in that Act include the entire territory under the jurisdiction of the United States, and the Philippine Islands is a territory under that jurisdiction. That Act has never been repealed and is still in force and effect.

MR. ENRILE. Answering Mr. Ferrier's statements, it may be that we are mistaken; but the Court will say whether the Act of Congress is applicable to the Philippines.

THE COURT. He may answer.

A I personally know three firms using the name Rogers in connection with their trade-mark, which manufacture silver and nickeled ware.

MR. FERRIER. (continues)

Q Do you know the names of those firms?

A The International Silver Company, William A. Rogers Ltd., and Rogers Bros.

Q Do you know where these three factories manufacture their goods?

A William A. Rogers manufactures them at Niagara Falls, William A. Rogers Ltd. in Rhode Islands. As to the International Silver Company, I don't know; but I believe it is in Connecticut.

Q Do you know anything about the quality of the silverware manufactured by these three factories or firms?

A They all manufacture different grades or qualities, the International Silver Company, Rogers, I mean, William A. Rogers, Ltd., with whose goods I am familiar, are grade for grade known in business as being of the same grade or quality. The nickel-silver of the International and the nickel-silver of William A. Rogers Ltd. are sold by the manufacturers at almost the same prices in the United States and the prices of the other goods are approximately the same, with the exception that the best grade of the International Silver Company is the type 1847 and the best quality of William A. Rogers Ltd. is known in the market under the name of "Heirloom Plate," which is of better quality than the 1847 of the International Silver Company.

MR. ENRILE. I ask that everything testified by this witness so far be stricken out because he has not yet qualified as an expert and this is a subject in which one must qualify as an expert.

THE COURT. Denied. He is general manager of one of the commercial companies and is as such supposed to have the knowledge necessary to manage the business.

MR. ENRILE. Exception.

MR. FERRIER. (continues)

Q Do you know what the word Rogers signifies?

A It is the name of a person.

Q A family name or a Christian name?

A A family name.

Q Have you ever seen any article of silver bearing only the word Rogers as a trade-mark?

A No, sir.

Q Do you know whether or not William A. Ro-

gers Ltd. have registered their trade-mark in the United States?

MR. ENRILE. I object to the question as immaterial and incompetent because the certificate of registration would be the best proof whether or not it has been registered.

THE COURT. The objection is sustained because it is not the best evidence.

MR. FERRIER (continues)

Q Do you know since how long the articles manufactured by William A. Rogers Ltd. are being imported in the Philippines?

A The American Trading Company began importing them in 1924 or 1925, I don't remember exactly which.

Q Do you know whether or not that same merchandise was imported by some one else before that date?

A Yes, sir.

Q Was it imported?

A Yes, sir.

Q As far as you can remember, how many years is it that it is being imported?

A The firm Zuellig has informed me that they have been importing it since 1919.

MR. ENRILE. I ask that this testimony of the witness be stricken out as it is hearsay.

THE COURT. Strike it out.

MR. FERRIER. (continues)

Q Tell us what you know and not what another person has told you.

A I don't know if other persons have imported it before us; what I would say would be hearsay.

Q You mentioned another firm—I believe you said Rogers Bros. Have you seen any goods sold in Manila bearing the trade-mark "Rogers Bros."?

A Yes, sir; I have seen it in the establishment "El Zenith".

Q When?

A This week.

Q Goods manufactured neither by William A. Rogers nor by the International Silver Company?

A As far as I know, not manufactured by those people. There was a box containing twenty-seven pieces, with a guaranty card similar to or resembling that issued by William A. Rogers Ltd., which bears the photograph of a man's face and the words "Rogers Bros." and "Rhode Islands" which is the State where they are manufactured.

THE COURT. We shall continue this hearing this afternoon at half past two.

I CERTIFY that the foregoing is a true and correct transcript of the stenographic notes taken by me at the forenoon session on October 3, 1928, during the continuation of the hearing of these cases.

(Sgd.) SANTIAGO GUISANDI,
Official Stenographer

Manila, Oct. 3, 1928.

(AFTERNOON SESSION)

(CONT. OF HEARING)

The same parties and their counsel being present before the Hon. C. A. Imperial, the Judge presiding at the session, the hearing of these cases was continued.

S. ALLEN PRESBY continues to testify under the oath previously taken in due form; his personal circumstances appear in the record. (Interpreted by Mr. Antonio Zulueta)

MR. FERRIER (continuation of the direct exam.)

Q Mr. Presby: with reference to the last answer you gave relative to the articles which you saw in the store "El Zenith", do you desire any change made in what you testified this morning?

A After I left here, I went to "El Zenith", and the same ticket was in the show-window, and upon careful inspection I found that the name of the manufacturers is as follows: "The Rogers Manufacturing Co., Meriden, Connecticut," and the ticket or card was in such form that it was difficult to read.

Q Mr. Presby, when the American Trading Company received the complaint filed by the Heacock Company in this case, what did the American Trading Company do, if it did anything?

A They cabled to William A. Rogers Ltd., asking them to send the American Trading Company the dates on which the trade-mark Rogers was registered in the United Sates.

Q Did the American Trading Company receive any answer?

MR. ENRILE. I object to the witness continuing to testify on what William A. Rogers Ltd. said, because that would be hearsay testimony; moreover, it would be evidence made by the party presenting it, in which the adverse party has had no intervention; it is self-serving evidence.

THE COURT. He may answer yes or no.

A Yes, sir.

MR. FERRIER.

Q What is the nature of that answer?

MR. ENRILE. I object to the question because hearsay testimony is requested and it is self-serving evidence.

THE COURT. The objection is sustained because it is not the best evidence.

MR. FERRIER. (continues)

Q Did you receive any cablegram or a letter?

A Cablegram.

Q I show you, this radiogram marked exhibit "5". Tell us whether or not it is the document to which you have referred.

MR. ENRILE. I object to the question as immaterial; besides, the cablegram would be inadmissible as evidence at any rate, because it is self-serving evidence, and because the Court will see that it is attempted by this means to introduce here a statement of William A. Rogers Ltd. and we are deprived of an opportunity to cross-examine William A. Rogers Ltd. on what it says there.

THE COURT. He may answer.

MR. ENRILE. Exception.

A Yes, sir.

MR. FERRIER. (continues)

Q Did you receive any other answer from William A. Rogers Ltd. besides the radiogram?

A Yes, sir.

Q What did you receive, a letter, a cablegram, or what?

A I received a certified copy of the registration of their trade-mark in the United States.

Q I exhibit to you these documents which have been marked exhibits "7", "8", "9", "10", and "11" for identification. Please state whether or not these are the documents to which you have referred?

A Yes, sir.

Q Mr. Presby, the witness Vicente Bernardo testified here this morning that in the orders which he placed with you he only used the word Rogers. I now show you these documents marked for identification as exhibits "12",

"12—A", "13", and "13—A". Tell us what they are, if you know.

A Exhibit "12" is an order of Bernardo & Sons of May 16, 1928. Exhibit "12—A" is an order of Bernardo & Sons dated May 16, 1928, as follows: "Order to William A. Rogers Ltd. care of American Trading Company, Manila", signed by V. C. Bernardo, for Bernardo & Sons. Or, better, exhibit "12" is a copy of the order sent by the American Trading Company to William A. Rogers Ltd. which order has been accepted by us, and our acceptance of this order appears in exhibit "12-A" which is signed by myself. Exhibit "13—A" is an order from Bernardo & Sons, dated July 27, 1928, as follows: "Order of American Trading Company....."

MR. ENRILE. I object to the witness continuing to read in the record what the document contains, because it is already there.

THE COURT. He is not exactly reading the contents, but he is giving a short description of what the documents are. The witness may continue doing so.

WITNESS. (continuing) Order to the American Trading Company for Messrs. William A. Rogers Ltd., signed by V. C. Bernardo, for Bernardo & Sons. Exhibit "13" is our acceptance of our contract referred to in exhibit "13-A".

MR. FERRIER. (continues)

Q. Do you wish to say anything further, Mr. Presby?

A I wish to say that Mr. Bernardo told me he came this morning very excited and nervous; but that it was not his purpose to give misinformation. That is what he told me immediately after the hearing this forenoon, and these documents on which I have just testified come from his files which he has given to me.

MR. ENRILE. I ask that the statement of the witness be stricken out as it is hearsay.

THE COURT. What is hearsay is stricken out.

MR. FERRIER.

Q I show you this letter which has been marked exhibit "16" for identification. Tell me if you know, what it is?

MR. ENRILE. I object to the question because the document is the best evidence of what it is.

THE COURT. He may answer.

A It is a letter which I have received from Messrs. Heacock Company.

MR. FERRIER.

Q When you say you received it, do you mean to say that you received it personally?

A I mean addressed to the American Trading Company, but that I opened it.

MR. FERRIER. That is all.

MR. ENRILE. (Cross-examination)

Q This exhibit "12" is a carbon copy, is it not?

A Yes, sir.

Q And also exhibit "13"?

A Yes, sir.

Q Do you know where the original of these papers is?

A Yes, sir.

Q Where are they?

A They have been sent to the factory.

Q Have you made any effort to secure them from it?

A Those orders were handed to me at 12 o'clock by Mr. Bernardo, from his files.

Q I ask you if you have made any effort to secure the originals of these documents from the place where they are?

MR. FERRIER. We admit that we have not, and also say that the law does not oblige a person to do a thing that cannot be of any value. He

received those papers at noon today and the originals are in the factory in the United States, and it is very clear that these originals cannot be obtained from the United States.

MR. ENRILE (continues)

Q Do you know who prepared the originals of these documents?

A I cannot tell you.

Q But these are apparently blank forms of the American Trading Company?

A Yes, sir.

Q And what is generally done in these cases is this: the agent of the American Trading Company fills out this form in accordance with the verbal request or some note of the dealer, and the person giving the order signs it after it has been prepared by the agent or the dealer, is that not so?

A This was done by the stenographer.

Q These exhibits "12" and "13"?

A These exhibits "12" and "13"; exhibits "12-A" and "13—A" we received from Bernardo & Sons.

Q But exhibits "12" and "13" were prepared by the stenographer; whose stenographer?

A By my stenographer.

Q And after being prepared by your stenographer, they were submitted to Bernardo & Sons for signature?

A Those orders were signed by me; it was I who gave them to Bernardo & Sons.

Q But the signatures of Bernardo & Sons also appear here?

A That does not make any difference; but the orders here, "12—A" and "13—A" are the orders of Bernardo & Sons.

Q This exhibit "12—A", do you know who prepared the typewritten part that appears there?

A I received it this way from Bernardo & Sons.

Q And the part in handwriting, do you know who prepared that?

A V. Bernardo.

Q Was it prepared in your presence?

A No, sir.

Q Do you know who prepared this exhibit "13-A"?

A No, sir; I don't know.

Q But it was prepared in your presence?

A No, sir. It is signed by Bernardo and I suppose it was prepared by him.

Q Did you at any time see Mr. Vicente Bernardo sign his name?

A No, sir; but he told me that he signed and that he admits that contract, and that it was signed by him is evidently shown by the fact that he received the goods and paid for them.

MR. ENRILE. I request that the part that is hearsay be stricken out.

THE COURT. What is hearsay is stricken out.

MR. ENRILE (continued)

Q When you received this letter exhibit "16", what did you do?

A I don't remember whether that is the first or the second letter I received; but when I received the first letter from Heacock I sent a cablegram to the United States, as I testified previously.

Q Upon receiving this letter of Heacock's and the other which according to you you also received?

A I received letters from other persons and do not remember whether this is the first letter I received.

Q Did you receive one or two letters from Heacock in this connection?

A One.

Q Which is this exhibit "16"?

A Other persons informed me that Heacock had written them letters and when I learned of this, I sent a cablegram to the United States, and I don't remember whether I received this letter before or after.

Q What I desire to know with certainty is whether you received one letter from Heacock or two?

A One.

Q And that is this exhibit "16"?

A Yes, sir.

Q And when you received this letter you quit placing orders with William A. Rogers Ltd.?

A I did not stop sending orders.

Q Did you quit securing sales for William A. Rogers Ltd.?

A No, sir; I continued.

Q So that you mean to say you paid no attention to this letter, just as if you had never received it, this letter exhibit "16"?

A Yes, sir, with the only exception that I reported the matter to my principals in the United States and they assured me that I must ignore this letter completely. They advised me by cable.

Q You said that a week ago and again at noon today you saw in the show-window of "El Zenith" a box of table-ware made by the "Rogers Manufacturing Company" of Meriden, Connecticut, with the picture of a man. Were those words "Rogers Manufacturing Company, Meriden, Connecticut" which you saw and the picture of a man on a card or paper placed in the box of table-ware?

A Yes, sir.

Q You did not see the trade-mark on the table-ware itself?

A No, sir.

Q Neither did you go sufficiently near to see?

A No, sir, it was in the show-case.

Q Do you not know from whom "El Zenith" got that box of table-ware?

A No, sir.

Q Neither can you affirm to the Court that that paper you saw was originally a part of that box, nor that the trade-mark appearing on that paper was also on the table-ware that was in the box?

A No, apparently it was printed in the United States; it is a facsimile like that used by William A. Rogers Ltd. on its guaranteed ware; it is of the same size and like the picture appearing on that ware.

Q As you testified this morning, the first time that you or the American Trading Company imported or sold in the Philippines table-ware of William A. Rogers Ltd. was in the year 1924 or the year 1925?

A One of those two years, at the end of one or the beginning of the other.

Q And aside from that you do not, of your own knowledge, know of any other importation of table-ware prior to that date?

A Only by hearsay.

Q You said that ninety-five per centum (95%) of sales of this table-ware were made through you direct to the factory?

A Ninety-five per centum, more or less, of the sales are made by means of indent orders.

Q You or the American Trading Company never sold to any person table-ware of William A. Rogers Ltd.?

A How not? As I have already said, ninety-five per centum was by means of indent orders and the remaining five per centum was ordered by me direct and delivered to the costumers.

Q You mean to say that that five per cent was sold by the American Trading Company to the costumers?

A Not exactly. In a sale they wanted the price C. I. F. delivered in their warehouse, and we fixed the factory price and the cost of bringing the goods.

Q But as to that five per cent which is not indent, supposing the goods are lost in transit, who stands the loss, the person to whom the goods were to be delivered or the American Trading Company?

MR. FERRIER. I object to the question because this is a matter of law. This witness is not competent to say who must pay.

THE COURT. He may answer.

MR. FERRIER. Exception.

A It is a sale. We pay the price upon arrival here, we collect from the customer and pay what has to be paid for the sale tax, and pay the factory on our own account.

MR. ENRILE. (continues)

Q Do you know if this table-ware of William A. Rogers Ltd. imported by you has any trade mark which has been registered with the Bureau of Commerce and Industry of the Philippine Islands?

MR. FERRIER. I object to the question as incompetent, immaterial, and irrelevant.

THE COURT. What is the object of the question?

MR. ENRILE. To see whether that mark is really registered here.

THE COURT. He may answer.

MR. FERRIER. Exception.

A As far as I know, they are not registered.

MR. ENRILE. (continues)

Q Are these articles of table-ware which form Exhibit "E" any of those imported by the American Trading Company?

A As I understand the question asked by you, whether these goods were imported by the American Trading Company, naturally they have not been imported by the American Trading Company.

Q You mean to say that you are entirely unacquainted with the table-ware forming Exhibit "E"?

A Certainly I am.

Q Have you or the American Trading Company imported table-ware identical with these of exhibit "E" and sold them here?

A Yes, sir; but those were imported by Bernardo & Sons (referring to exhibit "E").

Q You mean that exactly these that are here, forming part of exhibit "E", were imported?

A But the same witness testified this morning that he imported these goods appearing in exhibit "E". How can they have been imported by me?

Q But they were imported through the American Trading Company?

A As agents of William A. Rogers Ltd.

Q On the order of Bernardo & Sons for that table-ware which forms exhibit "E", that table-ware was imported and received by the American Trading Company, wasn't it?

A I don't know.

Q Is it because you don't know or because you don't want to tell?

A My dear sir, I am not prevaricating. Sometimes they order direct and for that reason I cannot say whether I received that order direct from the factory.

Q Besides the American Trading Company having imported articles identical to exhibit "E", as you said before, have you imported or solicited orders or accepted orders for other table-ware manufactured by William A. Rogers Ltd.?

MR. FERRIER. I object to the question because it is not proper cross-examination.

THE COURT. He may answer.

MR. FERRIER. Exception.

A Yes, sir.

MR. ENRILE (continues)

Q Have you samples of those goods?

A Not here.

Q You mean to tell the Court that you have not imported, for instance, either this exhibit "4" or exhibit "5" or exhibit "6"?

A (addressing the Court) I would like not to have Mr. Ponce Enrile ask questions of this kind which tend to create the belief that I am prevaricating. I have always testified the entire truth and have no objection to answering any question asked of me, provided they are not asked in that manner. In English the question has always been asked this way: "You mean to say such or such a thing?" as if I had not wanted to tell the truth.

THE COURT. Ask the question some other way.

THE WITNESS. If you ask me if I have imported, I will say yes or no with pleasure.

MR. ENRILE. (continues)

Q You testified before that you imported goods

exactly like those of exhibit "E", and when I asked you whether you had imported other goods or whether you had received orders or accepted orders for William A. Rogers Ltd. for other articles different from exhibit "E", you answered you had not.

A No, sir; I answered I had.

Q Yes, you answered you had, and when I subsequently asked you whether you had specimens of those goods, you said you had not; now I ask you whether that answer of yours means that you have not imported these exhibits "4", "5" and "6"?

MR. FERRIER. I object to the question because it puts in the mouth of the witness a statement that he has not made.

THE COURT. I have heard well and remember what the witness answered. The witness answered that he had not now in his possession any specimens of the goods to which the question referred; but at the same time he showed something that was in the possession of his counsel.

MR. FERRIER. And immediately afterwards his counsel presented the things indicated.

THE COURT (to Mr. Enrile). Do you insist on your question?

MR. ENRILE. I only want to ask if those goods were imported by him?

WITNESS. Yes, sir; that is part of the goods of William A. Rogers Ltd. (Referring to exhibits "4", "5", and "6".)

MR. ENRILE. (continues)

Q My question is not whether or not you have the agency, and we do not arrive at a conclusion because you do not answer the questions. I ask you whether you imported or not?

A Yes, sir; I said we imported these specimens; we still have the agency.

Q Besides these specimens exhibits "4", "5", and "6" and other goods identical with exhibit "E", have you imported or solicited sales or secured orders of other articles manufactured by William A. Rogers Ltd.?

A. Yes, sir.

Q. What articles?

A I could not tell you by heart; but we have introduced table-ware.

Q What trade-mark have the goods that you have imported?

A Of the same kind, table-ware.

Q But what special mark do these goods bear?

A Exactly like that table-ware.

Q You don't remember?

A I remember very well.

Q Please describe the mark they bear?

A Here it is. (Witness writes on a piece of paper, which is marked exhibit "X")

Q You said that the number 1881 on the goods of William A. Rogers means a certain grade of those goods. What grade is that?

A First grade, which is "Heirloom Plate".

Q And the other marks of William A. Rogers Ltd. indicate different grades?

A Yes, sir.

Q So that the number 1881 does not indicate anything else but the grade?

A Not as far as I know, sir. The others we do not advertise (referring to other symbols or letters); but as far as I know, in our advertisements 1881 has no special significance, like the International which announced the year 1847 as the year when it was founded.

Q And how did you advertise this table-ware?

A We advertised it as one of our trade-marks 1881.

Q Testifying here the other day, you said you had never advertised these goods?

A I said so and I maintain it. If you ask me how the American Trading Company has advertised it, then I have not answered the question correctly; I understood that your question referred to the manner in which William A. Rogers Ltd. advertised.

Q You said this morning that the number 1847 on the goods of the International Silver Company indicates the grade of the article?

A No, sir I said that that was the date when it was founded.

Q Did you not saiy this morning, that the word "Heirloom" on the goods of William A. Rogers Ltd. indicated the highest grade of their goods, just as you said that 1847 indicates the highest grade of the International Silver Company? Did you say that this morning, or did you not?

A If I remember well, I said yes and no. Because this morning I said that the grade 1847 of the International Silver Company was equivalent to the "Heirloom Plate" of William A. Rogers Ltd. I did not say that the International Silver Company advertised its mark "1847 Plate" as its highest grade article; I said that it is actually a first-class article of theirs.

Q You said there was a factory named Rogers Bros., that you know that factory in Rhode Island?

A No, sir. I corrected this testimony when I came this afternoon, and the truth of it is that its name is Rogers Manfacturing Company and not Rogers Bros.

Q Can you tell the Court if the Rogers table-

ware was known in the Philippines before these goods were imported in the year 1924 and the year 1925?

A By hearsay or personally?

Q Personally.

A I don't know.

Q You never heard the word "Rogers" in the Philippines in connection with table ware?

A I don't remember.

Q You only learned that there was table-ware called Rogers, or that the word Rogers was used with reference to table-ware, when you began to import the table-ware of William A. Rogers Ltd.?

A By hearsay or personally?

Q I ask you whether you learned it only through having seen advertisements?

A I really don't know.

Q Where did you see those advertisements? here in Manila?

A Yes, sir.

Q In what publication did you see them?

A I don't know; I don't remember.

Q And you knew that there was much sale or acceptance of those articles or table-ware Rogers before you imported that table-ware of William A. Rogers Ltd?

A How does the counsel know that I imported?

Q I ask you?

A I did not know anything about the Rogers goods except by the advertisements; I learned of them only when I began to import goods of William A. Rogers Ltd.

Q And those advertisements which you saw here in Manila, as you say, of the Rogers table-ware, were advertisements of the firm Heacock?

A I don't remember farther back than 1923 or 1924; but I suppose it must have been Heacock's table-ware.

Q When you said that before importing the Rogers table-ware, you only knew it through advertisements, do you mean to say or give to understand that you never saw table-ware with the word Rogers stamped on it in the Philippine Islands?

A Really, I desire to state, with the leave of the Court, that this question is incorrect because in it I am threatened with having said such and such a thing.

THE COURT. What do you want to say, Mr. Ferrier?

MR. FERRIER. I have already told the colleague to avoid those preliminary phrases, to ask the question direct.

THE COURT. In order to avoid incidents of this nature which retard the completion of this case, please amend your question, Mr. Enrile.

MR. ENRILE (continues)

Q When you say that you did not know the word Rogers in connection with table-ware by the advertisements until 1924 and 1925, and that in those years you knew it because you imported the table-ware of William A. Rogers Ltd., do you mean to say or would you have us understand that during all the time that you were living here in the Philippines before 1924 and 1925, you never saw table-ware with the trademark Rogers or with the word Rogers stamped on it?

A I did not see any table-ware with the mark Rogers before that date.

Q In no part of the Philippine Islands?

A Of course not; I did not deal in silverware nor

was I interested in it, and a person who is not interested in a certain line of business would hardly pick up table-ware in the hotel where he is eating to see what is the trade-mark. I was in the paper business.

Q Is it not true that when you imported those goods, you knew that the trade-mark Rogers in connection with table-ware was so accredited throughout the Philippines that it was almost a necessity in all households?

A Of course, I did not know anything about the trademark. It is as if I asked you if you knew anything about Luna Bond. For your information I wish to tell you, however, that I then had Rogers silverware on the table in my own home.

Q Where did you buy that table-ware before 1924 and 1925?

A I dont't know; my wife probably bought it at Heacock; I don't know.

Q When you delivered the orders accepted by you to Bernardo & Sons, you knew that they packed them in boxes like exhibit "E"?

A I did not know anything; I don't solicit orders of that kind and I seldom go to those establishments; we import them in packages and deliver them that way. You can see here in these exhibits "12" and "13" how those articles were ordered.

MR. FERRIER.

Q Do you know how many copies were made when exhibits "12" and "13" were prepared in the office of the American Trading Company?

A Four.

Q They were made at the same time?

A Yes, sir.

Q Using carbon paper?

A Yes, sir.

Q That being so, can you tell us whether exhibits "12" and "13" are correct copies of their originals?

A Yes, sir, because if there had been any erasures it could be seen.

Q What has become of the original of that order?

A In this case, the original of exhibits "12" and "13", together with the original of exhibits "12-A" and "13-A", have been sent to the factory of William A. Rogers Ltd. at Niagara Falls.

Q Who, if anybody, signed the original?

A It must have been signed by the buyer, in this case by Bernardo & Sons.

Q Has any copy been given to Bernardo & Sons?

A The copies that you have in your hands now were signed by me and handed to Bernardo & Sons; they are from the files of Bernardo & Sons.

MR. FERRIER. That is all. I offer in evidence exhibit "1", an advertisement of Heacock Company appearing in the Manila Times of May 27, 1929.

MR. ENRILE. I object to exhibit "1" because it is not properly identified; morever, it is immaterial.

THE COURT. The Court will decide after all the exhibits have been offered.

MR. FERRIER. As exhibit "2", the advertisement of the International Silver Company in the Saturday Evening Post of July 21, 1928.

MR. ENRILE. I object to this exhibit because it is not properly identified and because it does not constitute any admission, action, or statement on the part of Heacock Company. The Inter-

national Silver Company is not a party in this action.

MR. FERRIER. With the leave of the Court, I shall cut out from said "Saturday Evening Post" the last page and last page but one which contain the advertisement referred to, and offer the same in order not to offer the entire publication, so as not to make the record too bulky; exhibit "3", another advertisement of the International Silver Company in the same Saturday Evening Post, issue of August 18, 1927, and with the leave of the Court I shall also cut out the last page of that number.

MR. ENRILE. The same objection as to the previous exhibit, because it is not properly identified, and supposing it is an advertisement of the International Silver Company, the International Silver Company is not a party in these proceedings and this does not constitute any admission on the part of Heacock Company.

MR. FERRIER. Answering this statement, I am going to invite Your Honor's attention to Mr. Gaches' statement that the International Silver Company is really the owner of the trademark; that if they withdraw the advertisement, they are obliged to return the mark to the International Silver Company. As exhibits "4", "5", and "6" three specimens, being silverplated table-ware manufactured by William A. Rogers Ltd. which bear as mark several words and symbols appearing on the back of the handle of each of said articles.

MR. ENRILE. Without objection as to exhibit "4", without objection as to exhibit "6". We object to exhibit "5" because there is no allegation whatever in the complaint of William A. Rogers Ltd. nor in the answer of William A. Rogers Ltd. involving the mark appearing on

the back of this exhibit.

MR. FERRIER. In answer to that I shall say that this exhibit "5" has been identified by Heacock Company's witnesses as articles sold by the American Trading Company.

MR. ENRILE. There is no question as to its having been identified; but the mark here is not involved in the litigation because there is no allegation in the complaint nor in the answer of William A. Rogers Ltd. nor in that of the American Trading Company in which this exhibit "5" is involved.

THE COURT. Another exhibit.

MR. FERRIER. As exhibits "7", "8", "9", "10", and "11", certified copies of the trade-marks registered in the United States by William A. Rogers Ltd.; as exhibits "12", "12-A", "13", and "13-A", the orders of Bernardo & Sons to the American Trading Company or the order of the American Trading Company to William A. Rogers Ltd. to send to said Bernardo & Sons the merchandise ordered by them.

MR. ENRILE. I object to exhibits "7", "8", "9", "10", and "11", in general to all of them, for the reason that they are absolutely immaterial and irrelevant as evidence, because these trade-marks have not been registered in the Philippine Islands, and in particular to exhibits "7", "8", and "9", to which I object because they are not the marks specified in the complaint of William A. Rogers Ltd. and the American Trading Company, or in the answer of the American Trading Company, and consequently these marks appearing in exhibits "7", "8", and "9" have nothing to do with this suit nor are they in controversy here. As to exhibits "12" and "13", I object to them as incompetent, immaterial, and irrelevant, and also because

they are copies, and no ground has been established for admitting those copies. As to exhibits "12-A" and "13-A", we object because they are immaterial, incompetent and irrelevant.

MR. FERRIER. As exhibit "14", the alleged list introduced by the Heacock Company, of persons to whom they have sent letters relative to the trade-marks.

MR. ENRILE. No objection.

MR. FERRIER. Exhibit "15", which is a radiogram of William A. Rogers Ltd., addressed to the American Trading Company, regarding which Mr. Presby has testified here, and exhibit "16", which is a letter addressed to the American Trading Company by the Heacock Company.

MR. ENRILE. We have no objection as regards exhibit "16" nor as regards exhibit "14"; but we object to exhibit "15" because it is immaterial and incompetent as evidence and we have not had an opportunity to cross-examine the person who makes that statement in the radiogram. Morever, a conclusion is established there that it is duly protected by patents, and that will not be proved by their statement but by the proper documents on file in the offices of the Government.

THE COURT. All the exhibits are admitted, with the exception of "15", with reference to which the objection is sustained.

MR. ENRILE. With my exception as to the exhibits objected to and admitted.

THE COURT. The hearing of these cases will be continued on the 29th of this month, at half past two in the afternoon.

MR. ENRILE. In view of the fact that the hearing of these cases has not yet been completed,

I would like to have more time for the filing of our amended answer.

THE COURT. Ten (10) days are granted.

I certify: That the foregoing is a true and correct transcript of the stenographic notes taken by me at the afternoon session of October 3, 1928, during the continuation of the hearing of these cases.

(Sgd.) SANTIAGO GUISANDI,
Official Stenographer.

Manila, P. I., October 31, 1928.

(AFTERNOON SESSION)

(CONTINUATION OF THE HEARING)

There being present the same parties and their respective counsel, before the Hon. C. A. Imperial who presides the session, the hearing of these cases was continued.

* * *

MR. ENRILE. Your Honor, in view of the decision of the Court that Mr. Ferrier show his authority to appear in behalf of William A. Rogers Ltd., I would like to have Mr. Ferrier ordered to prove his authority to represent William A. Rogers Ltd.

THE COURT. Mr. Ponce Enrile's motion for a reconsideration is denied.

MR. ENRILE. We enter our exception to the order denying our motion for a reconsideration of the motion with reference to the authority of Mr. Ferrier to represent William A. Rogers Ltd. We now ask that our amended answer be accepted.

THE COURT. The amended answer is accepted without objection.

MR. FERRIER. With Your Honor's leave I shall make a reply to the counter-complaint of H. E. Heacock Company against William A. Rogers Ltd.

MR. ENRILE. With the leave of the Court, we have here photographic reproductions of exhibits "A", "B", "C", and "D", which were the advertisements of the H. E. Heacock Company in the issues of the Manila Times marked by us as such exhibits, and which, with the leave of the Court we withdraw in order to substitute photographic reproductions for the same, and we now present these photographic reproductions in lieu of the original exhibits, they bearing the same marks, "A", "B", "C", and "D".

THE COURT. Is there any objection?

MR. FERRIER. Without objection to the admission of the photographic reproductions.

THE COURT. Admitted without objection.

MR. FERRIER. With Your Honor's leave I shall withdraw exhibits "10" and "11" and replace them by two other documents which I ask be marked as exhibits "10" and "11", which are exactly alike, with the exception that exhibits "10" and "11", previously presented, show that the trade-mark was originally registered on March 31, 1908, and June 16, 1908, respectively, and that they were renewed on April 17, 1928, and July 24, 1928, respectively. And we agree that exhibits "10" and "11", which are now offered as substitutes for both, were renewed, respectively, on April 17, 1928, and July 24, 1928.

MR. ENRILE. Without objection.

THE COURT. As requested. The substitution may be made.

MR. FERRIER. In this case, a subpoena duces tecum has been issued requiring the H. E. Heacock Company to bring certain letters exchanged between it and the International Silver Company, the manufacturer of the goods sold by the H. E. Heacock Company, bearing the alleged trade-mark Rogers. These letters have been requested on account of the statement of Mr. Gaches, manager and president of the H. E. Heacock Company, that the International Silver Company had knowledge of the present litigation. We have also required Mr. Rebullida by subpoena duces tecum to bring a certain letter which he has received from the H. E. Heacock Company, dated January 11, 1922, and Mr. Gaches has already identified the letter as being the same that he wrote. I therefore ask that this be admitted as exhibit "17".

MR. ENRILE. We state that exhibit "17" marked by Mr. Ferrier is a copy of a letter that we had in our possession, and Mr. Gaches has just informed me here that it really is the copy of a letter which he has written to Mr. Rebullida, and we now hand it to Mr. Ferrier. I have no objection to its competency as evidence, that is, because of it being a copy and of the original not being presented. I have no objection, either, as to the authenticity of said copy, but I object to it on the score of it not being material as evidence, as it has nothing to do with this case and Mr. Rebullida is not a party here.

THE COURT. Admitted without objection.

MR. ENRILE. Exception. As to the subpoena addressed to the H. E. Heacock Company, requiring them to bring here the correspondence between them and the International Silver Co., I object to said subpoena duces tecum on

the ground that it is immaterial, and also because it tends to reveal the commercial relations between the International Silver Company and the H. E. Heacock Company, and it has not been shown here that said correspondence is material, precisely because the International Silver Company is not a party in this case and any correspondence between the H. E. Heacock Company and the International Silver Company can not be material in this case, because the International Silver Co., has not been included here, either as plaintiff or as defendant.

MR. FERRIER. I do not attempt to reveal to anybody nor to the Court any secret there may exist between the International Silver Company and Messrs. H. E. Heacock Company so far as such secrets are of a commercial character; but Mr. Gaches has testified here that it was the International Silver Company which manufactured the goods that they were selling here and which bear the alleged trade-mark Rogers; and Mr. Gaches has also testified here that if there was any difference between the International Silver Company and the H. E. Heacock Company with reference to that trade-mark, the H. E. Heacock Company would probably transfer that trade-mark to the International Silver Company. Mr. Gaches further testified that the International Silver Company had knowledge of this litigation and that fact appeared in letters received by his company and in letters addressed to the International Silver Company by the H. E. Heacock Company; and he also testified that those letters are in the possession of the H. E. Heacock Company, either the original sent to the H. E. Heacock Company by the International Silver Company, or copies of the letters sent.

by the H. E. Heacock Company to the International Silver Company. We have requested that those letters be produced.

THE COURT. The objection is sustained and the subpoena issued by the Clerk of the Court is cancelled.

MR. FERRIER. With my exception.

MR. ENRILE. We close our evidence.

THE COURT. Each counsel is given 15 days to file written reports, beginning with Mr. Ferrier.

I CERTIFY: That the foregoing is a true and correct transcript of the stenographic notes taken by me on October 31, 1928, during the continuation of the hearing of these cases.

(Sgd.) SANTIAGO GUISANDI,
Official Stenographer.

(I)

DOCUMENTARY EVIDENCE

EXHIBIT "A" is an Ad. in the *Manila Times* of October 4, 1905, by H. E. Heacock Co., advertising Rogers Silver-Plated Ware and other articles.

EXHIBIT "B" is an Ad. in the *Manila Times* of October 7, 1905, by H. E. Heacock Co., advertising Rogers Silver-Plated Ware and other articles.

EXHIBIT "C" is an Ad. in the *Manila Times* of October 9, 1905, by H. E. Heacock Co., advertising Rogers Silver-Plated Ware and other articles.

EXHIBIT "D" is an Ad. in the *Manila Times* of November 8, 1905, by H. E. Heacock Co., advertising Rogers Silver-Plated Ware and other articles.

EXHIBIT "E" is a box containing fifty-one pieces of tablewares marked "Wm. A. Rogers Nickel Silver".

EXHIBIT "F" is a box containing fifty-one pieces of tablewares marked "Rogers Nickel Silver".

EXHIBIT "G"

B. C. AND I. FORM NO. 131.

THE GOVERNMENT OF THE PHILIPPINE ISLANDS
Department of Commerce and Communications
Bureau of Commerce and Industry
MERCANTILE REGISTER

TO ALL PERSONS TO WHOM THESE PRESENTS SHALL COME, GREETING:

This is to certify that the annexed is a true copy from the records of the Mercantile Register, Bureau of Commerce and Industry, of the Certificate of Registration, Statement, Declaration and Drawing, relative to the trade-mark "ROGERS" registered in this office on June 27, 1918, under serial No. 2251, by H. E. Heacock Co., of Manila, Philippine Islands, for spoons and other flatware whether nickel, silver plated or silver, as well as nickel, silver or silver goods of all kinds save and except cutlery.

In testimony whereof I have hereunto set my hand and caused the seal of the MERCANTILE REGISTER, BUREAU OF COMMERCE AND INDUSTRY, to be affixed at the City of Manila, this 30th day of July, in the year of our Lord one thousand nine hundred and twenty-eight.

(SEAL)
(DOCUMENTARY STAMP)

(SGD.) FIDEL A. REYES
Director

No. 2251

B. C. AND I. FORM NO. 84

THE GOVERNMENT OF THE PHILIPPINE ISLANDS
Department of Commerce and Communications
Bureau of Commerce and Industry
MERCANTILE REGISTER

TO ALL TO WHOM THESE PRESENTS SHALL COME, GREETING:

This is to certify that by the records of the Mercantile Register, Bureau of Commerce and Industry, it appears that H. E. Heacock Co. of Manila, Philippine Islands did, on the 24th day of May, 1918, deposit in said Mercantile Register for REGISTRATION facsimiles of a TRADE-MARK for spoons and other flatware whether nickel, silver plated or silver, etc., and the date of the receipt thereof was duly noted and recorded; that on the 24th day of

May, 1918, it deposited therewith a statement and a written declaration under the oath of Samuel F. Gaches, President, copies of which are hereto annexed; and the said company having made the payment of a fee of TWENTY-FIVE DOLLARS, and complied with the regulations in such cases prescribed by the Director and in all other respects complied with an Act of the Philippine Commission approved March 6, 1903, entitled "An Act defining property in Trade-Marks and in Trade-Names and providing for the protection of the same, defining unfair competition and providing remedies against the same, providing registration for Trade-Marks and Trade-Names, and defining the effect to be given to registration under the Spanish Royal Decree of eighteen hundred and eighty-eight relating to the registration of Trade-Marks and the effect to be given to registration under this Act," and its amendments, the said facsimiles, statement, and declaration were duly recorded, and the said Trade-Mark has been duly registered in the said Mercantile register this 27th day of June, one thousand nine hundred and eighteen, and protection therefore, will remain in force for THIRTY YEARS from said date unless sooner terminated in accordance with section 17 of said Act of March 6, 1903, as amended.

In testimony whereof I have hereunto set my hand and caused the seal of the Mercantile Register, Bureau of Commerce and Industry, to be affixed

(SEAL) at the City of Manila, this twenty-seventh day of June, in the year of our Lord one thousand nine hundred and eighteen.

(SGD.) FIDEL A. REYES
Assistant Director

(Certified Copy)

THE GOVERNMENT OF THE PHILIPPINE ISLANDS
Department of Commerce and Communications
Bureau of Commerce and Industry
MERCANTILE REGISTER

Manila, P. I., May 22, 1918.

To the Chief of the Division of
Archives, Patents, Copyrights and
Trade-Marks,
Manila, P. I.

Sir:

The undersigned presents herewith five facsimiles of its lawful trade-mark, and requests that the same, together with the accompanying statement and declaration, may be registered in the Division of Archives, Patents, Copyrights, and Trade-Marks in accordance with the law in such cases made and provided.

H. E. HEACOCK CO.
By: (SGD.) SAMUEL F. GACHES

"ROGERS"

(Certified Copy)

THE GOVERNMENT OF THE PHILIPPINE ISLANDS
Department of Commerce and Communications
Bureau of Commerce and Industry
MERCANTILE REGISTER

STATEMENT

TO ALL WHOM IT MAY CONCERN:

Be it known that H. E. HEACOCK CO., a corporation organized under the laws of the Philippine Islands, and located in the City of Manila, has adopted for its use a trade-mark for spoons and other flatware whether nickel, silver plated, or silver, as well as nickel, silver plated and silver goods of all kinds save and except cutlery, of which the following is a description:

The trademark consists of the word "ROGERS", in ordinary Roman capitals.

The trade-mark has been continuously used in the business of said corporation for fifteen years.

The class of merchandise to which this trademark is appropriated is spoons, and other flatware whether nickel, silver plated or silver, as well as nickel, silver plated or silver goods of all kinds save and except cutlery.

The trade-mark is applied or affixed to the goods by stamping or engraving, or applying the same in any other suitable manner to the back bot-

tom, side, edge, or top of the goods wherever convenient, and is also applied by printing upon labels placed upon the packages containing the goods.

H. E. HEACOCK CO.
By: (SGD.) SAMUEL F. GACHES

Witnesses:
(SGD.) JERONIMO ORTEGA
(SGD.) FRANCISCO M. BAZA

(Certified Copy)
THE GOVERNMENT OF THE PHILIPPINE ISLANDS
Department of Commerce and Communications
Bureau of Commerce and Industry
MERCANTILE REGISTER

DECLARATION

UNITED STATES OF AMERICA
PHILIPPINE ISLANDS } SS.
CITY OF MANILA

Samuel F. Gaches, being duly sworn deposes and says: That he is the President of the firm of H. E. Heacock Co., the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said firm at this time has a right to the use of the trade-mark therein described; that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance there-

to as might be calculated to deceive; that the trade-mark is used by the said corporation in commerce in the Philippine Islands, and that the description and facsimiles presented for record truly represent the trade-mark sought to be registered.

(SGD.) SAMUEL F. GACHES
Cedula No. F-114 issued at Manila,
January 2nd, 1918.

Sworn to and subscribed before me, a notary public, the 22nd day of May, 1918.

(SGD.) A. DE ABOITIZ PINAGA
Notary Public.
Commission expires December 31st, 1918.

Doc. No. 57
Pag. No. 15.
Series of 1918.

Affixed one documentary stamp of 20 centavos and the official seal of the Notary Public.

EXHIBIT "H-1"

Allen, Samar, P. I.
August 6, 1928.

H. E. Heacock Co.,
Escolta, Manila

Gentlemen:

The undersigned being desirous of buying table wares marked "ROGERS" from your establishment, and not having any catalogue and list of

prices of said table wares, hereby request that you send him one of your catalogues regarding said table wares at the above address.

Hoping to receive the favor requested, I remain,

Yours very respectfully,

(SGD.) IÑIGO I. RESULTA,
Allen, Samar, P. I.

EXHIBIT "H-2"

MEMORANDUM

VALENTIN RIVERA
Jeweler
P. O. Box 69 Tel. 83
Lucena, Tayabas

August 7, 1928
H. E. Heacock Co.,
Wholesale Dept.,
Escolta, Manila

My dear Sir:

Enclosed I am sending you a check of the National Bank in the sum of ₱500.00, which kindly credit to my account.

I have still consigned goods in my possession unsold; also if not inconvenient please send me the following:

2 Sets only—110 pieces Ross P75A Porcelain Dinner Ware.

1 Rogers School Set—#676F Clinton Pattern, 6 Pieces with case.

6 Only Fountain Pen Heacock Automatic
6 " " " " Special.

That is all, I remain,

Yours respectfully,
(SGD.) VALENTIN RIVERA
April 12, 1928

Order No. 18
Mr. H. E. Heacock Co. When:
Send to Dionicio Doliente Value: P75.
Bolbok, Batangas
Via Batangas,
Conditions: Thirty days

1 Set (51) Silver Ware,
Rogers 66' to be engraved
with the following initials:
G. C. D.

D. DOLIENTE
Date 3/18/26

Order No.
H. E. Heacock Co. Manila.
Ship to Mr. Francisco Robles
At San Juan de Bolbok, Bat.
How Ship: Via Candelaria, Tay.
Terms:
Salesman: Exconde

When: Soon as possible
Buyur .....

1 Set—26 Pieces Clinton
—1 Rogers Silver
lated Ware.....

Note: Please send by regular freight.
Express, directly

GIL EXCONDE

EXHIBIT "H-3"

P. O. Box 51 100 Aguinaldo St.

RUFINO S. LIABRES

Books, Magazines, Pictures, Office and School Supplies, Rubber Stamps, Jewels, Clocks, Watches, Bicycles, Typewriters, Office Equipments, Sporting Goods, Phonographs and Records, Kodak Films, Albums, Religious and Church Goods, Groceries, Breads, Etc.

BATANGAS, BATANGAS.

SALES AGENT FOR:

Philippine Education Co., Inc.
American Electric Co., Inc.
E. C. Arellano & Sons
Frank & Company
Manila

H. E. Heacock Company
Catholic Trade School
C. Alcan, Inc.
La Patria
Manila

March 23, 1928.

H. E. HEACOCK COMPANY
Wholesale Department
127 Escolta, Manila.

Gentlemen:

Please ship to me by express train at your earliest possible convenience to arrive here before the closing of the present school year which will take place on the 28th of March:

1 set (51 pieces) Silver Plated Ware, Rogers 66, No. 809-F "Mayfair"—to be engraved with the following initials—T. V. C.—as per order attached.

I hope to receive the above order on time.

I am enclosing herewith a check for ₱200.00 for which amount, please enter it to our credit on your books.

Please send me also as soon as possible the other watches I sent you for repair immediately after finish.

Very truly yours,
(SGD.) RUFINO S. LIABRES.

Encl.: Check
Order—do not duplicate
1 order for consignment.

Sariaya, Tayabas, P. I.
May 8, 1927

Messrs. H. E. Heacock Co.,
Manila

Sirs:

Please send me the following article as soon as possible and enter same under my Regular Account:

One ROGERS SCHOOL SET No. 637 F, Mayfair Pattern, 5 pcs., Paper Box, p. R44.

It is also requested that the initials "JBL" be put on each piece.

Also I desire to inquire whether my two watches have already been repaired. The owners should like to get same as soon as possible.

If you have already got in stock of the SIMMON WATCH CHAINS PLEASE SEND me four with the above order and enter same under my Consignment Memo. Account.

Respectfully,

(SGD.) JUANITA R. VDA. DE MENDOZA
NICANDRO & FABELLA
Pagsanjan, Laguna

November 17, 1926

Messrs. H. E. Heacock Co.
Manila
Gentlemen:—

Please send us by casco DENCIA #2266 the following:

CARMEN F-29A

1. Doz. Tea cups and Saucers
1. Doz. Coffee cups and Saucers
1. Doz. Breakfast plates

CATALOG Rose F-75A
R

2. Doz. A. D. Coffee cups and Saucers
2. MAHOGANY CLOCK-A629-11 x 26, 8 inches square dial, 8 days trike
2 CHESTS OF 26 Pieces—Rogers Nickal Silver 791—F Montrose

Kindly be advised that all shipment to us must be by CASCO DENCIA #2266.

Our sales is fast improving and may place more order by next week.

Very truly yours,
NICANDRO & FABELLA
By: RAMON FABELLA.

M. COUTO & SONS
Merchants
P. O. Box 466
Manila

ORDER No. 13538

Correspondence and Bill of Lading—Spanish, English.

Messrs. H. E. Heacock & Co.
Manila

Please send to Utoomall Naroomall, P. O. Box No. 66 of Davao the following articles, consigned to ..... of ..... via .....

Reference: Parroquiano.

Period... date, bill of lading, payable in Manila.

This order is subject to the approval of the vendor.

The prices and goods set forth in this order shall be understood to be unconditional except in cases of variation.

Amount	Goods	Discount	Price Pesos Cent.	Total Pesos Cent.
5	Pairs Table Wares Rogers Nickel Silver 51 pieces	25%	40.00	
1	Only Image of the Sacred Family #F315	20%	22.50	
2	Simmons Chains V-176	Net	6.00	

Manila, May 17-26

U. Naroomall

(SGD.) JOSE COUTO.

M. COUTO & SONS
Merchants
P. O. Box 466
Manila

ORDER No. 14319

Correspondence and Bill of Lading—Spanish, English.

Messrs. H. E. Heacock & Co.
Manila

Please send to U. Naroomall, P. O. Box No.... of Davao the following articles, consigned to..... via Davao.....

Reference: Parroquiano de la Pan

Period 30 days, bill of lading, payable in Manila.

This order is subject to the approval of the vendor.

The prices and goods set forth in this order shall be understood to be unconditional except in cases of variation.

Amount	Goods	Discount	Price Pesos Cent.	Total Pesos Cent
1	Rogers School Sets 676F			

Davao, Nov. 18, 1927.

(SGD.) ILLEGIBLE.

EXHIBIT "H-4"

MEMORANDUM

VALENTIN RIVERA
Jeweler
P. O. Box 69 Tel. 83
Lucena, Tayabas

#793F—1Box of table wares *Mayfair* Rogers, silver-plated—26 pieces.

Engraving No. 2.
Initials:

Dr.	B. M. V.—4	pieces
	L. J. P.—4	pieces
	S. J. P.—4	pieces
	P. Z. V.—4	pieces
	T. P. L.—4	pieces
Mrs.	M. C. V.—6	pieces.
	26	pieces.

MEMORANDUM

VALENTIN RIVERA
Jeweler
P. O. Box 69 Tel. 83
Lucena, Tayabas

May 26, 1928
H. E. Heacock Co.
Escolta, Manila

Dear Sirs:

Please send us one only set Tableware No. 792F Montrose, 51 pieces, Rogers Nickel Silver for which please engrave 3 initials as per your catalogue, page 8-48 engraving No. 2. We have sold this Tableware and need a free initials on it and am sure we will be given free initials on every sales we made if initials is requested to us.

Hoping to receive the Tableware on the return mail.

Thanking you for an advance, I remain,

Very respectfully yours,

VALENTIN RIVERA

By:

(SGD.) VITO ESTRELLADO.

Incl:

The 3 Initials

Engraving No. 2.—F. M. V.

MEMORANDUM

VALENTIN RIVERA
Jeweler
P. O. Box 69 Tel. 83
Lucena, Tayabas

F. M. V.
Engraving #2

MEMORANDUM

VALENTIN RIVERA
Jeweler
P. O. Box 69 Tel. 83
Lucena, Tayabas

May 26, 1928
H. E. Heacock Co.
Escolta, Manila.

Dear Sirs:

Please send us one only set Tableware No. 798 F MAYFAIR Rogers—26 pieces silver plated ware with Initials as follows:

Dr. B. M. V.—4 pieces
L. J. P.—4 pieces
S. J. P.—4 pieces
P. Z. V.—4 pieces
T. P. L.—4 pieces
Mrs. M. C. V.—6 pieces including the 2 Extras

26 pieces in all or one box of 26 pieces Tableware.

Hoping to receive as early a date possible as will be convenient to you.

Many thanks.

Very respectfully yours,
VALENTIN RIVERA
By (SGD.) VITO ESTRELLADO

EXHIBIT "H-5"

Importers & Specialist in Jewelry

Cable Address "Ramo"

Branches
Iloilo, Iloilo
Tacloban, Leyte
Baclayon, Bohol
Tagbilaran, Bohol

HEAD OFFICE
Phone 553 498—504 Manalili Street
P. O. Box 52
CEBU, CEBU, P. I.

RAMO HERMANOS
General Merchants

Cebu, Cebu, P. I., Sept. 9, 1927.

H. E. Heacock Co.
127-131 Escolta, Manila, P. I.

My dear sir:

We have received your kind letter of August

20th last and have been informed of the contents thereof. In reply thereto we beg to state the following:

Regarding your shipment of watches, fountain pens, and watch chains, we have received them in good condition, and inasmuch as these goods are not our order, we have to return to you all those not sold within the period appearing in your bill of lading #16032 E.

Regarding the images, we have already sold three of the same to the present time, and we will see if we could sell some more.

We have the honor to inform you that on the first and second instant we have twice purchased table wares marked Roger, consisting of 51 pieces, from your branch here in Cebu. The total of our purchases is ten sets.

This is all, and thanking you for the favors, we remain always,

Yours very respectfully,
RAMO HERMANOS
By: ALEJANDRO RAMOS.

EXHIBIT "H-6"

Telephone No. 41 Telegraphic Address "Lalman"

BOMBAY BAZAAR
Lalchand & Mangharam
Direct Importer of European & Oriental Art Goods
Sanchez Street
P. O. Box 44
Jolo, Sulu, P. I.
July 28, 1927.

Messrs. H. E. Heacock & Co.
Manila, P. I.

Gentlemen:

Enclosed herewith is a check No. 544628 C

for ₱800.75, and please credit to our account the sum of ₱800.00, and the remaining ₱.75 as commission of the check. Please acknowledge receipt.

Referring to your letter of the 12th inst. relative to the six sets of tableware which we returned to you, and you refused to accept same, we wish to state that we are sorry very much that it happened in this way, and beg to state that these tableware could not be sold here, for the reasons that the people in this place are mostly mohammedans, and naturally they always buy the cheap kinds, so this is the very reasons why we are forced to return them. But if you still insist to refuse accepting these wares, we ask your kindness to make another arrangements, that is, to send us six sets of Silver-nickel Rogers Tablewares in its place, and credit to us the difference.

We know that what has happened in this order has troubled you much, and even before, but as we have stated above that those things we returned in your previous dealings with you were the same things as what it happened now, we were forced to return things to you for the same reasons that those expensive tablewares could hardly be sold here, unless what we order from are placed to us under special order from our customers, but in this case, we ordered them to keep in stock for sale, but as we said that expensive tablewares are hard to sell within a short time.

We are therefore returning back to you the sets, with the hope to send us six sets of tablewares "Rogers Nickel Silver" in exchange of the above, and credit us the difference.

Thanking you for the trouble, we beg to remain,

Very truly yours,

LALCHAND & MANGHARAM

By (Sgd.) M. KHEMCHAND.

EXHIBIT "H-7"

Telephone No. 41 Telegraphic Address "Lalman"

BOMBAY BAZAAR
LALCHAND & MANGHARAM
Direct Importer of European & Oriental Art Goods

Sanchez Street
P. O. Box 44
Jolo-Sulu, P. I.
October 22, 1926.

Messrs. H. E. Heacock & Co.
Manila, P. I.

Gentlemen:

Please send to us on first available transportation one (1) set of Rogers 66 Silver plated Ware 801F Clinton, 51 pieces, No. 27, and charge same to our current account.

Sometime ago we placed an order of Junior Parker Fountain Pen, if you have them in stock now please send to us three on first mail as we are entirely sold out of this pen.

In this connection we wish to advise you that by the end of this month we shall remit you payment of our due account.

Hoping to receive our orders in the near future, we beg to remain,

Very truly yours,
LALCHAND & MANGHARAM
By (Sgd.) M. KHEMCHAND
Member.

EXHIBIT "I" is a silver-plated sugar bowl bearing the mark "1847 Rogers Bros."

EXHIBIT "K" is an individual set of silver-plated flatware, consisting of one knife, one fork, one tablespoon and one teaspoon, marked "1847 Rogers Bros." except the knife which is marked "INSICO Stainless".

EXHIBIT "L" is another individual set of silver-plated flatware, consisting of one knife, one fork, one tablespoon, and one teaspoon, marked "Wm. Rogers & Son AA."

EXHIBIT "M" is another individual set of silver-plated flatware consisting of one knife, one fork, one tablespoon, and one teaspoon, marked "Wm. Rogers & Son".

EXHIBIT "I"

THE TOTAL NUMBER FOR SILVERWARE BUYERS

E. R. REACOCK CO.

(Advertisement in The Morning Herald
of May 22, 1847)

EXHIBIT "F"

ON THE TABLE OF AMERICA'S FIRST
FASHION SINCE 1847

(EIGHTEEN FORTY-SEVEN)
THE 97-YEAR PLATE

How long should your dinnerside values....
in its beauty and its workmanship?

Begin your service in 1847 ROGERS BROS. with THE PIECES OF 8....covers for eight in knives, forks and spoons at $43.75. Next, add THE PIECES OF CHARM, the fancy pieces in flatware, such as bouillon spoons, oyster forks, tomato servers, berry spoons....at prices surprisingly moderate....Select, next, the appropriate holloware, in the pattern matching your flatware; dinner sets, coffee services, urns and candelabra....And the *piece de résistance* for your service should be a formal dinner set in PLATE D'OR, the new and gorgeous gold finish in 1847 ROGERS BROS. ware (All prices slightly higher in Canada)

MAY WE SEND YOU THE FASCINATING BUDGET BOOK?...telling of a new and delightful way to acquire an all-embracing service in silverplate..... with pleasing speed and painless thrift.... Write for Booklet U90 to International Silver Company....Department E....Meriden, Connecticut.

THE ARGOSY PATTERN

Other Pattern:
Ambassador
Ancestral
Anniversary

1847 ROGERS BROS.
SILVERPLATE
INTERNATIONAL SILVER CO.

Salesrooms: New York, Chicago, San Francisco

Canada: International Silver Co. of Canada, Limited, Hamilton, Ontario.

(Advertisement in the Saturday Evening Post of July 21, 1928)

EXHIBIT "3"

ON THE TABLES OF AMERICA'S FIRST FAMILIES SINCE 1847

(EIGHTEEN FORTY-SEVEN)

THERE IS BUT ONE!

So recognized is the leadership of 1847 ROGERS BROS. Silverplate in the field of fine silverware, that others often seek to suggest its quality by similar sounding names.....But sateen is not satin. Those who go part way in name, seldom go all the way in quality and craftsmanship.

The complete trade mark enchased on every piece thus: 1847 ROGERS BROS. insures your complete satisfaction through a lifetime of silver service....There is but one 1847 ROGERS BROS. Silverplate. In service for 80 years, it is guaranteed without time-limit.

Nothing so bespeaks the refinement and distinction of the home as a silver service of matching pieces. Such a service...in 1847 ROGERS BROS. Silverplate..... may be assembled in a leisurely, inexpensive manner, as your needs and your purse dictate.

The pieces of 8 Set forms the logical basis of a matching service..eight of each in knives, forks and spoons....(Priced at $43.75).....Then pieces of charm in the same pattern... butter spreaders (8 for $8.30), salad forks (8 for $10.00), bouillon spoons (8 for $9.65), serving pieces and the other incidentals of the well-appointed table. These may be purchased separately or as a set.....
Finally, appropriate hollow ware; dinner and coffee sets, handsome ornamental pieces....to complete a service of matching and matchless beauty. (All prices slightly higher in Canada.)

THE AMBASSADOR PATTERN
Cold Meat Fork..$2.50
Other Patterns: Argosy
Ancestral, Anniversary
1847 ROGERS BROS.
SILVERPLATE
INTERNATIONAL SILVER CO.

May we send you the fascinating Budget Book? .....telling of a new and delightful way to acquire an all-embracing service in silverplate..... with pleasing speed and painless thrift....Write for Booklet V-90 to International Silver Company ....Department E....Meriden, Connecticut. Salesrooms: New York, Chicago, San Francisco.. Canada: International Silver Company of Canada, Limited, Hamilton, Ontario.
(Advertisement in the Saturday Evening Post of Aug. 18, 1928)

EXHIBIT "4" is a silver-plated fork marked "W. R."

EXHIBIT "5" is a silver-plated tablespoon marked "Wm. A. Rogers".

EXHIBIT "6" is a silver-plated tablespoon marked "1881 (R) ROGERS (R) A-1".

EXHIBIT "7"

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DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE

TO ALL PERSONS TO WHOM THESE PRESENTS SHALL COME, GREETING:

This is to certify that the annexed is a true copy from the records of this office of the Certificate of Registration, Statement, Declaration, Drawing and Certificate of Renewal in the matter of the

Trade-Mark Registered by
Wm. A. Rogers Limited,
June 26, 1906, Number 54,731;
Renewed: April 18, 1926.

The certificate of registration was granted for the term of twenty years, and so far as is disclosed by the records of this office, said certificate is still in full force and effect, being renewed from June 26, 1926 for twenty years.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this thirty-first day of January in the year of our Lord one thousand nine hundred and twenty-eight and of the Independence of the United States of America the one hundred and fifty-second.

(SEAL)

THOMAS E. ROBERTSON
Commissioner of Patents.

Attest:

(SGD.) D. E. WILSON
Chief of Division

U. S. Government Printing Office: 1927.
2-372

No. 54, 731

THE UNITED STATES OF AMERICA,
TO ALL TO WHOM THESE PRESENTS SHALL COME:

This is to certify That by the records of the

UNITED STATES PATENT OFFICE it appears that Wm. A. Rogers Limited, of New York, N. Y., a corporation organized under the laws of the Province of Ontario, did, on the 25th day of May, 1905, duly file in said Office an application for REGISTRATION of a certain

TRADE-MARK

for Silver-Plated Flat Ware, Hollow Ware, and Tableware, that it duly filed therewith a drawing of the said TRADE-MARK, a statement relating thereto, and a written declaration, duly verified, copies of which are hereto annexed, and has duly complied with the requirements of the law in such case made and provided, and with the regulations prescribed by the COMMISSIONER OF PATENTS.

And, upon due examination thereof, it appearing that the said applicant is entitled to registration of its said TRADE-MARK under the law, the said TRADE-MARK has been duly registered to Wm. A. Rogers Limited, and its successors or assigns, in the UNITED STATES PATENT OFFICE, the 26th day of June, 1906.

This certificate shall remain in force for TWENTY YEARS, unless sooner terminated by law.

In testimony whereof I have hereunto set my hand and caused the seal of the PATENT OFFICE to be affixed, at the

(SEAL) city of Washington, this twenty-sixth day of June, in the year of our Lord one thousand nine hundred and six, and of the Independence of the United States the one hundred and thirtieth.

(SGD.) E. B. MOORE,
Acting Commissioner of Patents.

RENEWED
TRADE-MARK

No. 54, 731 REGISTERED JUNE 26, 1906.

WM. A. ROGERS LIMITED.

SILVER PLATED FLAT WARE, HOLLOW WARE, AND TABLEWARE,

Application Filed May 25, 1905.

EXTRA (Coin) PLATE
(Silver)

Witnesses:
(Sgd.) C. H. WILSON
" ALEX. SCOTT

Proprietor.
(Sgd.) WM. A. ROGERS LIMITED
By WARFIELD & DUELL
Attorneys.

RENEWED
UNITED STATES PATENT OFFICE.

WM. A. ROGERS LIMITED, OF NEW YORK, N.Y.

TRADE-MARK FOR SILVER-PLATED FLAT WARE, HOLLOW WARE, AND TABLE-WARE.

No. 54,731. Statement and Declaration. Registered June 26, 1906.

Application filed May 25, 1905, Serial No. 6,568.

Used ten years.

STATEMENT

TO ALL WHOM IT MAY CONCERN:

Be it known that the Wm. A. ROGERS LIMITED, a corporation duly organized and existing under and by virtue of the laws of the Province of Ontario, Dominion of Canada, and located in the city of New York, county of New York, in the State of New York, and doing business at No. 12 Warren street, in said city of New York, has adopted for its use a trade-mark, of which the following is a description.

The trade-mark, as shown in the drawing, comprises a pair of opposed braces. Arranged upon either side of the braces are the words "Extra" and "Plate," and within the braces are the words "Coin Silver."

The trade-mark has been continuously used in the business of said corporation since a date prior to February 20, 1895.

The class of merchandise to which the trade-mark is appropriated is silverware, and the particular description of goods comprised in said class upon which said trade-mark is used is silver-plated flat ware, hollow ware, and tableware.

The trade-mark is usually displayed upon the goods themselves by stamping it thereon or otherwise associating it therewith, on packages and cases containing the goods, on labels used in connection therewith, and by otherwise associating it with the manufacture, use, and sale of said goods.

WM. A. ROGERS LIMITED,
By WILLIAM A. ROGERS,
Manager.

DECLARATION

State of New York, county of Niagara, ss.:

W. A. JAMIESON, being duly sworn, deposes

and says that he is general supt. of WM. A. ROGERS, LTD., the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by the said corporation in commerce among the several States of the United States, and particularly between New York, Pennsylvania, Illinois and California; and between the United States and foreign nations, and particularly between the United States and the Dominion of Canada; and that the description, drawing, and facsimiles presented truly represent the trade-mark sought to be registered; and that the mark has been in actual use as a trade-mark of the applicant, or its predecessors from whom it derived title, for ten years next preceding the passage of the act of February 20, 1905, and that, to the best of his knowledge and belief, such use has been exclusive.

W. A. JAMESON.

Subscribed and sworn to before me, a notary public, this 23d day of December, 1905.

(L. S.)

FIRNUM G. ANDERSON,
Notary Public.

2—372

No. 54,731

THE UNITED STATES OF AMERICA

Application having been made by Wm. A. Rogers Limited, of New York, N. Y., a corporation of Ontario, Canada, for renewal of Certificate of Regis-

tration of Trade-Mark No. 54,731, registered June 26, 1906, to Wm. A. Rogers Limited, for Silver-plated flat ware, hollow ware, and tableware, and the renewal fee required by law having been paid, this is to certify that said certificate of Registration No. 54,731, has been renewed and will remain in force for twenty years from June 26, 1926, unless sooner terminated by law.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington, this 13th day of April, 1926.

(SEAL)

(SGD.) THOMAS E. ROBERTSON
Commissioner of Patents.

ATTEST:
(SGD.) G. P. TUCKER
Law Examiner.

EXHIBIT "8"

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DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE

TO ALL PERSONS TO WHOM THESE PRESENTS SHALL COME, GREETING:

This is to certify that the annexed is a true copy from the records of this office of the Certificate of Registration, Statement, Declaration and Drawing in the matter of the

Trade-Mark Registered by
Wm. A. Rogers, Limited,
February 6, 1917, Number 115,395.

The certificate of registration was granted

for the term of twenty years, and so far as is disclosed by the records of this office, said certificate is still in full force and effect.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this thirty-first day of January in the year of our Lord one thousand nine hundred and twenty-eight and of the Independence of the United States of America the one hundred and fifty-second.

(SEAL)

THOMAS E. ROBERTSON
Commissioner of Patents.

ATTEST:
(Sgd.) D. E. WILSON
Chief of Division

U. S. Government Printing Office: 1927
2-372

No. 115395

THE UNITED STATES OF AMERICA,
TO ALL WHOM THESE PRESENTS SHALL COME:

This is to certify that by the records of the UNITED STATES PATENT OFFICE it appears that WM. A. ROGERS, LIMITED, of New York and Niagara Falls, New York, a corporation organized under the laws of the Province of Ontario, did, on the 23d day of April, 1915, duly file in said Office an application for REGISTRATION of a certain

TRADE-MARK

for SILVER-PLATED FLAT AND HOLLOW WARE AND CUTLERY, that it duly filed therewith a drawing of the said TRADE-MARK, a statement relating thereto, and a written declaration, duly verified, copies of which are hereto annexed, and has duly complied with the requirements of the law in such case made and provided, and with the regulations prescribed by the COMMISSIONER OF PATENTS.

And, upon due examination thereof, it appearing that the said applicant is entitled to registration of its said TRADE-MARK under the law, the said TRADE-MARK has been duly REGISTERED to Wm. A. Rogers, Limited, its successors or assigns, in the United States Patent Office, this sixth day of February, 1917.

This certificate shall remain in force for TWENTY YEARS, unless sooner terminated by law.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of the PATENT OFFICE to be affixed, at the city of Washington, this sixth day of
(SEAL) February, in the year of our Lord one thousand nine hundred and seventeen and of the Independence of the United States the One hundred and forty-first.

(SGD.) R. F. WHITEHEAD
Acting Commissioner of Patents.

UNITED STATES PATENT OFFICE.

WM. A. ROGERS, LIMITED, OF NEW YORK AND NIAGARA FALLS, NEW YORK.

TRADE-MARK FOR SILVER-PLATED FLAT AND HOLLOW WARE AND CUTLERY.

115,395. Registered, Feb. 6, 1917.

Application filed April 28, 1915. Serial No. 86,155.

STATEMENT

TO ALL WHOM IT MAY CONCERN:

Be it known that Wm. A. Rogers, Limited, a corporation duly organized and existing under and by virtue of the laws of the Province of Ontario, Dominion of Canada, and located in the city of New York, county of New York, in the State of New York, doing business at No. 12 Warren Street, in said city of New York, and having a manufacturing establishment of Niagara Falls, county of Niagara, State of New York, has adopted for its use the trade-mark shown in the accompanying drawing, for silver-plated flat and hollow ware and cutlery, in Class No. 28, Jewelry and precious-metal ware.

The trade-mark has been continuously used in the business of said corporation since March 19, 1915.

The trade-mark is usually displayed upon wrappers and upon boxes containing the goods, or by otherwise associating it with the manufacture, use and sale of said goods.

WM. A. ROGERS, LIMITED,
By S. J. MOORE,
President.

HEIRLOOM DECLARATION.

State of New York, county of New York, ss.:

S. J. MOORE, being duly sworn, deposes and

says that he is president of the corporation, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by the said corporation in commerce among the several States of the United States; that the drawing presented truly represents the trade-mark sought to be registered; that the specimens show the trade-mark as actually used upon the goods; that one of the manufacturing establishments of said corporation is located at Niagara Falls, county of Niagara, State of New York, and that the goods claimed in this application are the products of such establishment and of other manufacturing establishments of said corporation within the United States.

S. J. MOORE.

Subscribed and sworn to before me, a notary public, this 22nd day of April, 1915.

(L. S.) C. J. KULBERG.
Notary Public.

Copies of this trade-mark may be obtained for five cents each, by addressing the "Commissioner of Patents, Washington, D. C."

EXHIBIT "9"

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

TO ALL PERSONS TO WHOM THESE PRESENTS SHALL COME, GREETING:

This is to certify that the annexed is a true

copy from the records of this office of the Certificate of Registration, Statement, Declaration and Drawing in the matter of the Trade-Mark Registered by

Wm. A. ROGERS, LIMITED,

May 19, 1914. Number 97, 079.

The certificate of registration was granted for the term of twenty years, and so far as is disclosed by the records of this office, said certificate is still in full force and effect.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this thirty-first day (SEAL) of January in the year of our Lord one thousand nine hundred and twenty-eight and of the Independence of the United States of America the one hundred and fifty-second.

THOMAS E. ROBERTSON
Commissioner of Patents.

ATTEST:

(SGD.) D. E. WILSON
Chief of Division

U. S. Government Printing Office: 1927
2-372

No. 97079

THE UNITED STATES OF AMERICA,

TO ALL TO WHOM THESE PRESENTS SHALL COME:

THIS IS TO CERTIFY that by the records of

the UNITED STATES PATENT OFFICE it appears that WM. A. ROGERS, LIMITED, of New York and Niagara Falls, New York, a corporation organized under the laws of the Province of Ontario, did, on the 2nd day of October, 1913, duly file in said Office an application for REGISTRATION of a certain

TRADE-MARK

for SILVER-PLATED FLAT AND HOLLOW WARE AND CUTLERY, that it duly filed therewith a drawing of the said TRADE-MARK, a statement relating thereto, and a written declaration, duly verified, copies of which are hereto annexed, and has duly complied with the requirements of the law in such case made and provided, and with the regulations prescribed by the COMMISSIONER OF PATENTS.

And, upon due examination thereof, it appearing that the said applicant is entitled to registration of its said TRADE-MARK under the law, the said TRADE-MARK has been duly REGISTERED to Wm. A. Rogers, Limited, its successors or assigns, in the UNITED STATES PATENT OFFICE, this nineteenth day of May, 1914.

This certificate shall remain in force for TWENTY YEARS unless sooner terminated by law.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of

the PATENT OFFICE to be affixed, at the city of Washington, this nineteenth day of (SEAL) May in the year of our Lord one thousand nine hundred and fourteen, and of the Independence of the United States the one hundred and thirty-eight.

(SGD.) R. F. WHITEHEAD
Acting Commissioner of Patents.

UNITED STATES PATENT OFFICE.

WM. A. ROGERS, LIMITED, OF NEW YORK AND NIAGARA FALLS, NEW YORK.

TRADE-MARK FOR SILVER-PLATED FLAT AND HOLLOW WARE AND CUTLERY.

97,079 Registered May 19, 1914.

Application filed October 2, 1913. Serial No. 73,177.

STATEMENT.

TO ALL WHOM IT MAY CONCERN:

Be it known that Wm. A. ROGERS, LIMITED, a corporation duly organized and existing under and by virtue of the laws of the Province of Ontario, Dominion of Canada, and located in the City of New York, county of New York, in the State of New York, doing business at No. 12 Warren street, in said city of New York, and having a manufacturing establishment at Niagara Falls, county of Niagara, State of New York, has adopted for its use the trade-mark shown in the accompanying drawing, for silver-plated flat and hollow ware and cutlery, in Class No. 28, Jewelry and precious-metal ware.

The trade-mark has been continuously used in the business of said corporation since July, 1901.

Applicant is the owner of the registered trade-marks No. 36,491, May 28, 1901; No. 36,492, May 28, 1901; No. 59,396, January 8, 1907; No. 68,369, March 31, 1908; No. 77,597, April 19, 1910; and No. 77,598, April 19, 1910.

The trade-mark is usually displayed upon the goods themselves by stamping it thereon or otherwise associating it therewith, on packages and cases containing the goods, on labels used in connection therewith, and by otherwise associating it with the manufacture, use and sale of said goods.

(L. S.) Wm. A. ROGERS, LIMITED,
By E. G. BAKER,
Secretary.

1881 (R) ROGERS (R)

DECLARATION

Province of Ontario, county of York ss.:

EDWIN GORDON BAKER, being duly sworn, deposes and says that he is secretary of the corporation, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by the said corporation in commerce among the several States of the United States and between the United States and foreign nations, and particularly with Australia, Italy and Cuba; that the drawing presented truly represents the trade-mark sought to be registered; that the facsimiles show the trade-mark as actually used upon the goods; that one of the manufacturing establishments of said corporation is located at Niagara Falls, county of Niagara,

State of New York, and that the goods claimed in this application are the products of such establishment and of other manufacturing establishments of said corporation within the United States.

E. G. BAKER.

Subscribed and sworn to before me, a notary public, this 26th day of September, 1913.
(L. S.)

W. S. MORLOCK,
Notary Public.

Copies of this trade-mark may be obtained for five cents each, by addressing the "Commissioner of Patents, Washington, D. C."

EXHIBIT "10"

394

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE

TO ALL PERSONS TO WHOM THESE PRESENTS SHALL COME, GREETING:

This is to certify that the annexed is a true copy from the records of this office of the Certificate of Registration, Statement, Declaration and Drawing in the matter of the

Trade-Mark Registered by
Wm. A. Rogers Limited,
March 31, 1908, Number 68,369.

The certificate of registration was granted for the term of twenty years, and so far as is disclosed

by the records of this office, said certificate is still in full force and effect.

In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this thirty-first day of January in the year of our Lord one thousand nine hundred and twenty-eight and of the Independence of the United States of America the one hundred and fifty-second.

(SEAL)

THOMAS E. ROBERTSON
Commissioner of Patents.

ATTEST:
(SGD.) D. E. WILSON
Chief of Division

2—372

No. 68,369

THE UNITED STATES OF AMERICA,

TO ALL TO WHOM THESE PRESENTS SHALL COME:

This is to certify that by the records of the UNITED STATES PATENT OFFICE it appears that Wm. A. Rogers, Limited of Toronto, Ontario, Canada, and Niagara Falls, New York, a corporation organized under the laws of the Province of Ontario, did, on the 25th day of May, 1905, duly file in said Office an application for REGISTRATION of a certain

TRADE-MARK

for Silver-Plated Flat Ware, Hollow Ware and Tableware, that it duly filed therewith a drawing of the said TRADE-MARK, a statement relating thereto, and a written declaration, duly verified, copies of which are hereto annexed, and has duly complied with the requirements of the law in such case made and provided, and with the regulations prescribed by the COMMISSIONER OF PATENTS.

And, upon due examination thereof, it appearing that the said applicant is entitled to registration of its said TRADE-MARK under the law, the said TRADE-MARK has been duly registered to Wm. A. Rogers, Limited, and its successors or assigns, in the UNITED STATES PATENT OFFICE, this 31st day of March, 1908.

This certificate shall remain in force for TWENTY YEARS, unless sooner terminated by law.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of the PATENT OFFICE to be affixed, at the city of Washington, this thirty-
(SEAL) first day of March, in the year of our Lord one thousand nine hundred and eight, and of the Independence of the United States the one hundred and thirty-second.

C. C. BILLINGS
Acting Commissioner of Patents.

TRADE-MARK.

No. 68,369 REGISTERED MAR. 31, 1908

WM. A. ROGERS LIMITED.

SILVER PLATED FLAT WARE, HOLLOW WARE, AND TABLE WARE.

Application Filed May 25, 1905.

WM. A. ROGERS

WITNESSES:
J. CLYDE, RIPLEY
ROBERT S. BLAN

PROPRIETOR
WM. A. ROGERS, LIMITED

By
WARFIELD & DUELL.
Attorneys.

UNITED STATES PATENT OFFICE.

WM. A. ROGERS LIMITED, OF TORONTO, ONTARIO, CANADA, AND NIAGARA FALLS, NEW YORK

TRADE-MARK FOR SILVER-PLATED FLAT WARE, HOLLOW WARE, AND TABLE WARE.

No. 68,369. Statement and Declaration Registered March 31, 1908

Application filed May 25, 1905, Serial No. 6,565.

STATEMENT

TO ALL WHOM IT MAY CONCERN:

Be it known that WM. A. ROGERS LIMITED,

a corporation duly organized under the laws of the Province of Ontario, Dominion of Canada, and located in and having its principal office at Toronto, Canada, and doing business at 445 King street, west, in said city, and having a manufacturing establishment at Niagara Falls, State of New York, has adopted for its use the trade-mark shown in the accompanying drawing, for the following products of such manufacturing establishment, namely: silver plated ware comprising silver-plated flatware, hollow ware and tableware, in Class 28, Jewelry and precious metal ware.

This trade-mark has been continuously used in the business of said corporation, or that of its predecessor, since 1894.

The trade-mark is usually displayed upon the goods themselves by stamping it thereon or otherwise associating it therewith; on packages and cases containing the goods; on labels used in connection therewith, and by otherwise associating it with the manufacture, use and sale of said goods.

WM. A. ROGERS LIMITED
By WILLIAM A. ROGERS,
A Director and General Manager.

DECLARATION.

State of New York, city and county of New York, ss.:

WILLIAM A. ROGERS, being duly sworn, deposes and says that he is a director and general manager of the corporation, the applicant named in the

foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said corporation in commerce among the several States of the United States and between the United States and foreign nations or Indian tribes, and particularly with Canada and Great Britain; that the drawing presented truly represents the trade-mark sought to be registered; that the specimens show the trade-mark as actually used upon the goods; that the manufacturing establishment of said corporation is located at Niagara Falls, State of New York; that the goods claimed in this application are the products of such establishment; and that the mark has been in actual use as a trade-mark of the applicant and of applicant's predecessor, from whom title was derived, for ten years next preceding the passage of the act of February 20th, 1905, and that, to the best of his knowledge and belief, such use has been exclusive.

WILLIAM A. ROGERS.

Subscribed and sworn to before me, a notary public, this 21st day of February, 1908.

(L. S.)

HELEN M. SEAMANS,
Notary Public, No. 75, New York County.

EXHIBIT "11"

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE

TO ALL PERSONS TO WHOM THESE PRESENTS SHALL COME, GREETING:

This is to certify that the annexed is a true copy from the records of this office of the Certificate of Registration, Statement, Declaration and Drawing in the matter of the

Trade-Mark Registered by
Wm. A. Rogers Limited,
June 16, 1908, Number 69,548.

The certificate of registration was granted for the term of twenty years, and so far as is disclosed by the records of this office, said certificate is still in full force and effect.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this thirty-first day of January in the year of our Lord one thousand nine hundred and twenty-eight and of the Independence of the United States of America the one hundred and fifty-second.

(SEAL)

THOMAS E. ROBERTSON
Commissioner of Patents.

ATTEST:

D. E. WILSON
Chief of Division

U. S. Government Printing Office: 1927.

2—372

No. 69,548,

THE UNITED STATES OF AMERICA,

TO ALL TO WHOM THESE PRESENTS SHALL COME:

This is to certify that by the records of the UNITED STATES PATENT OFFICE it appears that Wm. A. Rogers Limited of Toronto, Ontario, Canada, and Niagara Falls, New York, a corporation organized under the laws of the Province of Ontario, did, on the 25th day of May, 1905, duly file in said Office an application for REGISTRATION of a certain

TRADE-MARK

for Silver-Plated Ware, Comprising Silver-Plated Flat Ware, Hollow Ware, and Tableware, that it duly filed therewith a drawing of the said TRADE-MARK, a statement relating thereto, and a written declaration, duly verified, copies of which are hereto annexed, and has duly complied with the requirements of the law in such case made and provided, and with the regulations prescribed by the COMMISSIONER OF PATENTS.

And, upon due examination thereof, it appearing that the said applicant is entitled to registration of its said TRADE-MARK under the law, the said TRADE-MARK has been duly registered to Wm. A. Rogers Limited, and its successors or assigns in the UNITED STATES PATENT OFFICE, this 16th day of June, 1908.

This certificate shall remain in force for TWENTY YEARS, unless sooner terminated by law.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of the PATENT OFFICE to be affixed, at the city of Washington, this sixteenth day (SEAL) of June in the year of our Lord one thousand nine hundred and eight, and of the Independence of the United States the one hundred and thirty-second.

C. C. BILLINGS
Acting Commissioner of Patents.

TRADE-MARK.

No. 69,548 Registered June 16, 1908

WM. A. ROGERS LIMITED.

SILVER PLATED WARE, COMPRISING SILVER PLATED FLAT WARE, HOLLOW WARE, AND TABLEWARE.

Application filed May 25, 1905.

(SYMBOL) W. R. (SYMBOL)

WITNESSES:
J. CLYDE RIPLEY
ROBERT S. BLAIR

PROPRIETOR
WM. A. ROGERS LIMITED

By

WARFIELD & DUELL
Attorneys

UNITED STATES PATENT OFFICE.

WM. A. ROGERS LIMITED, OF TORONTO, ONTARIO, CANADA, AND NIAGARA FALLS, NEW YORK.

TRADE-MARK FOR SILVER-PLATED WARE, COMPRISING SILVER-PLATED FLAT WARE, HOLLOW WARE, AND TABLEWARE.

No. 69,548. Statement and Declaration.

Registered June 16, 1908.

Application filed May 25, 1905. Serial No. 6,561.

STATEMENT

TO ALL WHOM IT MAY CONCERN:

Be it known that Wm. A. ROGERS LIMITED, a corporation duly organized under the laws of the Province of Ontario, Dominion of Canada, and located in and having its principal office at Toronto, Canada, and doing business at 445 King street west, in said city, and having a manufacturing establishment at Niagara Falls, State of New York, has adopted for its use the trade-mark shown in the accompanying drawing, for the following products of such manufacturing establishment, namely: silver-plated ware, comprising silver-plated flat ware, hollow ware, and tableware in Class 28, Jewelry and precious metal ware.

This trade-mark has been continuously used

in the business of said corporation, and that of its predecessor, since 1896.

The trade-mark is usually displayed upon goods themselves by stamping it thereon, or otherwise associating it therewith; on packages containing the goods; on labels used in connection therewith, and by otherwise associating it with the manufacture, use and sale of said goods.

WM. A. ROGERS LIMITED,
By WILLIAM A. ROGERS,
Manager.

DECLARATION

State of New York city and county of New York, ss.:

WILLIAM A. ROGERS, being duly sworn, deposes and says that he is a director and general manager of the corporation, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said corporation in commerce among the United States and foreign nations or Indian tribes, and particularly with Canada and Great

Britain; that the drawing presented truly represents the trade-mark sought to be registered; that the facsimiles show the trade-mark as actually used upon the goods; that the manufacturing establishment of said corporation is located at Niagara Falls, State of New York; and that the goods claimed in this application are the products of such establishment.

WILLIAM A. ROGERS.

Subscribed and sworn to before me, a notary public, this 12 day of March 1908.

(L. S.)

H. ADOLPH WINKOPP,
Notary Public, 101, New York County.

EXHIBIT "12"

Street No. .....
Cable Address:
"DISAP." MANILA
Codes Used:
General Five Letter
Western Union
Bentley's
Private

Order No. 300/148

AMERICAN TRADING CO.,
OF MANILA
Manufactures' Agent
310 Dasmariñas

Manila, P. I., May 17, 1928.

To Wm. A. Rogers, Ltd., Niagara Falls, New York.
Order from Factory

For Bernardo & Sons, 85-87 Rosario, Manila, P. I.
Ship Via Freight.

Terms 90 days sight D/ P thru Philippine National Bank, Manila and New York.

Insure 10% over value against pilferage and loss non-delivery as well as marine risk.

MARKS:

B. & S.

MANILA, P. I.

No. 300/148

24	Dozen Tea spoons	— Style 058
24	Dozen Dessert spoons	
24	" Dessert Forks	
24	" Medium Knives.	
9/12	" Medium Ladles	
1	" Butter Knives	
1	" Sugar Shells	
6	Dozen Tea spoons	— Style 078
6	" Dessert spoons	
6	" " forks	
6	" Med. knives	
6	Dozen Tea spoons	— Style 056
6	" Dessert spoons	
6-1/12"	" forks	
6	" Medium Knives	

Draft must be accompanied with 3 certified copies of invoice, 1 insurance certificate and 3 copies of bills of lading.

BERNARDO & SONS

By .....

AMERICAN TRADING CO.

By S. ALLEN.....

EXHIBIT "12-A"

BERNARDO & SONS

85-87 Rosario, Tel. 2-51-44

P. O. Box 1282, Manila, P. I.

May 16, 1928.

Order List to WM. A. ROGERS, LTD.

c/o The American Trading Co., Manila
Draft 90 Days, Philippine National Bank.

058	24—Dozen TEA SPOONS 24—Dozen DESSERT SPOONS 24—Dozen DESSERT FORKS 24—Dozen MEDIUM KNIVES 9/12 Doz. MEDIUM LADLES 1— " BUTTER KNIVES 1— " SUGAR SHELLS
056	6 Doz. Tea Spoons 6 " Dessert Spoons 6-1/2 " Dessert Forks 6 " Medium Knives
078	6 Doz. Tea Spoons 6 " Dessert Spoons 6 " Dessert Forks 6 " Medium Knives

BERNARDO & SONS
By V. C. BERNARDO.

EXHIBIT "13"

Street No. ..... Order No. 374/165
Cable Address:
"DISAP." MANILA
Codes Used:
General Five Letter
Western Union
Bentley's
Private

AMERICAN TRADING CO.,
OF MANILA
Manufactures' Agent
310 Dasmariñas

Manila, P. I. July 27, 1928.

To Wm. A. Rogers, Ltd., Niagara Falls, New York.
Order From Factory

For Bernardo & Sons, 85-87 Rosario, Manila, P. I.
Ship Via Freight

Terms 90 days sight d/P thru Philippine National Bank, Manila and New York.

Insure 10% over value against pilferage and loss non-delivery as well as marine risk.

MARKS:

B. & S.

MANILA, P. I.
No. 374/165

24	Dozen	Tea spoons	#058	6	Dozen	Tea spoons	#078
24	"	Dessert spoons	#058	6	"	Dessert Forks	"
24	"	Dessert Forks	"	6	"	Dessert Knives	"
24	"	Medium Knives	"	6	"	Medium Knives	"
2	"	Medium Ladles	"	1/2	"	Medium Ladles	"
2	"	Butter Knives	"	1/2	"	Butter Knives	"
2	"	Sugar Shells	"	1/2	"	Sugar Shells	"

6	"	#056	Tea spoons
6	"	"	Dessert spoons
6	"	"	Dessert forks
6	"	"	Medium Knives
1/2	"	"	Medium Ladles
1/2	"	"	Butter Knives
1/2	"	"	Sugar Shells

AMERICAN TRADING CO.

By S. ALLEN .....

6	Dozen	#044	Tea spoons
6	"	"	Dessert spoons
6	"	"	Dessert forks
6	"	"	Medium Knives
1/2	"	"	Medium Ladles
1/2	"	"	Butter Knives
1/2	"	"	Sugar Shells

2 Dozen #058 Child Set (Tea spoon, Child Fork, and Knife.)
1 Only Grecian Tea spoon (lost)

12	Only	cake Basket	#60
12	"	Napkin Rings	#3133-1/2
6	"	Prize cup	3548-5-1/4

less 50% and 15%

BERNARDO & SONS
By C. BERNARDO.

EXHIBIT "13-A"

ORDER TO AMERICAN TRADING CO.
For WM. A. ROGERS LTD.,
July 27, 1928. 90 DAYS.
BERNARDO & SONS, 85-87 ROSARIO
P. O. Box 1282, Manila.

24	Dozen 058 Tea Spoons		
24	" " Dessert Spoons		
24	" " Dessert Forks		
24	" " Medium Knives	24 @ BRDS	P328.80
2	" " Medium Ladles		
2	" " Butter Knives		
2	" " Sugar Shells		
6	Dozen 056 Tea Spoons		
6	" " Dessert Spoons		
6	" " Dessert Forks		
6	" " Medium Knives	6 @ BRDS	" 82.20
1/2	" " Medium Ladles		
1/2	" " Butter Knives		
1/2	" " Sugar Shells.		
6	Dozen 078 Tea Spoons		
6	" " Dessert Spoons		
6	" " Dessert Forks		
6	" " Medium Knives	6 @ BRDS	" 82.20
1/2	" " Medium Ladles		
1/2	" " Butter Knives		
1/2	" " Sugar Shells		
6	Dozen 044 Tea Spoons		
6	" " Dessert Spoons		
6	" " Dessert Forks		
6	" " Medium Knives	6 @ BRBE	" 78.72
1/2	" " Medium Ladles		
1/2	" " Butter Knives		
1/2	" " Sugar Shells		
2	Dozen 058 Child Set (Tea Spoon, Child Fork and Knife)	2 @ 8.50	" 17.00

1 Only Grecian Tea Spoon (lost)			
12 Only 60 Cake Baskets	12 @ ROS	"	45.60
12 Only 3133-1/2 Napkin Rings	12 @ OB	"	9.72
6 Only 3548 Prize Cups	6 @ BDS	"	22.20
50% and 15%			
			P666.44
			P666.44

BERNARDO & SONS
By C. BERNARDO.

EXHIBIT "14"

Manila, P. I., Dec. 28, 1927.

RECEIVED from H. E. HEACOCK CO., 127-131 Escolta, for CASAJE TOH. & CO., INC., 135 T. Pinpin, in good order, the following packages:

1 Closed Envelope

(Sgd.) GABRIEL BROS.
By C. G.

Manila, Dec. 28, 1927.

RECEIVED from H. E. HEACOCK CO., 127-131 Escolta, for CASAJE TOH. & CO., INC., 135 Rosario, in good order, the following packages:

1 Closed Envelope

(Sgd.) LUIS TOH

Manila, Dec. 28, 1927.

RECEIVED from H. E. HEACOCK CO., 127-131 Escolta, for THE EDUCATIONAL DISTRIBU-

TOR, 765 Juan Luna, in good order, the following packages:

1 Closed Envelope

(Sgd.) JUAN ACUAVAN
Manila, Dec. 28, 1927.

RECEIVED from H. E. HEACOCK CO., 127-131 Escolta, for Messrs. BERNARDO Y VARELA, 84 Rosario, in good order, the following packages:

1 Closed Envelope

(Sgd.) ?
Manila, Dec. 28, 1927.

RECEIVED from H. E. HEACOCK CO., 127-131 Escolta for Messrs. BERNARDO & SONS, 87 Rosario, in good order, the following packages:

1 Closed Envelope

(Sgd.) V. B. BERNARDO

EXHIBIT "15"

RADIOGRAM

WORLDWIDE WIRELESS

CONTINENT TO CONTINENT	SHORE TO SHORE	SHIP TO SHIP
"Via RCP"	RADIO CORPORATION OF THE PHILIPPINES	"Via RCP"

120 6X1 MV

NIAGARAFALLS NY 20 4

NLT DISAP
MANILA

ASSURE CUSTOMERS ALL TRADE MARKS

FULY PROTECTED REGISTRATIONS VARIOUS DATES EIGHTEEN NINETY SEVEN TO NINETEEN SEVENTEEN

ROGERS ILV

Repetitions of doubtful words should be obtained through the Company's Office & not by applying directly to the sender.

EXHIBIT "16"

Form No. 51-4-5-27-50 M Western Union Code
Cable Address: "Dial" Telephone 163
P.O. Box 119

HEACOCK'S
Manila

127-131 Escolta, Heacock Building
WHOLESALE AND RETAIL
Jewelers-Opticians-Stationers
Manila, P. I.

December 24, 1927.

American Trading Co.
310 Dasmariñas,
Manila.

Gentlemen:

We are advised that you have been importing silver and nickel flatware into the Philippine Islands under the name of "William A. Rogers". Please be advised that we registered the trade-mark "Rogers" in the Philippine Islands for use in connection with silverware some years ago, and are the exclusive owners thereof. The sale of silver flat-

ware, marked "William A. Rogers" constitutes an infringement of that trade-mark. We, therefore, make formal demand upon you to make no sale of such flatware within this jurisdiction, and advise you that should you do we shall be constrained to institute proceedings to enjoin you and to require you to account for the profits from such sales.

Very truly yours,

H. E. HEACOCK CO.
(Sgd.) SAMUEL F. GACHES
President.

SFG DV

Address all communications to H. E. HEACOCK CO., and not to individuals.

EXHIBIT "17"

January 11, 1922.

La Nacional Store,
Escolta, Manila.

Gentlemen:

We notice that you have in your window a sign Wm. A. Rogers placed on a 26-piece set of flatware.

The mark "Rogers" is a registered trade-mark of our own belonging to silverware and silver plated holloware and flatware, and cannot be used without infringing on our rights and subjecting yourselves to legal procedure.

The 26-piece set of flatware which you have on exhibition is neither W. A. Rogers manufacture nor is it silver plated, and we would request that you

remove this sign this morning, otherwise we will request our lawyers to take action against you for infringing on our rights.

Very truly yours,

H. E. HEACOCK CO.
(SGD.) SAML. F. GACHES,
President.

SFG/dv
A TRUE COPY;

(J)

That after the submission of evidence on various and different dates, by the respective parties herein, the said Court of First Instance of the City of Manila, through the Honorable Carlos A. Imperial, Judge of said Court, on March 11, 1929, rendered its decision in these two cases, as follows:—

(CAPTION AND TITLES OMITTED)

DECISION

These two cases were heard and tried together by agreement of the parties and their respective attorneys.

In the first case, H. E. Heacock Co., a corporation organized under the laws of the country, seeks to recover from the American Trading Co., another domestic corporation, damages for the violation of the law regarding trade-marks and unlawful competition, in an amount double the profits obtained from the sale of the table and silver-plated wares

which are the subject-matter of this action, and likewise prays that the aforesaid defendant be perpetually enjoined from continuing to sell table and silver-plated wares bearing the trade-mark "Rogers"; and in the second case, Wm. A. Rogers, Ltd., a corporation organized under the laws of the State of New York, United States of America, and the American Trading Co., ask that the defendant H. E. Heacock Co. pay to them the sum of four thousand pesos (₱4,000.00) by way of damages; that said entity be enjoined from annoying them in the business in which they are engaged, that is, in the sale and distribution of table and silver wares bearing the trade-marks set forth in the complaint, and, finally, and that they be granted such other legal remedy to which they may be entitled.

As will be seen, the only difference between the two actions consists, as to the contending parties, in the intervention of Wm. A. Rogers, Ltd., as producer or manufacturer of the table and silver-plated wares, in the second case, and as to the nature of the actions, in that the plaintiffs, in the second case, limit themselves in asking that H. E. Heacock Co., be enjoined from annoying them in the disposal and sale of said goods, besides the indemnity already indicated.

The grounds of the action instituted by H. E. Heacock Co. are set forth in the following allegations of its complaint:

"III

That for a period of upward of twenty years the plaintiff has been engaged in the importation and sale within the Philippine Islands of flatware bearing the name—ROGERS—stamped upon the back of the handle thereof, together with an indication of the material of which said flatware is composed;

IV

That on or about June 27, 1918, the plaintiff caused a trade-mark to be registered in its name, in the Bureau of Commerce and Industry, consisting of the word—ROGERS—for use upon spoons and other flatware whether nickel, silver-plated, or silver, as well as nickel, silver-plated or silver goods of all kinds save and except cutlery, and ever since that date the said trade-mark has been used extensively by the plaintiff upon flatware imported and offered for sale by it throughout the Philippine Islands;

V

That the goods to which the said plaintiff has affixed the said trade-mark have became generally, favorably and popularly known throughout the Philippine Islands as ROGERS flatware;

VI

That notwithstanding the fact that the said defendant was well aware of the ownership of said trade-mark by the plaintiff and of the use made by the plaintiff thereof as hereinbefore alleged and of the favorable reputation the flatware imported by the plaintiff as ROGERS flatware has come to have throughout the Philippine Islands has a right to the use of the word—ROGERS—in connection with the importation and sale of flatware, the said defendant in the year

1925 or thereabout began to import and sell within the Philippine Islands flatware of precisely the same designs as that imported and sold by the plaintiff with the words—"Wm. A. ROGERS"—together with an indication of the material of which such flatware is composed, stamped in precisely the same position on the back of the handle thereof as that utilized by the plaintiff;

VII

That the said defendant, through the use of said infringing mark or stamp in selling flatware imported by it, has given and is giving said flatware the appearance of the flatware imported and sold by this plaintiff in such a way as to induce purchasers to believe that the flatware imported and sold by the defendant is the same as that imported and sold by the plaintiff, and such appearance has so induced and is now inducing purchasers within the Philippine Islands to such belief; and

VIII

That such imitation of plaintiff's mark upon the flatware imported by the defendant has been effected by the defendant for the purpose of deceiving the public and defrauding the plaintiff of its legitimate trade, and that the public has been and is being deceived and this plaintiff has been and is being defrauded thereby to its great damage."

As remedies, the said plaintiff prays: (a) that the American Trading Co. render an account of the sales which it has made of the table and silver-plated wares bearing the trade-mark "Wm. A. Rogers" as well as the benefits which it had obtained therefrom; (b) that it be paid double the amount of

the profits obtained, by way of damages suffered by it by reason of the unlawful competition in the sale of the table and silver-plated goods bearing the trade-mark "ROGERS", and (c) that a perpetual writ of injunction be issued enjoining said defendant from selling and dealing in table and silver-plated goods bearing the trade-mark "ROGERS", with costs.

The defendant American Trading Co., on February 11, 1928, filed its answer alleging the following:

"1. Admits the allegations of paragraphs I and II of plaintiff's complaint.

2. Denies the allegations contained in paragraph III of plaintiff's complaint.

3. In answer to paragraph IV of plaintiff's said complaint this defendant admits that the plaintiff caused the word "ROGERS" to be registered with the Bureau of Commerce and Industry as and for a trade-mark to be used upon silverware and flatware as stated in said paragraph IV but in this respect alleges that the registration of said trade-mark is of no legal validity as against this defendant for the reason that the name "ROGERS" is a family name or surname not belonging to the plaintiff and that, therefore, the plaintiff had no legal right to appropriate or attempt to appropriate such name to its exclusive use. Further answering said paragraph IV of said complaint this defendant denies that this plaintiff has been using such trade-mark upon merchandise imported and offered for sale by it within the Philippine Islands.

4. Denies generally and specifically that the

plaintiff herein has ever affixed said trade-mark to any goods whatsoever as claimed by it in paragraph V of its said complaint and furthermore denies that any goods to which this plaintiff may have affixed said trade-mark have ever been or became popularly known throughout the Philippine Islands as "ROGERS" flat ware.

5. In reply to paragraph VI of plaintiff's complaint this defendant denies specifically that this plaintiff has the exclusive right to the use of the word "ROGERS" in connection with the importation and sale of silverware and flatware within the Philippine Islands and furthermore specifically denies that the flat ware and silverware imported and sold within the Philippine Islands by this defendant is of the same designs as that claimed to have been imported and sold by the plaintiff. Further answering said paragraph VI of plaintiff's said complaint this defendant alleges that all of the silverware and flat ware imported by it and sold within the Philippine Islands and bearing the words "Wm. A. ROGERS" together with other symbols and marks as the trade-mark thereon were manufactured by Wm. A. Rogers, Ltd. in the United States of America and that the trade-marks appearing thereon have been duly registered in the Patent Office of the United States of America in accordance with the provisions of the laws of the said United States of America, and is, therefore, admissible into the Philippine Islands under the provisions of Act No. 2460 of the Philippine Commission and the Acts of Congress of February 20, 1905, as amended by the Acts of Congress of May 4, 1906, March 2, 1907, and February 18, 1909.

6. Denies generally and specifically each and every allegation contained in paragraph VII of

plaintiff's said complaint and in this respect further alleges that even if the allegations of said paragraph were true nevertheless under the provisions of said Act 2460 and of the above mentioned Acts of Congress this defendant would have the right to import and sell such merchandise within the Philippine Islands.

7. Denies generally and specifically each and every allegation contained in paragraph VIII of plaintiff's complaint herein.

As a further answer and special defense to plaintiff's complaint on file herein this defendant alleges:

8. That the registration by this plaintiff of the word "ROGERS", a family name or surname which forms no part of its own name, is unwarranted and unauthorized and can in no way prevent another person whose family name is "ROGERS" from using such name in the transaction of his legitimate business either within or without the Philippine Islands.

9. That this defendant is acting within the Philippine Islands as the local agent and representative of Wm. A. Rogers, Ltd., a corporation organized under the laws of the State of New York of the United States of America; that said corporation is engaged in the manufacture of silverware and flat ware of various kinds and that it has registered in the Patent Office at Washington, D. C., United States of America, the following trade-marks for use upon silverware and flat ware manufactured by it and has been using such trade-marks from the different times of their registration (1897 to 1917) in its business and upon the goods manufactured by it consisting of silverware, flat ware, etc.;

		WM. A. ROGERS—E.P.N.S.	
		WM. A. ROGERS—E.P.B.M.	
1881	R	ROGERS R	E.P.N.S.
1881	R	ROGERS R W.R.	E.P.B.M.
1881	R	ROGERS R	A-1

Wm. A. Rogers (in old English script)

10. That the merchandise imported by this defendant and about which this plaintiff is complaining bears some one or more of the above set forth trade-marks.

11. The such trade-marks having been duly registered in the United States, merchandise to which they have been affixed is entitled to admission to the Philippine Islands under the provisions of Act 2460 of the Philippine Commision as well as the Acts of Congress above cited and that being entitled to admission to the Philippine Islands through importation from the United States they are entitled to be sold therein."

The aforesaid defendant concludes with a prayer for the dismissal of the complaint, with costs.

Wm. A. Rogers, Ltd. and the American Trading Co. base their causes of action on the following allegations of their complaint filed on January 12, 1923:

"1.—That the plaintiff Wm. A. Rogers, Ltd., is a corporation duly organized and existing under and by virtue of the laws of the State of New York, of the United States of America; that the plaintiff, the American Trading Co., is a corporation duly organized and existing under and by virtue of the laws of the Philippine Islands with its principal office in the City of Manila and that the defendant H. E. Heacock Co. is also a corporation duly organized and existing under and by

virtue of the laws of the Philippine Islands with its principal place of business also in the said City of Manila.

2.—That the plaintiff, the American Trading Co., is the Philippine agent and representative of the other plaintiff, Wm. A. Rogers, Ltd., for the purpose of securing orders for the purchase and sale of silverware, silver plated hollow and flat ware and cutlery manufactured by the said Wm. A. Rogers, Ltd., in the United States of America and sold throughout the United States and within the Philippine Islands under various trade-marks among which are the following:

		WM. A. ROGERS—E.P.N.S.		
		WM. A. ROGERS—E.P.B.M.		
1881	R	ROGERS	R	E.P.N.S.
1881	R	ROGERS W.R.	R	E.P.B.M.
1881	R	ROGERS	R	A-1

Wm. A. Rogers (in old English script)

3.—That such trade-marks were duly registered in the United States of America at different times from 1897 to 1917 and since their registration have been continuously used in trade by the said Wm. A. Rogers, Ltd., in the United States, in the Philippine Islands and throughout the world.

4.—That the plaintiff, the American Trading Co., as the local agent and representative of the other plaintiff, Wm. Rogers, Ltd., has been importing into the Philippine Islands such above mentioned merchandise manufactured by and bearing some or all of the trade-marks above mentioned of the other plaintiff, Wm. A. Rogers, Ltd., since 1923 and has built up a considerable business in the Philippine Islands in the sale of such merchandise.

5.—That the importation into the Philippine Islands of such merchandise bearing such trade-marks during the period stated was and is well known to this defendant which has until within the last few days made no objection thereto.

6.—That on or about the 27th day of June, 1918, the defendant registered with the Bureau of Commerce and Industry of the Philippine Islands the word "ROGERS" as a trade-mark for silverware, that ware and other articles similar to those imported into the Philippine Islands as above stated by these plaintiffs.

7.—That the said word "ROGERS" is a family name and while as a matter of law it may be true that the defendant had a right to register such name as its trade-mark, which these plaintiffs deny, such registration can in no wise prevent another person having the family name "ROGERS" or a corporation of which the family name "ROGERS" is a part as is the case with one of the plaintiffs here, from also using such name as his or its trade-mark.

8.—That beginning on or about December 15, 1927, this defendant wrote letters to the plaintiff, the American Trading Co., and to various customers of said plaintiff and of the other plaintiff herein threatening each and all of them with injunction proceedings and with a suit for an accounting of any profits which might arise from any sales made by them of silverware bearing the name "Wm. A. Rogers", basing such threats, as shown by such letters, upon the registration by it of the word "ROGERS" as its trade-mark as above stated.

9.—That such threats were and are based upon the illegal and unwarranted assumption that the registration by this defendant of the word "ROGERS" as its trade-mark for silverware is sufficient to prevent the plaintiffs herein and particularly the plain-

tiff "Wm. A. Rogers, Ltd.", from using that word either alone or in combination with other words, symbols or characters as its trade-mark upon similar merchandise and that such threats and demand were and are illegal, unauthorized and unwarranted.

10.—That the plaintiff, the American Trading Co., has requested the said defendant H. E. Heacock Co., to withdraw the various letters written by it to the said American Trading Co. and to the customers thereof and of to the other plaintiff Wm. A. Rogers, Ltd., but that said defendant has neglected and refused and still neglects and refuses so to do, to the damage and prejudice of these plaintiffs in that said customers of these plaintiffs have refused and are refusing to purchase the silverware manufactured by the plaintiff, Wm. A. Rogers, Ltd., bearing such trade-marks of said plaintiffs, thus causing injury and damage to these plaintiffs, in the amount of ₱4,000.00.

11.—That the continuance of the acts of this defendant set forth and complained of above during the pendency of the present action would work an injustice to these plaintiffs and that this defendant is doing and threatens to do acts in violation of these plaintiffs' right as above set forth, all of which, if permitted to be continued, will work irreparable injury and damage to these plaintiffs."

Said plaintiffs conclude by praying: (a) that the defendant H. E. Heacock Co. be enjoined from annoying them in the legitimate enjoyment of their business; (b) that it be ordered to pay the sum of four thousand pesos (₱4,000.00) as indemnity; (c) that it be ordered to pay them the additional damages caused during the pendency of the case; (d) that a perpetual writ of injunction be issued order-

ing the defendant, its agents, attorneys, and employees to abstain from annoying Wm. A. Rogers, Ltd., in the sale in the country of table and silver-plated wares bearing the name of the manufacturer, "Wm. A. Rogers, Ltd.", and (e) that they be granted such other legal remedies as the fact may warrant, with costs.

On October 26 of the same year, the defendant H. E. Heacock Co. filed its answer containing the following allegations, special defenses, and counterclaim:

"I

It admits the allegations of Paragraph I of said complaint.

II

It denies generally and specifically each and every allegation of each and every of the remaining paragraphs of said complaint, except such as may hereafter be expressly admitted.

By way of special defense, the defendant alleges:

I

That for a period of upward of twenty years the defendant has been engaged in the importation into and sale within the Philippine Islands of flatware bearing the trade-mark "Rogers" stamped upon the back of the handles thereof together with an indication of the material of which said flatware is composed.

II

That on or about June 27, 1918, the defendant caused a trade-mark to be registered in its name

in the Bureau of Commerce and Industry, consisting of the word—ROGERS—for use upon spoons and other flatware whether nickel, silver-plated, or silver, as well as nickel, silver-plated or silver goods of all kinds save and except cutlery, and ever since that the said trade-mark has been used extensively by the defendant upon flatware imported and offered for sale by it throughout the Philippine Islands.

III

That the goods to which the said defendant has affixed the said trade-mark have become generally, favorably and popularly known throughout the Philippine Islands as ROGERS flatware.

IV

That notwit standing the fact that the plaintiffs were well aware of the ownership of said trademark by the defendant and of the use made by the defendant thereof as hereinbefore alleged and of the favorable reputation the flatware imported by the defendant as ROGERS flatware has come to have throughout the Philippine Islands, and that no other dealer in flatware in the Philippine Islands has a right to the use of the word—ROGERS—in connection with the importation and sale of flatware, the said plaintiffs in the year 1925 or thereabout began to import and sell within the Philippine Islands flatware of precisely the same designs as that imported and sold by the defendant with the words "WM. A. ROGERS"—together with an indication of the material of which such flatware is composed, stamped in precisely the same position on the back of the handle thereof as that utilized by the defendant for that purpose.

V

That the said plaintiffs, through the use of said infringing mark or stamp in selling flatware

imported by them, have given and are giving said flatware the appearance of the flatware imported and sold by this defendant in such a way as to induce purchasers to believe that the flatware imported and sold by the plaintiffs is the same as that imported and sold by the defendant, and such appearance has so induced and is now inducing purchasers within the Philippine Islands to such belief.

VI

That such imitation of defendant's mark upon the flatware imported and sold by the plaintiffs in the Philippine Islands has been effected by the plaintiffs for the purpose of deceiving the public and defrauding defendant of its legitimate trade, and that the public has been and is being deceived and this defendant has been and is being defrauded thereby to its great damage.

As a second special defense, the defendant alleges:

I

That at the time the complaint herein was filed, this defendant had filed an action against the plaintiff herein, the American Trading Company, involving precisely the same issues as those presented in this cause and that the plaintiffs and their attorney knew that said action was pending at the time of the filing of the complaint herein.

II

That the number of said action is Civil Case No. 82962 of the Court of First Instance of the City of Manila, and a copy of this defendant's complaint herein, is hereunto annexed, and hereby made a part hereof, marked Exhibit "A".

WHEREFORE, it is respectfully prayed that the complaint herein be dismissed, and the preli-

nary injunction herein dissolved, with costs against the plaintiffs.

CROSS-COMPLAINT

By way of cross-complaint against the plaintiff Wm. A. Rogers, Ltd., the defendant alleges:

I

That the defendant H. E. Heacock Company is a domestic corporation duly organized and existing under the laws of the Philippine Islands, with its principal place of business at No. 127, Escolta, Manila, Philippine Islands.

II

That the plaintiff Wm. A. Rogers, Ltd., is a foreign corporation duly organized and existing under and by virtue of the laws of the State of New York of the United States of America, the other plaintiff, American Trading Company, a domestic corporation duly organized and existing under the laws of the Philippine Islands and with its principal office in the City of Manila, being the local agent or representative for the Philippine Islands for the said Wm. A. Rogers, Ltd.

III

That for a period of upward of twenty years the defendant has been engaged in the importation into and sale within the Philippine Islands of flatware bearing the trademark "Rogers" stamped upon the back of the handles thereof, together with an indication of the material of which said flatware is composed.

IV

That on or about June 27, 1918, the defendant caused a trade-mark to be registered in its name, in the Bureau of Commerce and Industry, consisting of the word—ROGERS—for use upon

spoons and other flatware whether nickel, silver-plated, or silver, as well as nickel, silver-plated or silver goods of all kinds save and except cutlery, and ever since that date the said trade-mark has been used extensively by the defendant upon flatware imported and offered for sale by it throughout the Philippine Islands.

V

That the goods to which the said defendant has affixed the said trade-mark have become generally, favorably and popularly known throughout the Philippine Islands as ROGERS flatware.

VI

That notwithstanding the fact that said plaintiff Wm. A. Rogers, Ltd. was well aware of the ownership of said trade-mark by the defendant and of the use made by the defendant thereof as hereinbefore alleged and of the favorable reputation the flatware imported by the defendant as ROGERS flatware has come to have throughout the Philippine Islands, and that no other dealer in flatware in the Philippine Islands has a right to the use of the word—ROGERS—in connection with the importation and sale of flatware, the said plaintiff in the year 1925 or thereabout began to import and sell within the Philippine Islands flatware of precisely the same designs as the imported and sold by the defendant with the words "WM. A. ROGERS"—together with an indication of the material of which such flatware is composed, stamped in precisely the same position on the back of the handle thereof as that utilized by the defendant for that purpose.

VII

That the said plaintiff, through the use of said infringing mark or stamp in selling flatware imported by it, has given and is giving said flatware

the appearance of the flatware imported and sold by this defendant in such a way as to induce purchasers to believe that the flatware imported and sold by said plaintiff is the same as that imported and sold by the defendant, and such appearance has so induced and is now inducing purchasers within the Philippine Islands to such belief.

VIII

That such imitation of defendant's mark upon the flatware imported and sold by said plaintiff in the Philippine Islands has been effected by the plaintiff for the purpose of deceiving the public and defrauding the defendant of its legitimate trade, and that the public has been and is being deceived and this defendant has been and is being defrauded thereby to its great damage."

Based on the foregoing allegations, special defenses, and counterclaim, the said defendant prays for practically the same remedies contained in its complaint filed in the first case.

On petition of the plaintiffs in the second case, and after filing a bond fixed by the court, a writ of preliminary injunction was issued against H. E. Heacock Co., its agents, attorneys, and employees, enjoining them until further order from annoying the plaintiffs in the business in which they are engaged in the Philippines, consisting in the importation of table and silver-plated goods bearing the trade-marks set forth in the complaint, and in the sale of said table and silver-plated goods in said country.

From the evidence adduced during the trial, the following facts are deducible:

That H. E. Heacock Co. was organized in the city of Manila in 1909, being the successor to the firm Heacock & Frier which was organized in the same city in 1901, and continued to do business from that time; that from 1901, H. E. Heacock Co., by itself and through its predecessors, imported into the Islands table and silver-plated goods for different uses (Silver-Ware, Flat-Ware & Hollow-Ware) bearing the factory trade-mark "ROGERS", whereas the American Trading Co. imported goods of the same nature and for the same uses from 1924 or 1925 only; that on June 27, 1918, H. E. Heacock Co. registered in the Bureau of Commerce and Industry the trade-mark "ROGERS", which was used in the disposal and sale in the Philippines of table and silver-plated goods for different uses, for a period of about twenty years up to the present time (Exhibit "G"); that the silver-plated goods sold by H. E. Heacock Co., bearing the trade-mark "ROGERS" have almost the same appearance and design as the goods of the same metal which have been imported and sold by the American Trading Co. (Exhibits "E" and "F"); that the silver-plated goods for use in the table and for other purposes manufactured by the International Silver Corporation and imported into the Islands by H. E. Heacock Co. were known generally and in the Islands by the

their trade-mark "ROGERS" and this trade-mark used in connection with said silver-plated goods have been known by the public as goods sold by H. E. Heacock Co.; that the said silver-plated goods with the trade-mark "ROGERS" were notoriously known in the Philippine Islands due to the extensive propaganda and advertisement made by H. E. Heacock Co. which cost from forty thousand to fifty thousand pesos; that the silver-plated goods for use in the table and for other purposes imported into these Islands by H. E. Heacock Co. and by Wm. A. Rogers Ltd., and the American Trading Co., have the word "ROGERS" with the addition of other words, figures or symbols indicating the different grades or qualities of the goods; that in the local market the word "ROGERS" is the one generally known and sought for by the public which desires to buy silver-plated goods for the table and for other purposes, disregarding and overlooking completely the other words, figures and symbols appearing on the goods; that some of the dealers in silver-plated goods imported by Wm. Rogers, Ltd. and the American Trading Co. only make mention and call attention to the word "ROGERS" appearing thereon, and in almost all cases the public entertained the conviction and the belief, at least, that such silver-plated goods were the same as those which bore the trade-mark "ROGERS" sold by H. E. Heacock Co.; that the American Trading Co. through it and as representative of Wm. A. Rogers Ltd. has succeeded in making a name in the mar-

but for the silver-plated goods which it imports and sells in the Philippines, thanks to the word "ROGERS" engraved thereon, and, finally, that H. E. Heacock Co. was informed of the importation of these silver-plated goods bearing the word "ROGERS" by the American Trading Co. about the end of 1927 only.

Before passing to consider the merits of the causes of action of H. E. Heacock Co., we shall first see the theory advanced by Wm. A. Rogers, Ltd. and the American Trading Co. to the effect that H. E. Heacock Co., cannot maintain its action in this jurisdiction for the reason that, the Act of Congress regarding trade-marks of February 20, 1905 being in force in these Islands, and Wm. A. Rogers, Ltd., having succeeded in registering its trade-mark in the United States, the word "Rogers" can not be registered in this territory.

It is said that the law supporting the foregoing theory is found in section 20 of the said Act of Congress of February 20, 1905, which reads as follows:

"SEC. 20. That in construing this Act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof: The United States includes and embraces all territory which is under the jurisdiction and control of the United States."

It is contended that this section defines clearly what the law means by the words "The United States", which embraces all its territories with-

excepting the Philippine Islands. But this interpretation does not appear well taken. In section 1 of the Philippine Act, Act of Congress of July 1, 1902, it is provided that the provisions contained in section 1891 of the Revised Statutes of 1878 shall not be applicable to the Philippine Islands. From this rule, it may be clearly inferred that the denomination "The United States," should not be understood as including Philippine territory. This conclusion is supported by the decision rendered in the case of U. S. v. Bull, 15 P. R. p. 22, wherein the Supreme Court said the following:

> "Section 1891 of the Revised Statutes of 1878 provides that 'The Constitution and all laws of the United States which are not locally inapplicable shall have the same force and effect within all the organized territories, and in every territory hereafter organized, as elsewhere within the United States.' When Congress organized a civil government for the Philippines, it expressly provided that this section of the Revised Statutes should not apply to the Philippine Islands. (Sec. 1, Act of 1902)."

By analogy of reasoning, the authoritative opinion of the Attorney-General of the United States which was rendered on the occasion of the interpretation of the extent of the provisions of the Act regarding the Importation of Narcotic Drugs of May 26, 1922 (42 Stat. 596) may be cited. The question then was whether under section 2, subsections (b), (c) and (d) of said Act of Congress, which provides that it shall be applicable to all territories

under the control of the United States, and that the words "United States", when used in their geographical sense, includes all the United States, its territories, and the district of Columbia, the Philippine Archipelago must be interpreted as being included. After a careful study, the Attorney-General reached the conclusion and maintained that the aforesaid Act does not include the Philippine Islands. The following are some of the salient paragraphs of the aforesaid opinion:

> "The language of the Narcotic Drugs Import and Export Act of May 26, 1922 (42 Stat. 596) fixing its geographical application, says:
>
> "The United States or any territory under its control and jurisdiction."
> "(Par. b. of Sec. 2).
>
> * * * * *
>
> "The Narcotic Drugs Import and Export Act will be searched in vain for any language disclosing that it 'specifically' provided that it shall apply to the Philippines. Not only does the Act not provide any enforcement machinery for the Philippines as is ordinarily done, as will be hereinafter pointed out in statutes intended to apply to the Philippines, but * * *
>
> "Additional support for the views above expressed is to be found in what may now be regarded as the well-settled manner in which Congress expresses its intention where it desires any of the Federal laws to the operative in the Philippines. In Sec. 23 of the Income Tax Act of September 8, 1916 (39 Stat. 776), it is provided that the provisions of that Act shall extend to the 'Philippine Islands'. The Act also confers juris-

diction upon 'courts of first instance of said Islands', and places the administration of the law so far as the Act is concerned upon the officers of those Islands. The so-called National Defense Act of June 15, 1917, (40 Stat. 217, 231), specifically confers upon the 'courts of first instance in the Philippine Islands' jurisdiction of offenses under that Act committed within the Philippines * * * In section 2 of the Narcotic Act of December 17, 1914, (38 Stat. 785, 787), it is provided that in 'the Philippine Islands administration of this Act' shall be looked after by the local internal revenue officers. The Act further provides that 'the courts of first instance in the Philippine Islands shall possess and exercise jurisdiction in all cases arising under this Act in said Islands.' In the Immigration Act of February 5, 1917, (39 Stat. 874), it is provided that 'this Act shall be enforced in the Philippine Islands by officers of the general government thereof.' In the Trading with the Enemy Act of October 6, 1917 (40 Stat. 411, 425), it is provided that the several courts of first instance in the Philippine Islands shall have jurisdiction of offenses committed under the Act within their territory." * * *

"In conclusion, it seems proper to state that even though the correct interpretation of the Narcotic Drugs Import and Export Act were more doubtful than I find it to be, it would nevertheless be necessary to resolve that doubt against the application of the law to the Philippines in view not only of the provisions of section 5 of the Act of August 29, 1916, supra, but also because of the provisions in section 1 of the Act of July 1, 1902 (32 Stat. 691), in which Congress specifically withheld from the Philippine Islands the application of section 1891 of the Revised Statutes, thus expressing its intention that the laws of the

United States should not apply to the Philippines unless the intention to that effect was clearly expressed." (32 Opp. Atty. Gen. 550, Opinion dated Oct. 17, 1925).

In view of the foregoing, it may be concluded that the aforesaid Act of Congress of the United States of February 20, 1905, regarding trade-marks and patents has not been extended or made applicable to the Philippine Islands.

As a corollary of the above conclusion the question arises as to whether Wm. A. Rogers, Ltd. and the American Trading Co., plaintiffs in the second case, may maintain the action instituted by them. Before passing upon this point, we should not lose sight of the fact, incontrovertible and admitted by the parties, that said corporations have not registered any trade-mark or patent in the Bureau of Commerce and Industry. That being the case, it is evident that they do not have such right of action pursuant to section 4 of Act No. 666, as amended by section 1 of Act No. 3332, which reads that "No action shall be brought for damages for the violation of the rights to use trade-marks defined in the preceding sections nor shall criminal proceedings be entertained as provided in section six of this Act, unless it be first shown that the trade-mark or trade-name alleged to have been violated or which give rise to the criminal action has been duly registered in the Bureau of Commerce and Industry, in accordance with the provisions of this Act."

In accordance with said legal provision, therefore, Wm. A. Rogers and the American Trading Co., can not maintain the action instituted by them, and this finally and adversely resolves the complaint interposed in the second case.

We come now to a consideration and determination of the merits of the action brought by H. E. Heacock Co. in the first case. The first question presented is the contention of the adverse party to the effect that the complaint is groundless in view of the fact that according to law, the word "ROGERS" is not susceptible of registration because it is a family name which use Wm. A. Rogers Ltd., cannot be lawfully deprived of. This question of law requires an examination and an inquiry of the authorities on the subject. It is indisputable that there are treatises and judicial decisions holding that a name or family name cannot and should not be registered as a trade-mark, inasmuch as it is not susceptible of appropriation in a legal sense. But it is evident that the majority and the weight of authorities hold the contrary view. Before all, it is necessary to quote the applicable sections of the Trade-Marks Act No. 666, to show what it says on the subject:

> "SEC. 1. A trade-mark is a name, emblem, sign, or device employed by any person, firm, or corporation to designate the goods dealt in or manufactured by such person, firm, or corpor-

ation, for the purpose of enabling the public to recognise such goods and manufactures, and to distinguish them from the goods and manufactures of others.

"SEC. 2. Any one who produces or deals in merchandise of any kind by actual use thereof in trade may appropriate to his exclusive use a trade-mark, not so appropriated by another, to designate the origin or ownership thereof; PROVIDED, that a designation or part of a designation which relates only to the name, quality, or description of the merchandise or geographical place of its production or origin can not be the subject of a trade-mark."

According to said sections a name may be used and appropriated exclusively as a trade-mark to distinguish it from another. There is nothing in our law which prohibits the use and registration of a familiar name for the purpose of using it exclusively and safeguarding it from fraudulent imitations which is the primordial purpose of the legislation.

In the case of "International Silver Co. vs. Simeon L. & George H. Rogers Co. et al.," 110 Fed. 955, 956-959, where the question was extensively discussed and a history of the origin of the words "Rogers Bros." and "Rogers" was made, the Circuit Court, through Judge Shipman, said the following:

"This is a motion for a preliminary injunction. Some of the historical facts in this case also existed in R. W. Rogers Co. v. Wm. Rogers Mfg. Co., and were stated in 17 C. C. A. 576, 70 Fed. 1017, as follows: 'About forty years ago, three brothers, by the name of Rogers, compo-

a firm in Connecticut under the style of "Rogers Bros." This firm first applied the act of electro-plating to the manufacture of silver-plated ware in this country, and acquired by steadfast integrity a high reputation for the sterling quality of their ware, and the name of "Rogers Bros." stamped upon the back of the goods also obtained a widely extender reputation.' A corporation called the 'Wm. Rogers Manufacturing Company' was 'the successor of the business established in 1865 by William Rogers, one of these brothers, and was after 1872 engaged in manufacturing and selling silver-plated ware, and continued the trade-marks upon such goods which its predecessor adopted in 1866, viz. "1865, Wm. Rogers Mfg. Co.", and "Wm. Rogers & Son".' It also used, from and after 1877, the following mark: '(Figure of Anchor) Rogers (Figure of Anchor).' 'Two other corporations acquired from one or more of these brothers the right to use the name "Rogers" also, and for a number of years last past the goods of these corporations, called in the speech of the public, "Rogers goods," have maintained a high character and a well known reputation.' One of these corporations was the Meriden Britania Company, which adopted, in 1862, as a trade-mark, the following: '1847, Rogers Bros.' Another corporation, Rogers & Bros., established in Waterburry, Conn., used as a trade-mark '(Star) Rogers & Bro.' In May, 1898, the complainant, called the 'International Silver Company,' was formed, which bought or acquired the entire capital stock or properties of 14 silver-plating corporations, including the William Rogers Manufacturing Company, the Meriden Britania Company, and the Rogers' Bro., and obtained by purchase or assignment the ownership of all their trade-marks, and now owns and controls the business of all the original Ro-

goes complainant, with the good will and trade-marks of each. The manufacture of the same goods to which their trade-marks were applied is continued by the complainant, the trademarks are applied, the trade-mark goods are advertised as aforetime, and the exclusive right to the use of these marks is in fact, and is considered to be, of great value. To the goods formerly manufactured by the corporations not entitled to use the Rogers marks the trade marks are not applied. In May, 1898, when the consolidation took place, the factory of the William Rogers Manufacturing Company was in Hartford. William H. Watrous was, and had been from 1879, its president and controlling manager, and was well known as a practical and skillful manufacturer; John McFadyen was, and has been for many years, its superintendent; and Samuel McFadyen had been also for many years its treasurer and bookkeeper. These officers were of known reputation and skill in their respective departments. The manufacturing business was continued in the same factory, and these gentlemen remained in the positions which they had formerly occupied until December 8, 1900, when the two McFadyens resigned. Watrous resigned as president and manager in January, 1901, and in March, 1901, resigned as a director of the complainant. On October 3, 1900, a corporation with a nominal capital of $200,000 was organized in Maine under the name of 'Rogers Bros. Mfg. Company,' to carry on, among other things, the silver-plating business. Simeon L. Rogers, George H. Rogers, John McFadyen, Samuel McFadyen, and Henry L. Cram, of Portland, Me., each subscribed for 1 share, and 1,996 shares remained unissued. On January 16, 1901, the name was changed to 'Simeon L. and George H. Rogers Company.' It established a factory in Hartford, and silverplated ware was first put upon the market about the

last week of February, 1901, and by May, 1901, it began to do a little business, which has gradually increased and apparently has been vigorously pushed. Simeon L. Rogers and George H. Rogers were the sons of Simeon S. Rogers, one of the three brothers who composed the original firm of Rogers Bros. George H. Rogers has, either as tenant or employee, been a farmer and had no connection with the business of silver plating until this company was formed. Simeon L. Rogers was born in 1844 and died July 21, 1901. At the termination of the Civil War he learned the business of burnishing and for years worked in various silver plating shops in New Britain, Waterburry, and Shelton as a maker of blanks for plating. From September, 1888, to September 1900, he was pressman in the forge department of the Silver-Plate Cutlery Company in Shelton, was engaged in cutting out steel knives and forks on the press upon an average compensation of $2.50 per day. He was not a manufacturer, but was a workman upon wages by the day or week. Mr. Watrous was a nephew of Simeon S. Rogers, and the two McFadyeans are brothers of Mrs. Watrous. On July 21, 1901, Simeon L. Rogers and George H. Rogers each owned 49 shares of the capital stock of the defendant company, of the par value of $4,900. The two amounts are said to be 'about one-eight of the capital stock which has been subscribed for and issued up to' August 10, 1901. From February 20, 1901, to May 10, 1901, the silver-plated wares of the defendant were marked as follows: '(Maltese Cross) Rogers (Maltese Cross).' '(Cross) Rogers Bros. (Cross).' '(Cross) S. L. & G. H. Rogers (Cross).' The cross was dropped, and from April 20, 1901, to May 10, 1901, and acorn was substituted, and the goods were marked as follows: '(Acorn) Rogers (Acorn).' '(Acorn) Rogers Bros. (Acorn).' The acorn was then dropped, and from

May 10, 1901, the goods have been stamped as follows, the letters 'S. L. & G. H. Co.' appearing in monogram; 'S. L. & G. H. Rogers Bros.,' 'S. L. & G. H. Rogers Co.' It will be remembered that the Meriden Britania Company, and its successor, the complainant, have continuously used '1847, Rogers Bros.' and that the William Rogers Manufacturing Company and its successor have continuously used '(Anchor) Rogers (Anchor).' The monograms of the defendant, when reduced to the size necessary for stamping them upon the back of a spoon or fork, are too small to be easily deciphered by a person with no previous knowledge of their meaning. Such a person simply understands that they represent something, and consequently the name 'Rogers' or 'Rogers Bros.' is both the prominent and the legible imprint upon the article. I have mentioned only the trade-mark rights which appertained to these corporations, without reciting their history, or the history of the trade-mark rights of any other corporation. It is unnecessary to go more minutely into that part of the case, because the history of the various Rogers marks has been two or three times the subject of careful analysis in the Connecticut court of last resort. Britania Co. v. Parker, 39 Conn. 450, 12 Am. Rep. 401; Manufacturing Co. v. Simpson, 54 Conn. 527, 9 Atl. 395; Rogers v. Rogers, 53 Conn. 122, 1 Atl. 807, 5 Atl. 675, 55 Am. Rep. 78.

It can hardly be denied that the defendant has no right to the use of 'Rogers Bros.' or of '1847, Rogers Bros.,' or of '(Anchor) Rogers (Anchor)'; but it is said, 'We have a right to the use of our whole name, and we prefix our initials to "Rogers Bros." and to "Rogers", and we add to "Rogers" the letters "Co."' In point of fact, these prefixes and suffixes are obscure, and, to the ordinary observer, enigmatical. They actually convey

no meaning. The marks simulate the marks of the complainant, and, under the guise of monograms, present the appearance of the marks of the complainant. The motive for such simulation was the advantage to be gained by misleading the purchaser at retail to the belief that the articles so stamped are what the public calls 'Rogers goods.' Neither can the defendant corporation simulate the marks of the complainant by the use of the name 'Rogers Bros.' or 'Rogers' with or without a preceding or succeeding emblem or symbol or initials. These names are the substantial and distinctive part of the trademark in the mind of the purchasing public.

The bill is for the restraint or prevention of the infringement of trade marks and of unfair competition in trade in connection therewith, and asks for a preliminary as well as permanent injunction against the use upon silverplated ware of the mark 'Rogers Bros.', whether alone or accompanied by a symbol or monogram, and against the use of a mark consisting of the word 'Rogers,' either alone or preceded or followed by some symbol or monogram. In other words, the bill asks for an injunction against the simulation of the complainant's trademarks upon silver ware, and asks for a like injunction against the use of the corporate name 'Simeon L. & George H. Rogers Co.' in connection with the business of manufacturing and selling silver plated ware, upon the ground that the adoption of this corporate name was a fraudulent attempt to gain the benefit of the manufacturing reputation of the corporations known as the original 'Rogers' companies. There is no adequate reason why a preliminary injunction should not issue as prayed for against the simulation of the complainant's marks upon silver ware, especially against the use of the marks heretofore used; and the simulation is sufficiently complete when 'Ro-

gers Bros.' or 'Rogers' is plainly presented, either alone or accompanied by some symbol or emblem or hieroglyphical device."

In the case of International Silver Co. vs. Rogers, 67 Atl., 105, 106, 107, the Court, in issuing the writ of preliminary injunction applied for, held as follows:

"This is an appeal from a decree of the Court of Chancery. The suit is a continuation of the litigation heretofore carried on by the International Silver Company against the William H. Rogers Corporation, and reported in 66 N. J. Eq. 119, 57 Atl. 1057, and on appeal in 67 N. J. Eq. 646, 60 Atl. 187, 110 Am. St. Rep. 506. The decree in that case was directed against the William H. Rogers Corporation, and its officers and directors, and enjoined them from making and selling silver-plated flatware under the corporate name of 'Wm. H. Rogers Corporation,' or under the name of 'Wm. H. Rogers' or under any name of which the word 'Rogers' is a part.

"The learned Vice Chancellor thought the injunction should not go, holding that the defendant was under no obligation to do anything more than use his own name fairly; that the evidence showed no fraud; and that the mere fact that a competitor is, or may be, injured, is not material. In that view we cannot concur. Assuming that every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidentally interfere with and injure the business of another having the same name, he may not, in such use of his name, resort to any artifice, or do any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name. Singer Mfg.

Co. v. June Mfg. Co., 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. Ed. 118; Russia Cement Co. v. Le Page 147 Mass. 206, 17 N. E. 304, 9 Am. St. Rep. 695, Pillsbury v. Pillsbury, 24 U. S. App. 395, 64 Fed. 841, 12 C. C. A. 432; Croft v. Day, 7 Beav. 84, Holloway v. Holloway, 13 Beav. 209, Watherspoon v. Currie, L. R. 5 H. L. 508; Howard v. Henriques, 3 Sandf. 725; Meneely v. Meneely, 62 N. Y. 427, 20 Am. Rep. 489; Lawrence Mfg. Co v. Tennessee Mfg. Co., 138 U. S. 537, 11 Sup. Ct. 396, 34 L. Ed. 997; Brown Chemical Co. v. Meyer, 139 U. S. 540, 11 Sup Ct. 625, 35 L. Ed. 247; Cats v. Merrick Thread Co., 149 U. S. 562, 13 Sup. Ct. 966, 37 L. Ed. 847. The leading case is Singer Mfg. Co. v. June Mfg. Co., supra, in which Mr. Justice White, after affirming the doctrine above set forth, and citing the cases which support it, declared: 'Where the name is one which has previously thereto come to indicate the source of manufacture of particular device the use of such name by another, unaccompanied with any precaution or indication, in itself amounts to an artifice calculated to produce the deception alluded to in the foregoing adjudications.' That proposition finds support in the following cases: Howe Scale Company v. Wyckoff, Seamans & Benedict, 198 U. S. 118, 25 Sup. Ct. 609, 49 L. Ed. 972; Walter Baker & Co. v. Baker (C. C.) 87 Fed. 209; Centaur Co. v. Link, 62 N. J. Eq. 147, 49 Atl. 828; Chickering v. Chickering, 120 Fed. 69, 56 C. C. A. 475.

When this suit was originally before the court, the Vice Chancellor found that the name 'Rogers' had acquired a secondary significance in connection with the manufacture of silverware. In his opinion, reported in 66 N. J. Eq. 120, 57 Atl. 1037, he uses this language: 'The complainant is the successor of several companies which have been engaged for many years in the manufacture of silver-

plated ware, and which all derive their title from three brothers of the name of Rogers, who were among the first, if not the first, to apply the art of electro-plating to its manufacture. They gained a reputation for their products, and the name "Rogers" has acquired a secondary significance in connection therewith'. That finding of fact is, in our judgment, fully warranted by the evidence. While a personal name may not constitute a technical trade-mark, yet, where an article has come to be known by that personal name, one may not use that name, even though it be his own, to palm off his goods as the goods of another who has first adopted it, and by which appellation the goods have come to be known, when the use of his own name for such purpose works a fraud. If he uses his own name, it must be so used as not to deprive others of their rights, or to deceive the public, and the name must be accompanied with such indications that the thing manufactured is the work of the one making it as would unmistakably inform the public of the fact. Williams v. Mitchell, 106 Fed. 169, 45 C. C. A. 265; Meyer v. Medicine Co., 58 Fed. 884, 7 C. C. A. 220; Baker v. Sanders, 80 Fed. 889, 26 C. C. A. 220; Allegretti v. Allegretti, 52 N. E. 487, 177 Ill. 129; Pillsbury v. Mills Co., 64 Fed. 841, 12 C. C. A. 432; Allegretti v. Keller (C. C.) 85 Fed. 643; Raymond v. Powder Co., 85 Fed. 231, 29 C. C. A. 245; Mills Co. v. Eagle, 86 Fed. 608, 30 C. C. A. 386, 41 L. R. A. 162.

"The defendant contends that he distinguished his goods by stamping on them the words, 'W. H. Rogers, of Plainfield, N. J.' The alleged distinguishing words are 'of Plainfield, N. J.'; but that is no distinguishing mark. As the history of the 'Rogers' name in connection with silverplated ware shows, there were several places where the art was carried on, and the "Rogers' mark was lawfully used. Locality has no sufficiently distinguish-

ing force, because locality is not associated in any way with the mark itself. It is the word 'Rogers', that is all controlling, and it is that which should be differentiated in order to effectually distinguish the goods. In Baker v. Sanders, 80 Fed. 889, 895, 26 C. C. A. 220, the defendant (in lieu of more extended changes), was required to affix the statement that 'Wm. H. Baker is distinct from and has no connection with the old chocolate manufactory of Walter Baker & Co.' In the case of Allegretti v. Allegretti, 52 N. E. 487, 177 Ill. 129, in the Supreme Court of Illinois, the court enjoined the defendants against the use of the name 'Allegretti', except in a manner indicating that the defendants' goods are 'manufactured and sold by B. F. Rubel, I. A. Rubel, and Giacomo Allegretti, and not by Ignazio Allegretti or the Allegretti Chocolate-Cream Company'."

In the case of Henderson vs. Peter Henderson & Co.; 9 Fed. (2d) 787, 788, 789, 790, the Court also said the following:

"Suit by Peter Henderson & Co., a corporation against Alexander Henderson, Decree for plaintiff, and defendant appeals. Decree modified, and as so modified, affirmed.

The appeal is from a decree awarding appellee relief on account of alleged infringement of statutory trade-mark and for unfair competition in trade.

Appellee's seed business was founded in the '50's by Peter Henderson, and soon became a partnership under name of Peter Henderson & Co., being such in 1890, when the founder died, his sons and surviving partners continuing the business for a short time under the old partnership name, and then organizing it into a New Jersey corporation having same name, and so continuing ever since. The

place of business was always in New York City, from which in the earlier stages of the business was done through dealers in various parts of the United States, but for the last 30 years or more no dealers have been employed; sales being through mail orders obtained through catalogues and extensive advertising in papers and periodicals. Its catalogue mailing list was in 1881 about 50,000, and grew steadily until now about 500,000, throughout the United States. Its seed packages bore the firm or corporation name, and many of them were labeled 'Henderson' or 'Henderson's' this, that, or the other seeds. So long was the name associated with its extensively advertised business and its products that the name 'Henderson' acquired a secondary significance in the seed business, indicating seeds and kindred products which originated with or were distributed by appellee. In 1907 appellee took advantage of the '10-year' trade-mark Act of 1905 (Comp. St. secs. 9485 et seq.), and procured from the United States Patent Office registration of 'Henderson' as a trade-mark for agricultural and horticultural seeds.

Appellant was raised in the seed business. As a youth he worked for a short time for appellee and then for others, and came to Chicago, where in 1910, with partners, he began a wholesale seed business under name of 'A. Henderson & Co.' In time the partners dropped out, but appellant continued the business under same partnership name. In 1919 he bought out one Winterson, who had for some years conducted at Chicago, under the name 'Winterson's Seed Store' a retail seed business; his sales being over the counter and by catalogue. Appellant moved his wholesale business into the Winterson store, continuing it there under the name of 'A. Henderson & Co.' and continuing the retail seed business under the name of 'Henderson's

Seed Store,' issuing catalogues in that name and so labeling his seed packages and other goods sold in connection with seeds. Appellant's retail trade is practically all confined to a radius of about 550 miles from its place of business, within which appellee has mail customers, which, though considerable in number, aggregate but a small percentage of its entire business. Since appellant's entry into the retail trade the evidence showed a few known instances of confusion with appellee's business, but not frequent and apparently not serious. It does not appear that this was by any procurement or intent of appellant, or that appellant undertook to bring about confusion of the names, or to unfairly compete with appellee, save only as this might be inferred from the enumerated facts."

"The trade-mark registration being effective, was it transgressed by appellant's use of it? We think it clear that under the circumstances the employment of the name 'Henderson's Seed Store' was in no sense necessary to insure to appellant the full opportunity to make use of his name in connection with his seed business. On principle as well as authority it is plain that he may not make such unnecessary use of it as will interfere with the trade rights which another had theretofore lawfully secured. Without entering into prolonged discussion of the cases, we refer to Waterman Co. v. Modern Pen Co., 235 U. S. 88, 35 S. Ct. 91, 59 L. Ed. 142, and Thaddeus Davids Co. v. Davids Mfg. Co., 233 U. S. 461, 34 S. Ct. 648, 58 L. Ed. 1046, Ann. Cas. 1915B, 322, in the Supreme Court, and Chickering, etc. v. Chickering & Sons, 215 F. 490, 131 C. C. A. 538, in this court, as indicating what our conclusion must be on the broad proposition of appellant's liability.

"We are of the opinion that the use of the initial 'A', preceding 'Henderson' in connection with

any part of appellant's seed business does not here, any more than in the Davids Case, avoid the conclusion of 'colorable imitation.'

Nor is the decree objectionable in providing that the term 'Henderson' shall not be employed by appellant in any name he may adopt for his seed packages. Appellee's lawful registry gives it the sole right to the employment of 'Henderson' as a name for its seed product, and, where lawful right to label a product with the registered name has been secured, the same words should not be employed in any name for another's like product where in reason this can be avoided."

In the case of Andrew Jergens Co. vs. Bonded Products Corporation, 13 Fed. (2d) 417, 423-424, the Court again said the following in a similar case:

"So far as I can see, the Woodbury's Facial Soap was the first to become, and remains so today, the most prominent 'Woodbury' soap on the market. The plaintiff has been associated with its manufacture and sale for over a quarter of a century. In this sense, plaintiff's soap has been the first on the market. Second comers in the market, while they should be allowed all reasonable opportunity to expand their business, nevertheless should and could avoid, and in fact under ordinary circumstances should be anxious to avoid, confusion of their product with that of another. It is not the province of this court to designate the kind of change or character of that type that would accomplish this result, although this occasionally has been done. Donnel v. Herring, 208 U. S. 267, 274, 28 S. Ct. 288, 52 L. Ed. 481; Baker v. Sanders, 80 F. 889, 893, 26 C. C. A. 220; Waterman Co. v. Modern Co., 235 U. S. 88, 35 S. Ct. 91, 59 L. Ed. 142. I fear, however, that any such allowed use here of such distinction, unless very carefully used would prob-

ably result in the same subtle deceit now apparent in defendant's wrappers, etc.

Sincerity and not subterfuge is required. 'Where the name is one which has previously theretofore come to indicate the source of manufacture of particular devices, the use of such name by another, unaccompanied with any precaution or indication, in itself amounts to an artifice calculated to produce the deception alluded to in the foregoing adjudications.' Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 188, 16 S. Ct. 1002, 1009, 41 L. Ed. 118. 'The fair and honest use of a person's own name in his ordinary and legitimate business, although to the detriment of another, will not be interfered with. A tricky, dishonest, and fraudulent use of a man's own name, for the purpose of deceiving the public, and of decoying it to a purchase of goods under a mistake or misapprehension of facts, will be prevented.' Rogers v. Rogers, 70 F. 1017, 17 C. C. A. 576. Opinions of Shipman and Wallace.

Thus it would seem to be required that the defendant must wrap and bend its soap, so as to make it plain 'even to the ignorant and unwary person' that its soap is its own, and not that of plaintiff's. A defendant must be sincere, and not 'slick', however much the inducement. He should not deliberately confuse, in the minds of the public, the source of his wares. As has been said: 'As is usual in such cases, the alleged infringer insists that he had no intention to dress up his goods to resemble complainants; that, on the contrary, the very identity of the surnames, Baker, "made him all the more careful to avoid any confusion therefrom." * * * His success in accentuating differences has certainly not been remarkable, and it is curious to note how frequently in cases of this kind the designer's efforts to produce wrappers, labels,

and inscriptions which shall be distinctly characteristic of some new make of goods result only in producing confussion with some earlier and well-known brand.' Walter Baker v. Sanders, 80 F. 889, 892, 26 C. C. A. 220, 223."

In the case of Coty Inc. vs. Perfume de Grande Luxe, 298 Fed. 865, 866-67, 869, 869-870, 871, 873-876, 877-878, the Court expressed itself as follows:

"Francois Joseph de Speturno Coty is a citizen of France, and a manufacturer in that country of perfumes and face powders and has been engaged in such business since 1905, during which time he has been selling his merchandise in the United States in packages bearing, in addition to other trade-marks, his surname 'Coty'. Ernest Coty is another French manufacturer of perfumes and toilet articles, and engaged in business in France since 1917. He sells his face powders in packages bearing his full name 'Ernest Coty', with the notation 'Maison fondee en 1917', which packages bear labels and coverings different in color and in design from those of the other Coty. The plaintiff in January, 1923, became the sole and exclusive owner of the business of Francois Joseph de Speturno Coty in the United States. The defendant Perfumes De Grande Luxe, Inc., in November, 1923, acquired by contract the exclusive sales agency in the United States for Ernest Coty's products."

"It seems to us that under all the circumstances of this case, upon principle and upon the adjudicated cases, no error was committed in enjoining the defendant from selling or advertising his goods without inserting upon the containers of packages the words, 'Not connected with the original Coty in letters of the same size, color, and print and

prominence as the word 'Ernest Coty'. The word 'original' does not in itself imply quality, but origin, and it serves to point out that the goods are not those of the manufacturer who was the first to produce and put on the market what the purchasing public know as 'Coty' perfumes. It is not only necessary for the proper protection of that business and of the good will attached to it, but for the protection of the public against deception as well. Anything less would not make deception and injury improbable, and that 'Ernest Coty' is not the original 'Coty' whose name is identified with the perfume trade throughout the world is certain."

"In trade-mark cases, the right to an injunction does not depend upon a wrongful intent in fact, if infringement is disclosed. In Thaddeus Davids Co. v. Davids, 233 U. S. 461, 471, 34 Sup. Ct. 648, 652 (58 L. Ed. 1046, Ann. Cas. 1915B, 322), Mr. Justice Hughes, speaking for the court, declared that in view of the statutory right it could not be considered necessary that the complainant, 'in order to establish infringement, should show wrongful intent in fact on the part of the defendant, or facts justifying the inference of such an intent. * * * Having duly registered under the act, the complainant would be entitled to protection against any infringing use.' But, where an injunction is issued to prevent unfair competition, the evidence must disclose wrongful intent in fact, or justify that inference from the inevitable consequences of the act complained of. Elgin National Watch Co. v. Illinois Watch Co., 179 U. S. 665, 21 Sup. Ct. 270, 45 L. Ed. 365.

We think that the reasons for not requiring proof of a fraudulent intent in cases of infringement of trade-marks apply with equal force in cases of unfair competition, the basis of the remedy be-

ing substantially the same. In both classes of cases the injury is the same, regardless of the intent with which it is done; and while there has been some difference of opinion, it is thought to be the better view that, where the necessary and probable tendency of defendant's conduct is to deceive the public and pass off his goods as and for those of the plaintiff, especially where preventive relief only sought, actual fraudulent intent need not be shown. See 38 Cyc. 784, where the cases are collected; Trappey v. McIlhenny Co. (C. C. A.) 281 Fed. 23, 27; Bissel Chilled Plow Works v. T. M. Bissell Plow Works (C. C.) 121 Fed. 387."

"We are not here concerned with the question as to what may be the rights of the defendant to carry on his business in France. Even if he had commenced his business in that country prior to the time that Francois Joseph de Speturno Coty had established his, the latter's rights in the business in the United States would not be in the least affected thereby, provided the latter was the first to establish a market in this country for his goods. In United Drug Co. v. Rectanus Co., 248 U. S. 90, 100, 39 Sup. Ct. 48, 63 L. Ed. 141, it is pointed out that the federal courts have held that a prior use of a trade-mark in a foreign country does not entitle its owner to claim exclusive trade-mark rights in the United States as against one who in good faith had adopted a like trade-mark here prior to the entry of the foreigner into this market. And see Le Blume Import Co. v. Coty (C. C. A.) 293 Fed. 344, 350."

"In Stark Bros. Nurseries & Orchards Co. v. Stark (D. C.) 248 Fed. 154, the facts were as follows: The complainant had registered its trade-mark under the act of 1905, which consisted of the words 'Stark Trees.' The defendants used the words 'William P. Stark Nurseries.' William P. Stark was one of the original Stark family, which

had been engaged in the nursery business for 90 or more years and made the name well known in that business. He was a stockholder in the complainant company at the time of the suit, and was at one time employed by it. He set up a competitive business, and associated with him in it his son, William H. Stark. The defendants in their advertising stated that they had 'no connection with any other concern.' District Judge Van Valkenburg held that, while the defendants were entitled to do business under their own name, the complainant was entitled to an injunction, and that the warning contained in the advertising matter, so far from absolving the defendants from the charge of unwarranted infringement, really invited the public to regard the defendants as the original Starks. An injunction was granted.

"The case was carried to the Circuit Court of Appeals for the Eighth Circuit, 257 Fed. 9, 168 C. C. A. 221. That court held that the court committed no error in granting a perpetual injunction, but it modified the decree by requiring the defendants in their printed matter to state 'that they are not of the original William Stark Nurseries.' The words added to the injunction order may be found in the margin.

"It is well-settled law that the mere name of an individual cannot become a valid technical trade-mark as against others bearing the same name. In Brown Chemical Co. v. Meyer, 139 U. S. 540, 11 Sup. Ct. 625, 35 L. Ed. 247 the Supreme Court declared that it was hardly necessary to say that an ordinary surname cannot be appropriated as a trade-mark by any one person as against others of the same name, who are using it for a legitimate purpose. In that case Mr. Justice Brown, who was writing for the court, said:

"A man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property. If such use be a reasonable, honest, and fair exercise of such right, he is no more liable for the incidental damage he may do a rival in trade than he would be for injury to his neighbor's property by the smoke issuing from his chimney, or for the fall of his neighbor's house by reason of necessary excavations upon his own land. These and similar instances are case of damnum absque injuria."

And see McLean v. Fleming, 96 U. S. 245, 24 L. Ed. 828; Singer Manufacturing Co. v. June Manufacturing Co., 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. Ed. 118; Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, 21 Sup. Ct. 270, 45 L. Ed. 365; Howe Scale Co. v. Wyckoff, Seamans & Benedict 197 U. S. 118, 134, 25 Sup. Ct. 609, 49 L. Ed. 972; Stix, Baer & Fuller Dry Goods Co. v. American Piano Co., 211 Fed. 271, 127 C. C. A. 639; William Rogers Manufacturing Co. v. Simpson 54 Conn. 527, 9 Atl. 395.

"While one cannot be denied the legitimate use of his name in carrying on his business, he cannot do so in a manner which invades the rights of others. And the courts have held that:

(1) He may not affirmatively do anything to cause the public to believe that his article is made by the first manufacturer.

(2) He must exercise reasonable care to prevent the public from so believing.

(3) He must exercise reasonable care to prevent the public from believing that he is the successor in business of the first manufacturer. Stix, Baer & Fuller Dry Goods Co. v. American Piano Company, supra; Stark Bros. Nurseries & Orchards Co. v. Stark, supra.

"In American Waltham Watch Co. v. United States Watch Co., 173 Mass. 85, 53 N. E. 141, 43 L. R. A. 826, 73 Am. St. Rep. 263 the court said:

'* * * The name of a person may become so associated with his goods that one of the same name coming into the business later will not be allowed to use even his own name without distinguishing his wares. Brinsmead v. Brinsmead, 13 Times Law R. 3; Reddaway v. Bonham (1896) A. C. 199, 210 See Singer Mfg. Co. v. June Mfg. Co. 163 U. S. 169, 204, 16 Sup. Ct. 1002; Cream Co. v. Keller, 85 Fed. 643. And so, we doubt not, may a geographical name acquire a similar association with a similar effect Montgomery v. Thompson, (1891) A. C. 217. Whatever might have been the doubts some years ago, we think that now it is pretty well settled that the plaintiff, merely on the strength of having been first in the field, may put later comers to the trouble of taking such reasonable precautions as are commercially practicable to prevent their lawful name and advertisements from deceitfully diverting the plaintiff's custom.'

In G. & C. Merriam Co. v. Ogilvie, 170 Fed. 167, 95 C. C. A. 423, the Circuit Court of Appeals for the First Circuit modified the restraining order entered below by directing the following words to be inserted therein.

'This dictionary is not published by the original publishers of Webster's Dictionary or by their successors.'

And it required that those words should clearly and unmistakably appear in the title page of every volume of the dictionary published by the respondent or his successors or assigns. A petition for a writ of certiorari to the Supreme Court was denied. And in a case in the Circuit Court of Appeals for the Sixth District, G. & C.

Merriam v. Saalfield, 190 Fed. 927, 932, 111 C. C. A. 517 referring to the terms of the injunction order in 170 Fed. 167, 95 C. C. A. 423 (the case above mentioned), the court said:

'It is not to be implied from what we have said that we regard the terms of the injunction ordered by the Circuit Court of Appeals for the First Circuit as an unreasonable or unjust limitation of the defendant's rights. On the contrary, we should be quite willing to adopt it, if the facts of this case should seem to call for it. The decisions of the Supreme Court in the cases of Singer Company v. June Company, 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. Ed. 118, and Herring Safe Co. v. Hall's Safe Co., 208 U. S. 554, 28 Sup. Ct. 350, 52 L. Ed. 616, amply justify the provisions of such an order.'

In the unreported case of Francois Joseph de Speturno Coty v. Coty Stores of America, Inc., previously mentioned herein, and decided May 15, 1922, the District Court of the United States for the State of Delaware granted an injunction restraining the defendant from using the name 'Coty' in advertising or otherwise in connection with perfumes or toilet preparations, unless accompanied by the name 'Ernest' in equally prominent letters, 'and from using the full name 'Ernest Coty', except when immediately followed by the phrase 'Not the original Coty' in lettering of the same style and at least one-half the size used for the words Ernest Coty'. It added:

'* * * But this shall not prevent the defendant's use of its corporate name, provided that it is accompanied by the said phrase in lettering of the same style and at least one-fourth the size used for the corporate name, nor shall it prevent the defendant from selling or offering for sale in its stores the products which it imports

bearing the name 'Ernest Coty', unaccompanied by the phrase 'Not the original Coty' provided that they do not bear the word 'Origan', or any imitation thereof, and provided that there is at all times prominently displayed and permanently fixed in each such store, present or future, a placard or such number of placards as may be necessary, in order that at least one such placard may be seen and easily read from any point in each such store, bearing the words, 'We are not the original Coty and do not carry his products.'"

The doctrine announced in the above cases is analogous to that which is applied in the case of expired patents, as illustrated in Singer Mfg. Co. v. June Mfg. Co. 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. Ed. 118. That case held that, after the expiration of the patents on the Singer machines, the name "Singer", by which such machines had come to be known, passed to the public with the cessation of the monopoly which the patent created, and that thereafter the public had the right to make the machine and affix the name Singer to it, but on condition that the one doing so must not deceive the public into thinking that it was manufactured by the original manufacturer. The court reversed the court below and remanded the cause, with directions to enter a decree perpetually enjoining the defendant.

"* * * First, from using the word 'Singer', or any equivalent thereto, in advertisements in relation to sewing machines, without clearly and unmistakably stating in all said advertisements that the machines are made by the defendant, as distinguished from the sewing machines made by the Singer Manufacturing Company; second, also perpetually enjoining the defendant from marking upon sewing machines or upon any plate or device connected therewith or attached thereto the word

'Singer', or words or letters equivalent thereto, without clearly and unmistakably specifying in connection therewith that such machines are the product of the defendant or other manufacturer, and therefore not the product of the Singer Manufacturing Company.'

But counsel for defendant insist that the injunction granted is not based upon the trade-mark, but upon alleged unfair competition, and does not restrain the defendants from infringing a trade-mark, and therefore was not properly granted under the rules of the court. The law of trade-marks is a part of the broader law of unfair competition. United Drug Co. v. Rectanus Co., 248 U. S. 90, 97, 39 Sup. Ct. 48, 63 L. Ed. 141. And as this court said in Hercules Powder Co. v. Newton, 266 Fed. 169, 174, the law of unfair competition is the natural evolution of the law of the trademark, out of which it has grown. There is no merit in the objection taken. Protection against unfair competition is afforded upon the same general principles upon which technical trade-marks are protected. And if a complaint prays an injunction for the infringement of a trade-mark, and the court, at a preliminary hearing and without passing upon the validity of the trade-mark, states that it is convinced from the affidavits presented that the defendant's conduct constitutes unfair competition, it may properly issue a preliminary injunction in the form adopted in the instant case. Whether the injunction goes to prevent the infringement of a trade-mark, or to prevent unfair competition, the object is the same, the protection of the plaintiff's right to the profits of his own business, and evidence introduced to show violation of a trade-mark may make out a clear case of unfair competition. And if under his complaint and the accompanying affidavits the plaintiff

makes out a prima facie case of unfair competition, he is entitled to a temporary injunction. The term infringement 'may be considered as a term covering all acts violating rights of others, either under the law as the technical trade-marks or that of unfair competition.' Nims on Unfair Business Competition, p. 40, Sec. 21."

In the case of Borden Ice Cream Co. vs. Borden's Condensed Milk Co., 201 Fed. 510, 513-514, the Court said the following:

"A personal name, such as 'Borden' is not susceptible of exclusive appropriation, and even its registration in the Patent Office cannot make it a valid trade-mark. Howe Scale Co. v. Wyckoff, 198 U. S. 134, 25 Sup. Ct. 609, 49 L. Ed. 972; Elgin Natl. Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, 21 Sup. Ct. 270, 45 L. Ed. 365; Singer Mfg. Co. v. June Mfg. Co. 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. Ed. 118; Brown Chemical Co. v. Meyer, 139 U. S. 540, 11 Sup. Ct. 625, 35 L. Ed. 247."

"The only theory upon which the injunction in this case can be sustained is upon that known as unfair competition. Relief against unfair competition is granted solely upon the ground that one who has built up a good will and reputation for his goods or business is entitled to all of the resultant benefits. Good will or business popularity is property, and, like other property, will be protected against fraudulent invasion.

The question to be determined in every case of unfair competition is whether or not, as a matter of fact, the name used by the defendant had come previously to indicate and designate the complainant's goods. Or, to put it in another way, whether the defendant, as a matter of fact, is, by his con-

duct passing off his goods as the complainant's goods, or his business as the complainant's business."

"Non-exclusive trade-names are public property in their primary sense, but they may in their secondary sense come to be understood as indicating the goods or business of a particular trader. Such trade-names, are acquired by adoption and user, and belong to the one who first used them and gave them value in a specific line of business. It is true that the name of a person may become so associated with his goods or business that another person of the same or a similar name engaging in the same business will not be allowed to use even his own name, without affirmatively distinguishing his goods or business.

The secondary meaning of a name, however, has no legal significance, unless the two persons make or deal in the same kind of goods. Clearly the appellants here could make gloves, or plows, or cutlery, under the name 'Borden' without infringing upon any property right of the old company. If that is true, they can make any thing under the name 'Borden' which the appellee has not already made and offered to the public. George v. Smith (C. C.) 52 Fed. 830."

And finally in the case of Wm. Rogers Mfg. Co. vs. Rogers & Spurr Mfg. Co., 11 Fed. 495, 499-500, the Court said the following:

"A great deal was said in argument about the natural right of a man to use his own name in any business that he chooses to adopt. This, however, as I have said, is the case of a defendant corporation which has adopted a name to suit its business; and of persons, having the name, who have adopted a trade-mark to let out for hire to other people.

Even if we grant all that has been said about

the freedom to use names, (and I grant upon that subject much more than has been argued, for I set no limits to that freedom, excepting interference with acquired rights), the books are full of cases in which defendants have been restrained from using their own names in a way to appropriate the good-will of a business already established by others of that name. Croft v. Day, 7 Beav. 84; Metzler v. Wood, L. R. 8 Ch. D. 606; Fallwood v. Fallwood, L. R. 9 Ch. D. 176; Levy v. Walker L. R. 10 Ch. D. 436; Massam v. Thorley, L. R. 14 Ch. D. 748; McLean v. Fleming, 96 U. S. 245; Devlin v. Devlin, 69 N. Y. 212; Filkins v. Blackman, 13 Blatchf. 440; Stonebraker v. Stonebraker, 33 Md. 252; Shaver v. Shaver, 54 Iowa, 208; (S. C. 6 N. W. Rep. 188;) Churton v. Douglas, Johns. (Eng.) 174. See 25 Albany Law J. 203.

All these cases in equity depend upon an appropriation by one person of the reputation of another, sometimes actually fraudulent, and sometimes only constructively so.

'It should never be forgotten in these cases that the sole right to restrain anybody from using any name that he likes in the course of any business that he chooses to carry on is a right in the nature of trade-mark,—that is to say, a man has a right to say, "You must not use a name, whether fictitious or real; you must not use a description, whether true or not, which is intended to represent, or calculated to represent, to the world that your business is my business, and so, by fraudulent misstatement, deprive me of the profits of the business which would otherwise come to me" '. Per James, L. J., Levy v. Walker, L. R. 10 Ch. D. 447-8.

The reason why artificial trade-marks are absolutely protected, without inquiry into motives, etc., is that the defendant has no natural right to

such a symbol, and has the whole world of nature from which to choose his own. The same principle, in my judgment, applies to corporate names; but here I am met by authorities hesitating to take this ground, as I have said. The defendants insist that there is no sufficient evidence that purchasers would be misled. The purpose being what it was, it would not need a great deal of evidence to prove it successfully accomplished. There is evidence that buyers at retail would be very likely to be deceived.

But the defendants say, again, 'Rogers' has become a mere designation of a particular kind of ware, like Thompsonian medicines, or Singer sewing machines. Thompson v. Winchester, 19 Pick. 214; Singer Co. v. Larsen, Cox, Dig. No. 659. But the evidence does not support this defense. The Rogers name does not express a certain sort of goods, but serves as a warranty of good workmanship, because all those persons who have used it have followed faithfully the excellent example of the original Rogerses, who insisted on honest work.

It is further argued that the Rogerses are so many that the court cannot find an intent to appropriate the reputation of one of them more than another; and that, if any suit will lie, it must be by all those who use any trade-mark whose distinctive feature is the name Rogers. I believe it to be true that the Greenfield Rogerses did not inquire, nor did the defendants care, whose reputation they were making available; but I am of opinion that any one of those who rightly uses the name may enjoin its interfering use by others."

Having demonstrated by adjudicated decisions that the word "Rogers" is susceptible of appropriation and registration, and that it must be protected as a trade-mark to safeguard the good will, we now

come to the last question of whether H. E. Heacock Co., under the established facts, has a right to the remedies prayed for in its complaint.

Sections 3 and 7 of Act No. 666 provide as follows:

> "SEC. 3. The ownership or possession of a trade-mark, heretofore or hereafter appropriated, as in the foregoing section provided, shall be recognized and protected in the same manner and to the same extent, as are other property rights known to the law. To this end any person entitled to the exclusive use of a trade-mark to designate the origin or ownership of goods he has made or deals in may recover damages in a civil action from any person who has sold goods of a similar kind, bearing such trade-mark, and the measure of the damages suffered, at the option of the complaining party, shall be either the reasonable profit which the complaining party would have made had the defendant not sold the goods with the trade-mark aforesaid, or the profit which the defendant actually made out of the sale of the goods with the trade-mark, and in cases where actual intent to mislead the public or to defraud the owner of the trade-mark shall be shown in the discretion of the court, the damages may be doubled. The complaining party, upon proper showing, may have a preliminary injunction, restraining the defendant temporarily from use of the trade-mark pending the hearing, to be granted or dissolved in the manner provided in the Code of Civil Procedure, and such injunction upon final hearing, if the complainant's property in the trade-mark and the defendant's violation thereof shall be fully established, shall be made perpetual, and this injunction shall be part of the judgment for damages to be rendered in the same cause as above provided."

"SEC. 7. (as amended by Act 3423). Any person who in selling his goods shall give them the general appearance of goods of another manufacturer or dealer, either in the wrapping of the packages in which they are contained, or the devices or words thereon, or in the manner of their appearance, which would be likely to influence purchasers to believe that the goods offered are those of a manufacturer or dealer who holds a duly registered patent therefor or who has long been accustomed to manufacture or sell such goods and who is other than the actual manufacturer or dealer, and who clothes the goods with such appearance for the purpose of deceiving the public and defrauding another of his legitimate trade, or any subsequent vendor of such goods or any agent of any vendor engaged in selling such goods with a like purpose, shall be guilty of unfair competition, and shall be liable to an action for damages, in which the measure shall be the same as that provided for a violation of a trade-mark rights, together with discretionary power in the court to impose double damages if the circumstances call for the same. The injured party may also have a remedy by injunction similar to that provided for in cases of violation or trade-marks. This section applies in cases where the deceitful appearance of the goods, misleading as to origin or ownership, is effected not by means of technical trade-marks, emblems, signs, or devices, but by the general appearance of the package containing the goods, or by the devices or words thereon, even though such packages, devices, or words are not by law capable of appropriation as trade-marks; and in order that the action shall lie under this section, actual intent to deceive the public and defraud a competitor may be inferred from similarity in the appearance of the goods as packed or offered for sale to those of the complaining party."

From a reading of the foregoing, it may be inferred that H. E. Heacock Co., in this case is entitled to an indemnity from the adverse corporations, not only because the latter violated a registered trade-mark, but also because they engaged in unlawful competition which was not authorized. It does not appear, however, that the facts justify the contention of the plaintiff corporation that it be given damages double the amount of the profits which the other corporations have earned. A sum equal to said profits would be sufficient compensation.

WHEREFORE, judgment is rendered in favor of H. E. Heacock Co., and Wm. A. Rogers, Ltd., and the American Trading Co. are ordered:

(a) To render, within thirty days, an account of the profits or earnings which they had obtained by the importation and sale in the Philippines of silver-plated wares for use in the table and others bearing the trade-mark "Rogers" and other distinctive symbols, from the time they engaged in said business up to the present time;

(b) To pay to said plaintiff a sum of money equal to said profits and earnings which they had obtained in said business, and

(c) That they perpetually abstain from importing and selling in the Philippine Islands silver-plated wares for use in the table and for other purposes similar to those imported and sold by the plaintiff, bearing the trade-mark "Rogers."

The complaint filed by Wm. A. Rogers, Ltd. and the American Trading Co. in civil case No. 32956 is hereby dismissed, as well as the counterclaim interposed in the other case, and the writ of preliminary injunction issued on petition of is hereby annulled. Wm. A. Rogers, Ltd., and the American Trading Co., shall likewise pay the costs in the two cases.

It is so ordered.

On March 14, 1929, the plaintiffs herein by their undersigned attorney, duly excepted to the above-quoted decision.

That on April 11, 1929, the said plaintiffs herein, by their undersigned attorney, filed the following motion for a new trial, to-wit:—

(CAPTION AND TITLE OMITTED)

Come now the plaintiffs herein, through their undersigned attorney, and respectfully move this Honorable Court to set aside and declare null and void the judgment heretofore rendered herein, and to grant them a new trial of the above-entitled action for the following reasons:—

1.—That the findings of this Honorable Court as set forth in said decision are manifestly and openly contrary to the evidence presented;

2.—That the evidence presented at the hearing of the above-entitled action is insufficient to justify the decision rendered therein; and,

3.—That such decision is contrary to law.

That on April 22, 1929, the said plaintiffs' motion for a new trial was overruled, notice of such overruling was given it on May 3, 1929, and on May 7, 1929 the said plaintiffs duly excepted to the said resolution and gave notice of their intention to appeal from the judgment rendered herein to the Supreme Court of the Philippine Islands, on a bill of exceptions.

On May 15, 1929, the petitioners presented their Bill of Exceptions for approval.

(K)

On May 24, 1929, in case G. R. No. 31851, counsel for the plaintiff filed the following opposition to defendant's Bill of Exceptions.

(CAPTION AND TITLE OMITTED)

PLAINTIFF'S OPPOSITION TO DEFENDANT'S BILL OF EXCEPTIONS

Comes now the plaintiff in the above-entitled case and hereby opposes the allowance of the Bill of Exceptions tendered by the defendant for the reason that the judgment appealed from is not yet final, but merely interlocutory.

ARGUMENT

The judgment rendered in this case orders the defendant to render an accounting to the court of its profits as provided by the Philippine Trade-Mark Law, and to pay to the plaintiff such profits as may

result from such accounting. Under these circumstances, the judgment is not final but merely interlocutory for the reason that there is something yet to be done by the defendant upon which the court is to pass its judgment.

If this appeal is allowed, the probabilities are that there would be another appeal on the accounting, which would necessarily overburden the courts in the determination of this case.

The authorities are clear on this point:—

> "A decree is final when it decides and disposes of the whole merits of the case, reserving no further questions or directions for the future judicial consideration and determination."
>
> (16 Cyc. 471)

> "As is seen by the foregoing, when the case was brought up to this higher tribunal through the corresponding bill of exceptions on appeal from the judgment of the lower court whereby said partnership between the plaintiff and the defendant was declared dissolved from May 1, 1909, the matter of the rendition of accounts ordered by that court in said judgment and the approval thereof was still pending, so, as counsel for the defendant—appellee quite correctly says, the case had not yet been terminated in the Court of First Instance and was not appealable until termination thereof, and the accounts to which the plaintiff, according to that court, was entitled to have rendered her, were either approved or disapproved. Consequently, the appeal filed by the plaintiff and allowed from said judgment in so far as it declared said partnership to have been dissolved was premature."
>
> (Natividad vs. Villarica, 31 P. R. 172-176)

"The trial court rendered judgment ordering, among other things, that the plaintiff make a liquidation of the said partnership.

In the case of Natividad vs. Villarica (31 Phil. 172), this court laid down the following doctrine:

'APPEAL; PREMATURE APPEAL.—When the rendition of accounts ordered by the Court of First Instance in dissolving a partnership is still pending, the case cannot be considered terminated in that court until said accounts have been rendered and approved, and consequently the allowance of the appeal filed by one of the parties from the judgment declaring the partnership dissolved is premature.'

The liquidation which the plaintiff has to make in obedience to said order of the court, does not settle the litigation, but said liquidation must be submitted to the court for decision, from which the parties may take an appeal, if the same is not agreeable to them.

Following, then, the doctrine laid down in the case above cited, the appeal herein interposed is held premature, and it is ordered that the record be returned to the court of origin for further proceedings, without any special pronouncement as to costs."

(Vivencio vs. Borja, 50 P. R. 148)

FOR ALL OF THE FOREGOING REASONS, it is respectfully prayed that the bill of exceptions tendered by the defendant be disallowed.

Manila, P. I., May 24, 1929.

DEWITT, PERKINS & BRADY
By ALFONSO ENRILE
Attorneys for plaintiff
601 Pacific Bldg., Manila

Received copy this 25th
day of May, 1929.
(SGD.) J. W. FERRIER
Attorney for Defendant
12 Escolta, Manila.

(L)

On May 31, 1929, counsel for the defendant in the aforesaid case, filed the following reply to the foregoing opposition:

(CAPTION AND TITLE OMITTED)

REPLY OF DEFENDANT TO PLAINTIFF'S OPPOSITION TO BILL OF EXCEPTIONS

Comes now the defendant herein, by its undersigned attorney, and in reply to the opposition presented herein by the plaintiff to the Bill of Exceptions filed herein by the defendant, respectfully shows to this Honorable Court:—

The objection to the Bill of Exceptions is based upon the alleged claim that the judgment rendered herein orders the defendant to render an accounting to the Court of its profits as provided by the Philippine Trade-Mark Law, and to pay to the plaintiff such profits as may result from such accounting. It is true that the said judgment does order an accounting but it is not true that the Philippine Trade-Mark Law provides for any such an accounting. Section 3 of said Act (No. 666) provides that trademarks shall be protected in the same manner and to the same extent as any other property rights known to the law. It further provides that the

injured party may have one of two recoveries: (a) What he lost by the infringement, or (b) What the other party gained by same. However, it is his duty to prove these losses or gains in the action which he brings, which the plaintiff completely failed to do in the present case.

Has it the right to get such proof by means of the accounting which it now seeks to have enforced? We respectfully insist that it has not. Not having such a right it has no reason to ask for the accounting before the appeal, as it would not even be entitled to it after the appeal unless the Supreme Court should confirm the finding of the lower Court that there was a violation of the trade-mark of plaintiff by this defendant. This proposition will be further elaborated in our further discussion of the objections filed herein.

The accounting which was ordered in the present case was based upon a finding that there had been a violation of the trade-mark of the plaintiff by the defendant. This finding is the vital point in the whole case. If it falls, as we contend it will when the Supreme Court determines the matter, any excuse for an accounting is gone.

All the decisions cited by plaintiff in its objection to the approval of the Bill of Exceptions and in support of its contention that when an accounting is ordered, it must be made before an appeal can be

taken are cases involving dissolutions of copartnerships. In each of such cases there was a clear admission that a copartnership existed. It followed, therefore, that upon its dissolution, there would have to be an accounting. In the present case, however, there is no admission on the part of this defendant of a violation of a trade-mark, the very foundation of the order for an accounting.

Furthermore, in a copartnership matter, the partners are, or at least are presumed to be, more or less familiar with the business in which they have an interest and with the particular interest which each of them has in such business. In the present case the plaintiff does not know the amount of business done by the defendant, nor can it be any of its business to have such information until a final decision to the effect that there has been a violation of the trade-mark in question has been made, and very likely not even then. It is not to be presumed that the law will compel a business man to give to his competitor knowledge of his business until such time as it is finally decided that he is entitled to such knowledge. To render such an accounting at the present time is to give to the plaintiff knowledge of the business of the defendant to which it may be ultimately found it is not entitled. In a copartnership dissolution on the other hand, all the partners have an interest in the finances of the copartnership, and the business of no one of them can be injured by the accounting.

An examination of the cases cited by plaintiff shows also that they are not applicable to the present case. In the case of *Natividad* vs. *Villarica*, 31 Phil. Rep. 172, cited in support of plaintiff's objection, the action was begun by the filing of a complaint on May 2, 1913, in which the plaintiff asked judgment against the defendant for the sum of ₱703.00 with legal interest, alleged to be the amount which she had contributed to the capital of a copartnership between herself and the defendant, and to which the defendant had contributed ₱2,007, on the ground that the defendant had violated the partnership agreement by not preparing a balance sheet of the business. The trial Court found that the partnership had been dissolved as of May 1, 1909, four years before the beginning of the action. The lower Court also found that an accounting had not been made and ordered one made. It results, therefore, that the Lower Court in such case did not order the dissolution of the copartnership, but only found as done something which had been already accomplished. It is also to be noted that the party appealing in said case is the one in whose favor the accounting was ordered to be made by the opposite party. This case, in the opinion of the undersigned, is not decisive of the present case. If the facts in such case had been that one of the parties denied the existence of a copartnership between them, and the Lower Court found that it did exist, and then ordered its dissolution and an ac-

counting, from which order the appeal had been taken, and the Supreme Court had then made the order which it made, then such case might be given consideration in the determination of the objection raised here. In other words, if in the present case both parties agreed that there was a violation by one of the trade-mark of the other, then the only question would be the amount of damages to be determined by such accounting. But such agreement does not exist here, where the defendant denies any violation of any legal trade-mark of the plaintiff, and until that violation is finally determined there is no authority to require an accounting.

Furthermore, in accordance with the decision in Forbes, Munn & Co., vs. Ang San To, 40 Phil. Rep. 272, it is readily to be seen that the damages, if any are awarded, must be proven at the hearing. The plaintiff here failed to prove any. Has it a right to attempt to establish them by an accounting after the hearing has been closed? We think not, and unless the Supreme Court finds a violation of the trade-mark as did the lower court, and sends the case back for further proceedings as it did in the Ang San To case, cited above, no damages can be allowed, and certainly no accounting could be demanded in the absence of proof of damages. See also the same case 43 Phil. Rep. 724.

The case of Vivencio vs. Borja, 50 Phil. Rep. 148, cited by the plaintiff in its opposition to the

Bill of Exceptions presented herein, is of but little, if any, value in the determination of the questions raised here. It is no more than a reiteration of the decision rendered in Natividad vs. Villarica, and involves the distribution of the assets of a copartnership which had been dissolved before the case had been presented to the Court. The arguments heretofore made herein in connection with the Natividad vs. Villarica case are applicable to the Vivencio vs. Borja case.

It is respectfully submitted, therefore, that plaintiff's objection to the approval of the Bill of Exceptions presented herein should be overruled and denied.

For all of which reasons the defendant respectfully contends that the Bill of Exceptions presented herein should be approved in the form as presented.

Manila, P. I., May 31, 1929.

Respectfully submitted,
(SGD.) J. W. FERRIER,
Attorney for the Defendant,
No. 12 Escolta, Manila, P. I.

Received copy: June 1, 1929
DEWITT, PERKINS & BRADY
By: J. ORTEGA
Attorneys for the Plaintiff
601 Pacific Building, Manila, P. I.

(M)

On June 11, 1929, the Court of First Instance

of Manila, entered the following order:

(CAPTION AND TITLE OMITTED)

ORDER

This case is before the Court on the motion to approve the Bill of Exceptions tendered by the defendant. The plaintiff objects to the allowance of the Bill of Exceptions at this time alleging that the judgment from which the defendant appeals has not yet become final. This objection is well founded in the opinion of the Court. In the Court's decision, the defendant is ordered to render an account within thirty days of the profits it obtained from the importation and sale in the Philippine Islands of flatware bearing the trade mark "ROGERS". As such account has not yet been made much less passed upon by the Court, this appeal is premature.

WHEREFORE, the Bill of Exceptions presented by defendant is disallowed, pending submission of, and action on, the account to be rendered as ordered by the Court in its decision.

Manila, P. I., June 11, 1929.

(SGD.) PEDRO TUASON
Judge.

(N)

In the other case, G. R. No. 31852, a similar [illegible] the approval of plaintiffs' Bill of Exceptions [illegible] by the plaintiffs, and an order by the Court disallowing said Bill of Exceptions, were

(O)

On July 6, 1929, counsel for Wm. A. Rogers, Ltd., and the American Trading Company presented petitions to the Supreme Court in cases G. R. Nos. 31851 and 31852, praying that, in accordance with Section 499 of the Code of Civil Procedure, a writ of mandamus issue, directed to the Honorable Pedro Tuason, or to the Judge presiding over the Fourth Branch of the Court of First Instance of Manila, commanding him to sign and certify the bills of Exceptions filed by Wm. A. Rogers, Ltd., and the American Trading Company.

(P)

On July 12, 1929, the Supreme Court required the respondent Judge to show cause in writing, within ten days, why the writ prayed for should not be granted.

(Q)

On July 25, 1929, the respondent Judge filed his answers to the aforesaid petitions, and respectfully submitted that the ruling made by the respondent disallowing petitioners' bills of exceptions in the aforesaid cases was correct; that the judgment rendered by the Honorable Carlos Imperial, Judge of Branch IV of the Court of First Instance of Manila on March 11, 1929, ordering the petitioners to render account of their profits within thirty days was not appealable final decree or judgment but merely interlocutory; and that, therefore, the writ of

mandamus prayed for by the petitioners should be denied with costs to the petitioners.

(R)

On July 26, 1929, the Supreme Court set the cases for hearing on August 1, 1929.

On August 1, 1929, the hearing of the cases took place, and the petition of counsel for the petitioners to file a list of authorities and a certified copy of the decision of the Supreme Court of Columbia was granted.

(S)

On September 6, 1929, the Supreme Court rendered the following decision on the petitions for a writ of mandamus:

(CAPTION AND TITLES OMITTED)

STATEMENT

This is a petition for a writ of mandamus to the Judge of the lower court commanding him to sign and certify defendant's bill of exceptions, a copy of which is attached to, and made a part of, the petition.

It is alleged that H. E. Heacock Company commenced an action in the Court of First Instance of Manila on January 12, 1928, against the American Trading Company for an alleged infringement of trademark and unfair competition, based upon Sections 3 and 7 of Act No. 666, and in substance that on June 27, 1918, it caused to be registered in the Bureau of Commerce and Industry a trademark

consisting of the word "Rogers" for use upon spoons and other flatware imported by it and sold throughout the Philippine Islands. That the American Trading Company, with knowledge of such trademark, and in the year 1925, began to import and sell within the Philippine Islands flatware bearing the trademark "Wm. A. Rogers." That the defendant has given the flatware the appearance of that imported and sold by the plaintiff in such a way as to induce purchasers to believe that the flatware which it imported and sold is the same as that imported and sold by the plaintiff. "That such imitation of plaintiff's trademark upon the flatware imported by the defendant has been effected by the defendant for the purpose of deceiving the public and defrauding the plaintiff of its legitimate trade, and that the public has been and is being deceived and this plaintiff has been and is being defrauded thereby to its great damage." Plaintiff prays for a perpetual injunction and for an accounting of the sales, and for double the amount of the profits as damages.

February 11, 1928, the American Trading Company filed its answer and alleged in substance that the registration by the plaintiff of the name "Rogers" as a trademark was of no legal validity as against the defendant, for the reason that the name "Rogers" is a family name which did not belong to the plaintiff, and that plaintiff has no legal right

to appropriate it. That all the silverware and flatware imported by the defendant and sold within the Philippine Islands bear the words "Wm. A. Rogers", together with other symbols and marks as the trademarks thereon, were manufactured by Wm. A. Rogers Ltd. in the United States, and that the trademarks appearing thereon had been duly registered in the Patent Office of the United States in accordance with the provisions of the Acts of Congress of February 2, 1905, May 4, 1906, March 2, 1907, and February 18, 1909, and that such articles were admissible to this country under the provisions of Act No. 2480, and that the American Trading Company is the local agent in the Philippine Islands of the manufacturer Wm. A. Rogers, Ltd.

Concurrent with the action of H. E. Heacock Company, the defendant American Trading Company, and Wm. A. Rogers, Ltd. commenced an action in the Court of First Instance of Manila against H. E. Heacock Company in which they alleged that they were the owners of certain trademarks therein set forth and prayed for an injunction against H. E. Heacock Company prohibiting it from interfering with the business of the plaintiffs.

By stipulation the two cases involving the use of such trademarks were heard and tried together in Branch IV of the Court of First Instance of Manila which rendered a joint decision, in which it

found in substance that Wm. A. Rogers, Ltd. and the American Trading Company had infringed plaintiff's trademark and had been guilty of unfair competition, and ordered them to render an accounting to H. E. Heacock Company, and perpetually enjoined them from importing and selling in the Philippine Islands flatware bearing the trademark "Rogers". To which decision exceptions were duly presented and motions for reconsideration were duly filed and overruled. Thereafter, and within the time provided by law, the American Trading Company, in Case No. 32952, filed and tendered for approval by the court its bill of exceptions, and on the same day plaintiffs Wm. A. Rogers Ltd. and the American Trading Company, in Case No. 32956, filed and tendered their bill of exceptions for approval. H. E. Heacock Company appeared and objected upon the ground that the proposed appeal was premature, and that the judgment rendered was not final and, hence, not appealable under Section 123 of the Code of Civil Procedure.

JOHNS, J.:

There is no objection to the bill of exceptions tendered either as to form or substance, and after an exhaustive hearing, the lower court refused to certify them on the sole ground that no final judgment had been rendered in either case. As a result of which, these petitions were filed in each case

in which it is prayed that a writ of mandamus issue, directed to the Judge of the lower court, commanding him to sign and certify the bills of exceptions which are incorporated in, and made a part of, the respective petitions.

Both parties filed exhaustive brief in the lower court and in this court and, as stated, the only question presented involves the construction of Section 123 of the Code of Civil Procedure, which is as follows:

"No interlocutory or incidental ruling, order, or judgment of the Court of First Instance shall stay the progress of an action or proceeding therein pending, but only such ruling, order, or judgment as finally determines the action or proceeding nor shall any ruling, order, or judgment be the subject of appeal to the Supreme Court until final judgment is rendered for one party or the other."

The court rendered the following judgment:

"Wherefore, judgment is rendered in favor of H. E. Heacock Co., and Wm. A. Rogers, Ltd. and the American Trading Co. are ordered:

(a) To render an accounting, within thirty days, of the profits or gains which they have obtained from the importation and sale in the Philippine Islands of the silverware and flatware bearing the trademark Rogers and other symbols of marks, from the time they engaged in said business up to this date;

(b) To pay to the aforesaid plaintiff a sum of money equal to the gains or profits that they had obtained from said business; and

"(c) To forever abstain from importing and selling within the Philippine Islands silverware and other articles similar to those which the plaintiff is importing and selling, and which bear as a trademark or trade-name the word 'Rogers.'

"The complaint filed by Wm. A. Rogers, Ltd. and American Trading Co., in Civil Case No. 32956, as well as their counterclaim interposed in the other case, is dismissed, and the writ of preliminary injunction issued at the instance of said parties, is declared without force and effect. Wm. A. Rogers, Ltd. and the American Trading Co., furthermore, are to pay the costs of both actions.

"So ordered."

Construing the pleadings of the respective parties, it must be conceded that the primary purpose of both actions was to judicially ascertain and determine who was the true owner of the trademark in question, and which party had the exclusive right to the use of the trademark in the Philippine Islands. That is to say, if H. E. Heacock Company was the true owner and had the exclusive right to use the word "Rogers" in the Philippine Islands, and that the American Trading Company was infringing upon its trademark, then it would follow that H. E. Heacock Company would be entitled to a judgment that it was the owner of the trademark and the right to its exclusive use, and to an injunction against the American Trading Company from in-

terferins with its business. On the other hand, if the word "Rogers" is a family name, and that all silverware and flatware imported by the defendant American Trading Company was manufactured by Wm. A. Rogers, Ltd. in the United States, and that the trademark appearing thereon had been duly registered in the Patent Office of that country in accordance with the Acts of Congress as alleged, and the American Trading Company is the local agent of the manufacturer Wm. A. Rogers, Ltd., then it would follow that they would have grounds for complaint against the use of their trademark by H. E. Heacock Company, and to have such use prohibited. That is to say, the real and important question involved under the pleadings is as to who is the owner and entitled to the use of the trademark in the Philippine Islands. In legal effect, the lower court held that it was the H. E. Heacock Company, and enjoined the American Trading Company to forever abstain from importing and selling any silverware within the Philippine Islands which bears the trademark or tradename of the word "Rogers". That was the primary and fundamental purpose of the suit, and based upon, and as incidental to, that judgment, the lower court ordered that an accounting should be rendered of the profits or gains from the use of the word "Rogers" by the American Trading Company. Hence, the real question presented is whether or not the judgment, as rendered by the

lower court, is now final within the meaning of Section 123 of the Code of Civil Procedure. It must be conceded that under the early decisions of this court such a judgment is not a final judgment within the meaning of that section. It must also be conceded that its recent decisions on that question are more or less in conflict.

Upon that legal question, Ruling Case Law, Vol. 2, p. 41, Section 23, says:

> "There is an irreconcilable conflict of authority on the question whether a decree, adjudicating all the equities, but reserving for future determination a settlement of accounts between the parties on the coming in of a master's report, is final or interlocutory. The rule which obtains in apparently a majority of the jurisdictions is, that when a decree is rendered settling all the equities, such a decree is final for the purposes of appeal, though a settlement of accounts between the parties is reserved for future determination on the report of the master. In a number of jurisdictions, however, the doctrine is laid down that a decree which reserves for future determination a settlement of accounts between the parties, though adjudicating the equities involved, is an interlocutory decree from which an appeal cannot be taken until the final decree is rendered."

That section is apparently copied from the notes to the decision in Gray v. Amos, 220 Ill. 251; American and English Annotated Cases, Vol. 5, p. 174, in which the same language is used, and it is said:

"This rule finds support and illustration in the following cases."

Citing numerous decisions from the Supreme Courts of Alabama and Michigan, and decisions from Arkansas, California, Illinois, Iowa, Maryland, Minnesota, Missouri, Montana, Nebraska, Oregon, and Texas, in which it is said:

"It now appears to be the settled law in Michigan that a decree adjudicating the equities, though reserving for future determination a settlement of the accounts between the parties on report of the master, is final decree for the purpose of appeal."

And among other things, the Supreme Court of Alabama said:

"If the opinion of the chancellor is erroneous, the delay, expense, and trouble attending the ascertainment of the facts preparatory to an account, are unnecessary and profitless."

In this note, it is said that the States of Florida, Kentucky, Mississippi, New York, Ohio, South Carolina, Tennessee, and Virginia, held that such a judgment is not final until after the accounting has been made. The note also says the case of McGourkey v. Toledo, etc. H. Co., 146 U. S. 536, in which that court, after reviewing the authorities, laid down this distinguishing rule:

"It may be said in general that if the court make a decree fixing the rights and liabilities of

> the parties, and thereupon refer the case to a master for a ministerial purpose only, and no further proceedings in court are contemplated, the decree is final; but if it refer the case to him as a subordinate court and for a judicial purpose, as to state an account between the parties, upon which a further decree is to be entered, the decree is not final. * * * But even if an account be ordered taken, if such accounting be not asked for in the bill, and be ordered simply in execution of the decree, and such decree be final as to all matters within the pleadings, it will be regarded as final."

In the instant case the lower court found, in legal effect, in both cases, that H. E. Heacock Company was the owner and entitled to the exclusive use of the trademark or tradename "Rogers" in the Philippine Islands, and that in the selling of these wares the American Trading Company infringed upon its use of that trademark, and enjoined it from importing and selling within the Philippine Islands silver ware articles similar to those which the plaintiff is importing and selling, and which have as the trademark the words "Rogers". In legal effect, that was a judgment on the merits as to the ownership and the right to the use of the trademark.

In this kind of a case, in particular, and in accord with the weight of authority, we hold that, under the issues made by the pleadings, the primary purpose in both cases was to ascertain and determine who was the true owner and entitled to the exclusive use of the disputed trademark, and that the judgment which was rendered by the lower court

was a judgment on the merits as to those questions and that the order of the court for an accounting was based upon, and is incidental to, the judgment on the merits. That is to say, that the judgment which the lower court rendered was a final judgment within the meaning of Section 123 of the Code of Civil Procedure; that in this kind of a case an accounting is a mere incident to the judgments; that an appeal lies from the rendition of the judgment as rendered; and that for such reasons it was the legal duty of the lower court to sign and certify the bills of exceptions as tendered. From our point of view, this is more in harmony with the administration of justice and the spirit and intent of the code. If on appeal the judgment of the lower court is affirmed, it would not in the least work an injustice to any of the legal rights of H. F. Heacock Company. On the other hand, if for any reason this court should reverse the judgment of the lower court, the accounting would be a waste of time and money, and might work a material injury to the petitioner. This decision is in accord with the trend of the opinion of this court in Africa vs. Africa, 42 Phil. 964. Anything now said must not be considered to be the last word of this court on the matter.

It follows that, in both cases, the writ of mandamus should issue to the lower court to sign and

certify the tendered bills of exceptions as prayed for in the petition. Neither party to recover costs.

It is so ordered.

(Sgd.) CHARLES A. JOHNS

WE CONCUR:

(Sgd.) RAMON AVANCEÑA
" THOS. A. STREET
" IGNACIO VILLAMOR
" NORBERTO ROMUALDEZ
" ANTONIO VILLA-REAL

JOHNSON, J., took no part in the consideration of this case.

(T)

On September 7, 1929, counsel for the American Trading Company and Wm. A. Rogers, Ltd., filed the following memorandum and motion.

(HEADING AND TITLES OMITTED)

MEMORANDUM AND MOTION

COMES NOW, the American Trading Company and William A. Rogers, Ltd., by its undersigned attorneys and respectfully shows to this Honorable Tribunal that since the beginning of the above-entitled actions and the decision of the Lower Court therein, the said Wm. A. Rogers, Ltd., has registered with the Bureau of Commerce & Industry of the Philippine Islands, its trademark "Wm. A. Rogers", and is, therefore, now upon the same standing in so far as registration of trademarks in

the Philippine Islands is concerned, as the H. E. Heacock Company. Said trademark was registered with the said Bureau of Commerce and Industry, was given Number 9662 of said Bureau, and is a copy of, and the same thing as, Trademark No. 68369 of the United States of America, first registered in the Patent Office at Washington on March 31, 1908, and renewed on April 17, 1928. A copy of this trademark was offered in evidence at the hearing in the Lower Court as Exhibit "10".

WHEREFORE, the said American Trading Company and the said Wm. A. Rogers, Ltd., respectfully move this Honorable Court to give consideration, in the determination of the above-entitled actions, to the above-mentioned fact, same having arisen after the action was determined in the Court of First Instance of the City of Manila.

Manila, P. I., September 6, 1929.

J. W. FERRIER
AND
GIBBS & McDONOUGH,
By: (SGD.) J. W. FERRIER,
12 Escolta, Manila, P. I.
Attorneys for American Trading Company and Wm. A. Rogers, Ltd.

RECEIVED copy this day.
September 7, 1929.

DEWITT, PERKINS & BRADY
By: GERONIMO ORTEGA
Attorneys for H. E. Heacock Co.

(U)

On September 16, 1929, the Supreme Court entered the following final judgment:

(CAPTION AND TITLE OMITTED)

JUDGMENT

The Court having regularly acquired jurisdiction for the trial of the above-entitled causes submitted by both parties for decision, after consideration thereof by the Court upon the record, its decision and order for judgment having been filed on the 6th day of September, A. D. nineteen hundred and twenty-nine;

By virtue thereof it is hereby adjudged and decreed that the writ of mandamus should issue to the lower court to sign and certify the tendered bills of exceptions as prayed for in the petition. Neither party to recover costs.

(SGD.) V. ALBERT
Clerk, Supreme Court, P. I.

(V)

On October 7, 1929, the following order was entered:

(CAPTION AND TITLE OMITTED)

The Honorable Judge of the Fourth Branch of the Court of First Instance of Manila.

GREETINGS:

WHEREAS, this Court on the 6th day of Sept-

ember, 1929, rendered a decision in the above-entitled cases, the dispositive part of which is as follows:

"In both cases, the writ of mandamus should issue to the lower court to sign and certify the tendered bills of exceptions as prayed for in the petition. Neither party to recover costs."

NOW, THEREFORE, you are hereby commanded to approve, sign and certify to this Court the Bill of Exceptions in Civil Cases Nos. 32952 and 32954, of the Court of First Instance of Manila, in accordance with law.

GIVEN BY the Hon. RAMON AVANCEÑA, Chief Justice of the Supreme Court of the Philippine Islands, this 7th day of October, nineteen hundred and twenty-nine.

(SGD.) V. ALBERT
Clerk, Supreme Court, P. I.

(W)

On October 7, 1929, the Court of First Instance of Manila entered the following order in case G. R. No. 31851:

(CAPTION AND TITLE OMITTED)

O R D E R

In pursuance of the decision and mandate of the Supreme Court, the bill of exceptions tendered by the defendant American Trading Co., in this case

is approved and ordered transmitted to the said Court.

Manila, P. I., October 7, 1929.

PEDRO TUASON
Judge.

(X)

On the same date, in case G. R. No. 31852, a similar order was issued by Judge Pedro Tuason of the Fourth Branch of the Court of First Instance of Manila.

PROCEEDINGS IN THE SUPREME COURT ON THE MERITS OF THE TWO CASES

(Y)

On October 26, 1929, the cases were duly registered under Nos. 31851 and 31852 of the General Register of the Supreme Court of the Philippine Islands.

(Z)

On February 14, 1930, counsel for the appellants Wm. A. Rogers, Ltd., and American Trading Company filed their brief, assigning the following errors:

ERROR NO. 1

The trial court erred in not holding that the appellee, whose name is "H. E. HEACOCK CO.," had no right to adopt and appropriate the name "ROGERS" as its trade-mark, and much less to debar the appellant Wm. A. ROGERS, LTD., from using that name in its own business.

ERROR NO. 2

The trial court erred in not finding that the appellee had never used the trade-mark "ROGERS" as registered by it in the Bureau of Commerce and Industry but had merely imported into and sold in the Philippine Islands the goods manufactured by, and bearing the trade-marks of the International Silver Company.

ERROR NO. 3

The trial court erred in ignoring the final decisions of the Courts of the United States which adjudged that the trade-marks in question of the herein appellant Wm. A. Rogers, Ltd., were not an infringement of the trademarks in question of the International Silver Company of which the appellee is a mere agent in the Philippine Islands.

ERROR NO. 4

The trial court erred in holding, in effect, that Wm. A. Rogers, Ltd., has no right to export its products to the Philippine Islands.

ERROR NO. 5.

The trial court erred in holding that the Act of Congress of February 20, 1905, is not in force in the Philippine Islands.

ERROR NO. 6.

The trial court erred in holding that appellant cannot maintain the present action against the ap-

pellee, and in dissolving the preliminary injunction against the latter.

ERROR NO. 7.

The trial court erred in ordering appellants to render an accounting of their profits and to pay to appellee a sum equal to such profits, in granting the writ of injunction prayed for by appellee, and in not dismissing appellee's cross-complaint.

(AA)

On April 11, 1930, counsel for the appellee H. E. Heacock Co., filed their brief with the Office of the Clerk of the Supreme Court.

(BB)

On July 30, 1930, the cases were submitted to the Supreme Court of the Philippine Islands for decision on the merits.

(CC)

On November 21, 1930, the said Supreme Court rendered its decision in the two cases, which is in words and figures following, to wit:

UNITED STATES OF AMERICA

PHILIPPINE ISLANDS

In the Supreme Court of the Philippine Islands

IN BANC.

H. E. HEACOCK CO., Plaintiff and Appellee, vs. AMERICAN TRADING COMPANY, Defendant and Appellant.	G. R. No. 31851. Submitted: July 30, 1930 Justices present: Avanceña, C. J., Street, Malcolm, Villamor, Ostrand, Johns, Romuáldez and Villa-Real, JJ. Johnson, J., took no part.

WM. A. ROGERS, LTD., a corporation, and AMERICAN TRADING COMPANY, a corporation, Plaintiffs and Appellants, vs. H. E. HEACOCK CO., a corporation, Defendant and Appellee.	G. R. No. 31852. Submitted: July 30, 1930 Promulgated: Nov. 21, 1930.

STATEMENT.

In Case G. R. No. 31851, in which H. E. Heacock Company is plaintiff and the American Trading Company defendant, plaintiff alleges that it is a domestic corporation, with its principal office and place of business in the City of Manila. That the defendant is also a domestic corporation, with its principal place of business in the City of Manila.

Plaintiff alleges that for more than twenty years it has been and is now engaged in the importation and sale in the Philippine Islands of flatware

bearing the name of "Rogers" stamped upon the back of the handle, with an indication of the material which it is made. That on June 27, 1918, it caused a trade-mark to be registered in its name in the Bureau of Commerce and Industry of the word "Rogers" for use upon spoons and other flatware whether nickel, silver-plated, or silver, as well as nickel, silver-plated or silver goods of all kinds, and ever since that date that trade-mark has been extensively used by the plaintiff, and that the goods to which it affixed that trade-mark has become generally and favorably known throughout the Philippine Islands. That notwithstanding that fact, the defendant on or about the year 1925 began to import and sell here flatware precisely the same designs as that imported and sold by the plaintiff with the words "Wm. A. Rogers", with an indication of the material of which such flatware is composed, stamped precisely in the same position on the back of the handle as that used by the plaintiff. That the defendant, through the use of said infringing mark or stamp has given the appearance of the flatware imported and sold by the plaintiff in such a way as to induce purchasers to believe that the flatware sold by the defendant is the same as that sold by the plaintiff, and that such imitation has been effected and was made to deceive the public and defrauding the plaintiff of its legitimate business, to its great damage.

Plaintiff prays that the defendant be ordered to render an accounting of the sales which it has made of flatware under the mark "Wm. A. Rogers," and of the profits derived from such sales, and that plaintiff have judgment for the double amount of such profits, and that the defendant, its agents, and employees be enjoined from selling nickel, silver-plated or silver goods of any kind under any mark where the name "Rogers" is used, in and by which the public may be induced to believe that the flatware imported and sold by the defendant is the flatware imported and sold by the plaintiff and known as "Rogers" flatware, and that it have costs.

For answer the defendant makes a general and specific denial of all of the material allegations of the complaint, but admits that the plaintiff caused the word "Rogers" to be registered with the Bureau of Commerce and Industry as a trade-mark to be used upon silverware and flatware, but alleges that such trade-mark had no legal validity as against the defendant, for the reason that the name "Rogers" is a family name or surname which does not belong to the plaintiff, which has no legal right to attempt and appropriate the name to its exclusive use, and specifically denies that the flatware and silverware imported and sold within the Philippine Islands by the defendant is of the same designs as that claimed to have been imported and sold by the plaintiff, and

defendant alleges that all of the silverware and flatware which it imported and sold within the Philippine Islands, bearing the words "Wm. A. Rogers," with the symbols and marks were manufactured by Wm. A. Rogers, Ltd. in the United States of America, and that the trade-marks appearing thereon have been duly registered in the Patent Office of the United States of America in accord with the provisions of the laws of that country, and is therefore, admissible into the Philippine Islands under the provisions of Act No. 2460 of the Philippine Commission, of the Acts of Congress of February 20, 1905, as amended by the Acts of Congress of May 4, 1906, March 2, 1907, and February 18, 1909, and as an affirmative defense, the defendant alleges that the registration by the plaintiff of the word "Rogers" is unwarranted and unauthorized, and can in no way prevent any other person whose family name is "Rogers" from using that name in the transaction of his legitimate business either within or without the Philippine Islands. That the defendant is acting here as the local agent and representative of Wm. A. Rogers, Ltd., a corporation organized under the laws of the State of New York, which is engaged in the manufacture of silverware and flatware of various kinds, that it registered in the Patent Office at Washington, D. C. with the following trade-marks:

"Wm. A. ROGERS-E.P.N.S.
Wm. A. ROGERS-E.P.B.M.

1881	R	ROGERS	R	E.P.N.S.
1881	R	ROGERS	R	E.P.B.M.
		W. R.		
1881	R	ROGERS	R	A-1

Wm. A. Regers (in old English script)"

which it has been using from 1897 to 1917 in its business. That the merchandise imported by the defendant, of which plaintiff complains, bears one or more of such trade-marks. That having been duly registered in the United States, the merchandise to which they are affixed is entitled to admission in the Philippine Islands under the provisions of Act No. 2460 of the Philippine Commission, as well as the Acts of Congress, and defendant prays that plaintiff's complaint be dismissed, with costs.

In Case G. R. No. 31852, in which Wm. A. Rogers, Ltd., and the American Trading Company are plaintiffs and the Heacock Company defendant, plaintiffs allege that Wm. A. Rogers, Ltd. is a corporation duly organized and existing under the laws of the State of New York. That the American Trading Company is the Philippine agent and representative of Wm. A. Rogers, Ltd. for the purpose of securing orders for the purchase and sale of silver-

ware, silver-plated hollow and flatware and cutlery manufactured by the said Wm. A. Rogers, Ltd. in the United States and sold there and within the Philippine Islands under various trade-marks which were duly registered in the United States at different times from 1897 to 1917, and such trade-marks have been used in trade by the said Wm. A. Rogers, Ltd. in the United States, in the Philippine Islands, and throughout the world. That the American Trading Company has been importing into the Philippine Islands its merchandise which bears the trade-marks above described since 1923, and has built up a considerable business, all of which is well known to the defendant. It is then alleged that the word "Rogers" is a family name, and that while it may be true that the defendant had the right to register it as a trade-mark, such a registration can not interfere with or prevent another person having the family name of "Rogers" or a corporation of which the family name "Rogers" is a part, from the use of that word as its or his trade-mark, and that the registration by the defendant of the word "Rogers" is illegal, unauthorized, and unwarranted, and has damaged the plaintiffs in the sum of ₱4,000.00, and they pray for an order restraining the defendant from interfering with the business of the plaintiffs under their trade-marks, and for a preliminary injunction and for such damages.

For answer the defendant makes a general and

specific denial, and as a special defense alleges in substance the same matters and things alleged in its complaint in Case G. R. No. 31851, and by way of cross-complaint against both plaintiffs renews the allegations made in its complaint against the American Trading Company.

As a reply plaintiffs admit that "on or about June 27, 1918, the defendant caused a trade-mark to be registered in its name in the Bureau of Commerce and Industry consisting of the sole word 'Rogers' but denies that said trade-mark has ever been used by the defendant upon flat ware either imported or offered for sale by it throughout the Philippine Islands and furthermore alleging that the registration of such word alone, said word being a family name and no one having such family name being in any way connected with the Heacock Co., defendant herein, that such registration of said word alone, a family name as it is, is null and void and unwarranted by any provision of law."

And denies that the defendant Heacock Company "has ever at any time affixed the said trade-mark 'Rogers' to any goods of any kind or character whatsoever," and "denies the allegations of said paragraph and in this respect alleges that the importation of flatware and silver plated ware manufactured by it and bearing its trade-marks were imported into the Philippine Islands long be-

fore 1925 and it furthermore denies that its designs are the same as those imported and sold by the defendant. It admits, however, that its trade-mark is stamped upon the back of the flatware manufactured and sold by it in the same manner and in the same position as trade marks are stamped upon manufacturers of every manufacturer of silver plated ware and flatware."

By stipulation both cases were tried as one. After the evidence was taken the court rendered judgment in Case G. R. No. 31851 against the defendant and in favor of the plaintiff, and for an accounting, and in Case G. R. No. 31852, it rendered judgment in favor of H. E. Heacock Company and against the plaintiffs, and dissolved the preliminary injunction which it had issued, and on appeal the American Trading Company, as plaintiffs in Case G. R. No. 31851, and Wm. A. Rogers, Ltd. and American Trading Company, as defendant in Case G. R. No. 31852, assign the following errors:

"1. The trial court erred in not holding that the appellee, whose name is 'H. E. HEACOCK CO.,' had no right to adopt and appropriate the name 'ROGERS' as its trade-mark, and much less to debar the appellant Wm. A. ROGERS, LTD. from using that name in its own business.

"2. The trial court erred in not finding that the appellee had never used the trade-mark 'ROGERS' as registered by it in the Bureau of Commerce and Industry but had merely imported into and sold in the Philippine Islands the goods manufactured by, and bearing the trade-marks of, the International Silver Company.

"3. The trial court erred in ignoring the final decisions of the Courts of the United States which adjudged that the trade-marks in question of the herein appellant Wm. A. Rogers, Ltd., were not an infringement of the trade-marks in question of the International Silver Company of which the appellee is a mere agent in the Philippine Islands.

"4. The trial court erred in holding, in effect, that Wm. A. Rogers, Ltd., has no right to export its products to the Philippine Islands.

"5. The trial court erred in holding that the Act of Congress of February 20, 1905, is not in force in the Philippine Islands.

"6. The trial court erred in holding that appellant cannot maintain the present action against the appellee, and in dissolving the preliminary injunction against the latter.

"7. The trial court erred in ordering appellants to render an accounting of their profits and to pay to appellee a sum equal to such profits, in granting the writ of injunction prayed for by apellee, and in not dismissing appellee's cross-complaint."

JOHNS, *J.*:

About seventy years ago, three brothers by the name of Rogers composed a firm in Connecticut under the name and style of Rogers Bros., which was the first to apply the art of electroplating to the manufacture of silver-plated ware in the United States, and it soon acquired a high reputation for the sterling quality of its wares. In 1865 a corporation was organized by Wm. Rogers, one of the bro-

thers, known as the Wm. Rogers Manufacturing Company, and after 1872 it engaged in the manufacturing and selling of silver-plated ware and continued to use the trade-marks on its goods adopted in 1866, to-wit, "1865 Wm. Rogers Mfg. Co." and "Wm. Rogers & Son." Two other corporations also acquired from one or more of the brothers the right to the use of the name Rogers, and the goods of which known by the public as "Rogers" acquired a very high character and well known reputation. In May 1898 "The International Silver Company" was organized, and it acquired the capital stock or properties of the 14 silver plating corporations, including the Wm. Rogers Manufacturing Company, the Meriden Britannia Company, and Rogers & Bro., and became the owner of all of those companies with their goodwill and each of their trade-marks, and ever since has continued and is now in their use and enjoyment, including the trade-marks "1847 Rogers Bros." and the "(Star) Rogers & Bro."

The Heacock Company was established in the City of Manila in the year 1909 as the successor of the firm of Heacock & Frier, which was established here in 1901, and has been in business ever since and importing into the Philippine Islands plate tableware, silverware, flatware and hollow-ware and plated goods bearing the trade-mark "Rogers," and it is admitted that on June 27, 1918, it regis-

tered here in the Bureau of Commerce and Industry the trade-mark "Rogers." That it has been in the use and enjoyment of that trade-mark ever since. The tableware and goods sold here by Heacock Company are manufactured by the International Silver Company, and such plated goods bearing the mark "Rogers" have become widely and generally known in the Philippine Islands due to the publicity and advertisements given to them by Heacock Company.

Upon that point Mr. Gaches testified:

"Q. If the International Silver Company withdrew the right to represent them from the H. E. Heacock Company, would your company insist upon making your 'Rogers' trade-mark prevail against the International Silver Company?

* * *

A. As the International Silver Company knew of and consented to registration of that trade-mark, we should probably consider it necessary to leave the trade-mark to them.

* * *

Q. As a business man engaged in commerce in Manila, and in the Philippines at large from 1901 to this day, could you tell the court what significance, if any, has the word 'Rogers' used upon goods such as knives, spoons, and forks, toilet articles, whether of silver or silver-plated, had upon the general commerce in the Philippine Islands and particularly in the City of Manila?

* * *

A. It has come to stand for to silver plate sold by the H. E. Heacock Company.

Q. And how has the word 'Rogers' come to stand for articles sold by the H. E. Heacock Company, in the commerce of the Philippine Islands; how has this secondary meaning come to be attached to the word 'Rogers' in the commerce of the Islands?

A. It is due to the extensive advertising campaign we have been carrying out since 1905, when we began to sell retail.

Q. From 1905, you say, the trade-mark 'Rogers' has been advertised by the H. E. Heacock Company; until when?

A. To this day; we are still advertising it.

Q. In what form have you been advertising?

A. By means of newspapers, weekly and monthly reviews, catalogues, bills, circulars, and in many other ways.

* * *

Q. Roughly about how much has been spent on advertising the Rogers trade-mark from 1909 till now?

A. It is very difficult to answer that question, unless I give a rough calculation.

Q. Yes, tell us your approximate calculation?

A Some ₱40,000.00 or ₱50,000.00.

* * *

Q. In selling those goods in the Philippines, manufactured by the International Silver Company, has the H. E. Heacock Company sold them under the industrial trade-mark of the International Silver Company or under the industrial trademark of the H. E. Heacock Company?

A. They are sold under the 'Rogers' trade-mark which is the name we have been advertising during the past twenty-three years in connection with knives, spoons, forks and other articles used at tables, whether nickel plated or silver plated, and that name is well known

throughout the Philippine Islands as representing goods sold by H. E. Heacock.

Q. How has the public come by such knowledge, that the name 'Rogers' upon those goods means precisely that they come for the H. E. Heacock Company?

A. On account of the extensive publicity and advertising of these objects.

Q When the H. E. Heacock Company sells those goods bearing the word 'Rogers' together with other trade-marks, what guaranty does it give to the public, if any, or what does the word 'Rogers' mean to the public in respect of the quality of the goods sold?

A. Naturally, the public has placed its confidence in that trade-mark or in that name as a trade mark on account of its guaranty represented by the Heacock firm which has been selling it all this time in this country.

Mr. Ferrier:

Q. That is an opinion of yours?

A. It is not an opinion; it is a fact.

Q. How have you acquired a knowledge of what the public thinks?

A. Because whenever the public orders any goods it specifies 'Rogers' goods."

It appears from the record that such wares were cleverly advertised in the issues of the Manila Times in October, 1905.

It having been admitted that Heacock Company registered the word 'Rogers' as a trade-mark in June, 1918, and it appearing that such trade-mark was registered with the knowledge, consent, and approval of the International Silver Company, in fact that it was made for its use and benefit, the ques-

tion is squarely presented as to what is its legal force and effect, and what legal right Heacock Company has to the use and enjoyment of the word and trade-mark "Rogers."

It is conceded that Heacock Company is not the manufacturer of the wares which it sells under that trade-mark. That such wares are manufactured by the International Silver Company from which they are purchased by Heacock Company and but it sold to the people in the Philippine Islands. The record is conclusive that covering a period of twenty-five years, through extensive advertising and the quality of the wares, the Heacock Company has built up and established a large and extensive business. That its only competitor in that line of goods is the defendant, American Trading Company, which appeared on the scene for the first time in 1925 with wares which are very similar to those imported and sold by the Heacock Company. It is admitted that the wares of the American Trading Company are manufactured in the United States by Wm. A. Rogers, Ltd. which has its trade-marks duly registered in that country, as it alleges. At the time of the trial of these cases in the lower court, its trade-marks were not registered in this country, but since then they have been and are now registered here. That is to say, fundamentally, the trade-marks of the International Silver Company, through which the Heacock Company purchases its wares, and

the trade-marks of Wm. A. Rogers, Ltd., from which the American Trading Company takes its orders, are both duly registered in the Patent Office of the United States, and that the name "Rogers" was registered here by Heacock Company in June, 1918, and the trade-marks of Wm. A. Rogers, Ltd. were first registered here after the trial of these cases in the lower court.

The storm center of this case is the legal force and effect of the registration by Heacock Company of the word "Rogers" in June, 1918, and what that company did before and since its registration in placing the wares on the market. The defendant contends that the word "Rogers" is a family name, and conceding, without admitting, that Heacock Company might have the legal right to register the word "Rogers" as a trade-mark, it vigorously contends that it does not have the exclusive right to the use of that word.

Act No. 666 is entitled:

> "An Act defining property in trade-marks and in trade-names and providing for the protection of the same, defining unfair competition and providing remedies against the same, providing registration for trade-marks and trade-names, and defining the effect to be given to registration under the Spanish royal decree of eighteen hundred and eighty-eight relating to the registration of trade-marks, and the effect to be given to registration under this Act."

* * *

"SECTION 1. A trade-mark is a name, em-

blem, sign, or device employed by any person, firm or corporation to designate the goods dealt in or manufactured by such person, firm, or corporation, for the purpose of enabling the public to recognize such goods and manufactures, and to distinguish them from the goods and manufactures of others.

"SEC. 2. Anyone who produces or deals in merchandise of any kind by actual use thereof in trade may appropriate to his exclusive use a trade-mark, not so appropriated by another, to designate the origin or ownership thereof: *Provided*, That a designation or part of a designation which relates only to the name, quality, or description of the merchandise or geographical place of its production or origin can not be the subject of a trade-mark.

"SEC. 3. The ownership or possession of a trade-mark, heretofore or hereafter appropriated, as in the foregoing section provided, shall be recognized and protected in the same manner and to the same extent, as are other property rights known to the law. To this end any person entitled to the exclusive use of a trade-mark to designate the origin or ownership of goods he has made or deals in may recover damages in a civil action from any person who has sold goods of a similar kind, bearing such trade-mark. * * *"

Section 7 of that Act as amended by Act No. 3423, provides:

"SEC. 7. Any person who is selling his goods shall give them the general appearance of goods of another manufacturer or dealer, either in the wrapping of the packages in which they are contained, or the devices or words thereon, or in the manner of their manufacture, or in any other feature of their appearance, which would be likely to influence

purchasers to believe that the goods offered are those of a manufacturer or dealer who holds a duly registered patent therefor or who has long been accustomed to manufacture or sell such goods and who is other than the actual manufacturer or dealer, and who clothes the goods with such appearance for the purpose of deceiving the public and defrauding another of his legitimate trade, or any subsequent vendor of such goods or any agent of any vendor engaged in selling such goods with a like purpose, shall be guilty of unfair competition, and shall be liable to an action for damages, in which the measure shall be the same as that provided for a violation of trade-mark rights, together with discretionary power in the court to impose double damages if the circumstances call for the same. * * *"

The material provisions of Section 14 of Act No. 666, as amended by Section 1 of Act No. 2460, are as follows:

"No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or shall copy or simulate a trade-mark or trade-name registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the Philippine Islands, shall be admitted to entry at any customhouse of the Philippine Islands; * * * *Provided, however,* That this section shall not be construed to affect rights that any person may have acquired by virtue of having registered a trade-mark under the laws of the United States."

It is admitted that under these provisions Heacock Company registered the word "Rogers" in June,

1918, and it will be noted that under Section 1 a trade-mark is a name employed by a corporation to designate the goods in which it deals, so that the public can recognize its goods. This definition closely follows that laid down in Words & Phrases, Vol. 8. p. 7042, where it is said:

> "A trade-mark 'is the name, symbol, figure, letter, form, or device adopted and used by the manufacturer or merchant in order to designate the goods that he manufactures or sells, and to distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry, or enterprise'" (Citing numerous decisions of both States and Federal Courts.)

By the provisions of Section 3 of Act No. 666, the ownership of such a trade-mark is "recognized and protected in the same manner and to the same extent, as are other property rights known to the Law." The purpose and intent of the law is to give force to this section, and it must be conceded that without such protection a registered trade-mark would not be of any value.

It is admitted that for a number of years the trade-marks of Wm. A. Rogers, Ltd. have been and are now registered in the Patent Office of the United States, and that the word "Rogers" is a part and parcel of those trade-marks, and for the purposes of this opinion, it is admitted that the trade-marks of Wm. A. Rogers, Ltd., as registered in the United

States, are now registered in the Philippine Islands. That is to say, Heacock Company registered the word "Rogers" in June, 1918, and Wm. A. Rogers, Ltd. for the first time in 1930 registered in this country trade-marks which it had previously registered in the United States, all of which in one form or another contain the word "Rogers." As stated, when Heacock Company first imported such wares into the Philippine Islands it was then a virgin country, and it must be admitted that any business standing or reputation which such wares had up to 1925 were those given to it by the advertising and business methods and dealings of that company.

The evidence is conclusive that the wares for which the American Trading Company has been taking and filling orders is very similar in appearance, design, and material to the wares which have been advertised and sold in this country by Heacock Company since 1905. It is true that a dealer in such wares could and would see the distinction between them, but even so, in the ordinary course of business, the average public to whom they are sold could not and would not distinguish one from the other.

As stated the old original firm of Rogers Bros. was composed of three brothers of that name from whom, in one form or another, Wm. A. Rogers, Ltd. and the International Silver Company have acquired the right to use their respective trade-marks in the United States, in all of which the word "Rogers" is used as a part of such trade-marks.

The appellants cite and rely upon that portion of Act No. 666, as amended by Section 1 of Act No. 2460, which reads as follows:

> "* * * *Provided, however,* That this section shall not be construed to affect rights that any person may have acquired by virtue of having registered a trade-mark under the laws of the United States."

It will be noted that these provisions are specifically confined and limited to "this section," which is Section 14, and they do not apply to any other sections of the original or amended act, and that section 14 treats exclusively of the importation of merchandise into the Philippine Islands and its entry at any customhouse, and this exception is confined and limited to "rights that any person may have acquired" by registered trade-mark under the laws of the United States, and that nowhere in Section 14 is the word "sale" or "sell" used. The appellants cite and rely upon Section 12 of Act No. 666, as amended by Act No. 744, as follows:

> "The application prescribed in the foregoing section must be accompanied by a written declaration verified by the person, or by a member of the firm, or by an officer of the corporation applying, or by the duly authorized attorney or agent of such person, firm, or corporation, to the effect that such party has at the time a right to the use of the trade-mark or trade-name sought to be registered and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be

calculated to deceive; and that the description and facsimiles presented for registry truly represent the trade-mark sought to be registered."

It must be conceded that in June, 1918, when Heacock Company applied for, and obtained the registration of, the word "Rogers", it then had the right to the use of that trade-mark or trade-name, for the simple reason that it was the only person then dealing in "Rogers" wares of any kind, and that Wm. A. Rogers, Ltd. or the American Trading Company did not appear on the scene until seven years later.

Those provisions of Section 12 should be confined and limited to any other person, firm or corporation which at the time of the application had the right to the use of such trade-mark in form or substance.

How could Heacock Company in 1918 know that seven years later the American Trading Company or Wm. A. Rogers, Ltd. would appear on the scene, claiming the right to the use of the word "Rogers" as a family name? How could it then know that Wm. A. Rogers, Ltd. had registered its trade-marks in the United States Patent Office? The construction of this section should be confined and limited to actual matters and things as they existed in 1918 when Heacock Company applied for, and obtained the registration of, the word "Rogers."

In one form or another the word "Rogers" was

used in the trade-mark of the International Silver Company which it registered in the Patent Office of the United States, and the record shows that the International Silver Company knew of, and consented to, the registration of the word "Rogers" by the Heacock Company in 1918. Hence, Heacock Company never committed any fraud against that company when it registered the word "Rogers" in the Philippine Islands. Neither did it commit any fraud against Wm. A. Rogers, Ltd., for the simple reason that when in 1918 Heacock Company registered the word "Rogers" Wm. A. Rogers, Ltd. was then not doing business in the Philippine Islands.

It is contended that besides the word "Rogers", the goods of both parties contain initials, figures, and symbols which distinguish them from each other, but the evidence shows that in dealing with the public, the important and decisive word is the word "Rogers."

In the final analysis, in June, 1918, Heacock Company duly registered here the word "Rogers" as its trade-mark. At that time this was a virgin field for the wares evidenced by that trade-mark. Since then, through its advertising, business methods, and dealings, it has built up a growing and increasing market for the sale and purchase of such wares.

Act No. 666 is entitled "An Act defining property in trade-marks and in trade-names and pro-

viding for the protection of the same, defining unfair competition and providing remedies against the same, providing registration for trade-marks and trade-names * * *." The purpose and intent of the law is very apparent. Pursuant to its provisions Heacock Company registered the word "Rogers" as its trade-mark, for ought that appears, without any knowledge at the time of the existence of the registered trade-marks of Wm. A. Rogers, Ltd. in the Patent Office of the United States in which the word "Rogers" is used. If in June, 1918, when the Heacock Company applied for the registration of the word "Rogers," the Wm. A. Rogers, Ltd. had then been in the field with its wares, another and a very different question would be presented. If appellants' contention is sustained, any old established firm here which in good faith had applied for, and obtained, the registration of a given word as its trade-mark, and through its skill, energy, and business dealings had built up a good business, largely founded on that trade-mark, could after many years of such business wake up some fine morning and find that its trade-mark was of but little, if any, commercial value, because some other firm in the United States had registered its trademarks in the Patent Office of that country, in which it made use of the word which the local merchant had registered as its trade-mark in this country. What would be the value of an old registered trademarks in the Philippine Islands upon which a mer-

chant had established his business here, if in later years another person in the same line of business, and on the strength of a similar registered trade-mark in the United States, could enter the field here and become a competitor in the sale of similar wares under similar trade-marks?

Upon the facts we attach but little, if any, importance to the use of the word "Rogers" as a family name. In any event when Heacock Company applied for the registration of the word "Rogers" it had the same legal right to the use of that word as Wm. A. Rogers, Ltd., and for seven years it has had the uninterrupted use of that word under that trade-mark, and in the ordinary course of business, stripped of all non-essentials, it must be conceded that in this line of wares, it is the word "Rogers" which gives the business its intrinsic value, all of which was done by Heacock Company before the appellants ever entered the field. Neither upon the admitted facts will the provision in Section 14, upon which the appellants rely, bear the construction for which they contend.

By Act No. 666 and its amendments, the Legislature of the Philippine Islands made specific provisions for the defining of property in trade-marks and trade-names, and their protection and unfair competition, and provided for remedies against it, and for the registration of trade-marks and trade-names, and it is admitted that in June, 1918, Heacock Company registered the word "Rogers" as its trade-mark upon which it has built up an old established business.

The attorneys for the respective parties have submitted able and exhaustive briefs on numerous other legal questions, but in the final analysis the important and decisive question is the legal force and effect of the registration of the word "Rogers" by the Heacock Company in June, 1918, and we are clearly of the opinion that the registration at that time of that word is valid, and that as such it should be protected under the provisions of Act No. 666 and its amendments.

All things considered, the judgment of the lower court in both cases is affirmed, with costs against the appellants.

Ten days after the promulgation of this decision final judgment will be entered and five days thereafter the record will be remanded to the co below.

It is so ordered.

(SGD.) CHARLES A. JOHNS.

WE CONCUR:—

(SGD.) RAMON AVANCEÑA.

.....

(SGD.) THOS. A. STREET.

(SGD.) GEO. A. MALCOLM.

.....

(SGD.) NORBERTO ROMUALDEZ.

(SGD.) ANTONIO VILLA-REAL.

JOHNSON, J., did not take part.

I reserve my vote.

(Sgd.) J. A. OSTRAND.

(DD)

On December 19, 1930, counsel for the appellants filed the following application for rehearing and motion for new trial:

(HEADING AND TITLES OMITTED)

APPLICATION FOR REHEARING AND MOTION FOR NEW TRIAL

Come now the appellants in the above entitled cases and respectfully petition the court to grant a rehearing for the reasons hereinafter set forth and in case of denial thereof to direct a new trial on the grounds set out in the affidavit annexed hereto as Appendix "C".

FOREWORD

This decision is subject to review by the Supreme Court of the United States because it involves the interpretation, application and effect of the United States Trademark Laws in the Philippine Islands. It involves the protection, if any, to be granted in the Philippines to the owners of trademarks registered under the laws of the United States both before and after registration of the same trademarks under the laws of the Philippine Islands. It involves the interpretation of the trademark laws of the Philippine Islands as applied to the trademarks of a corporate entity of the Dominion of Canada (a foreign country which by treaty, convention and law affords full protection by registration of trademarks to the

citizens of the United States and the Philippines) and which trademarks of such foreign entity were first registered in the United States Patent Office at Washington and later with the Bureau of Commerce and Industry of the Philippines. It involves a question of comity and reciprocal observance of trademark laws between the government of the United States and the Philippines on one hand, and the Dominion of Canada on the other, as to whether or not a right of property guaranteed to the appellant Wm. A. Rogers, Ltd., a corporate entity of the Dominion of Canada, by the United States government in the registration of the latter's trademarks in the United States Patent Office at Washington and confirmed by the Court of Appeals of the District of Columbia and the Federal Courts of the United States in the course of forty years litigation with the principal of appellee, the International Silver Company and its predecessors, is entitled to any respect or protection in the Philippines. It involves the right of this Honorable Court to disregard the final decisions of the Federal Courts of the United States and of the Court of Appeals of the District of Columbia in litigation between Wm. A. Rogers, Ltd., and its predecessor and the International Silver Co. and its predecessors in which every issue in these cases has been decided in favor of Wm. A. Rogers, Ltd., and its predecessor and founder Wm. A. Rogers, notwithstanding the finding of the court that the appellee H. E. Heacock Co. represented the International Silver Co. in the registration of

the word "Rogers" as a trademark in the Philippines. It involves the trademark rights in the Philippines of probably a dozen other independent Rogers flatware and tableware concerns, one of whom the Simeon L. and George H. Rogers Co. of Oneida, New York, has already registered its trademarks in the Bureau of Commerce and Industry of the Philippines and all of whose trademarks likewise registered in the United States Patent Office at Washington consist of the word "Rogers" accompanied by other words and symbols to distinguish them from the trademarks of the other Rogers competitors, and whose rights to do business in the Philippines have been in effect foreclosed without a hearing by the decision in this case. It involves a property right of Wm. A. Rogers, Ltd. worth millions of dollars and the value of which may be established by affidavit in accordance with Section 9 of the Act of Congress of February 13, 1925, entitled "An Act to Amend the Judicial Code, etc." It involves the right to protection or exposure to piracy in the Philippines of every United States trademark, tradename and patent which has been legally registered in the Patent Office at Washington. It almost involves the sovereignity of the United States in the Philippines.

With all due respect to this Honorable Court, we find its decision so repugnant to our conception of the rights of the parties in accordance with the un-

disputed facts that we are constrained to believe that the writer of the decision and the other members of the court who signed it, due to an over crowded calendar, must have overlooked some of the controlling facts and applicable laws and must have failed to realize the full significance of the affirmance of the judgment of the trial court.

Some of the findings and reasoning in favor of the appellee are in conflict with other findings which are accepted in the decision as undisputed facts and which in our opinion are wholly incompatible with the result reached by the court.

This Honorable Court in its decision of September 6, 1929, granting the mandamus for the approval of the bill of exceptions in the above entitled cases, with the decision of the trial court and all the controlling facts before it, among other things, declared:

> "On the other hand, if the word 'Rogers' is a family name, and that all silverware and flatware imported by the defendant American Trading Company was manufactured by Wm. A. Rogers, Ltd. in the United States, and that the trademark appearing thereon had been duly registered in the Patent Office of that country in accordance with the Acts of Congress as alleged, and the American Trading Company is the local agent of the manufacturer Wm. A. Rogers, Ltd., then it would follow that they would have grounds for complaint against the use of their trademark by H. E. Heacock Company, and to have such use prohibited." (p. 5, mandamus decision.)

Every fact which this Honorable Court hyphotetically found in the foregoing excerpt of the mandamus decision would entitle the appellants to a favorable decision on the merit is proven by the record to be true. Nevertheless, upon those identical facts the court found in favor of the appellee. It is true that the court was not bound by its definition in the mandamus decision of the respective rights of the parties under the issues joined, but, certainly, taking into consideration that the part of the decision quoted was a practical assurance of ultimate success on the part of appellants in the light of their knowledge of the undisputed facts and encouraged them to continue selling the wares of Wm. A. Rogers, Ltd., and incurring the liability adjudged by the decision of the trial court, it would seem that appellants are entitled to some explanation of the reasons for the complete about face of the court reversing the doctrine laid down by it in the mandamus decision, notwithstanding the fact that that doctrine is unanimously supported by the jurisprudence on the subject of trademarks.

ERRORS AND ARGUMENT IN SUPPORT THEREOF

I.

The court erred in failing to find that the trademark laws of the United States contained in the Act of Congress of February 20, 1905, as amended by virtue of their own recitals and by virtue of the provisions of Section 14 of Act 666 of

the Philippine Legislature are applicable to the Philippines and, therefore, decisive of the right to import into the Islands and sell the same kind of ware of Wm. A. Rogers, Ltd. which are sold in the United States under the same trademarks.

II.

The court erred in failing to hold that property rights created by the registration of trademarks in the United States under the provisions of the Act of Congress of February 20, 1905, as amended in conjunction with Section 14 of Act 666 of the Philippine Legislature are entitled to the protection of the tribunals of justice in the Philippine Islands, whether that Act of Congress be technically and directly applicable to the Islands or not.

While this Honorable Court quotes in its decision our assignments of error against the judgment of the trial court in which we invoked the applicability to the Philippine Islands of the trademark laws of the United States as recited in the Act of Congress of February 20, 1905 and as recognized and confirmed by the proviso of the first paragraph of Section 14 of Act 666 of the Philippine Legislature, yet the court makes no attempt to meet our argument to the effect that the application of that Act of Congress to the Philippines gives trademarks registered in the United States the same force and effect in the Philippines as in the United States without their

registration in the Philippines except insofar as the right to maintain certain actions as provided in Section 4 of Act 666 of the Philippine Legislature may be concerned. Whatever else may be said of our argument on that subject, certainly the importance and far-reaching effect of the questions involved made it worthy of serious consideration. Nevertheless, it was practically ignored in the decision of the court.

The court quotes the proviso of said Section 14 of Act 666 as follows:

> "Provided, however, that this section shall not be construed to affect rights that any person may have acquired by virtue of having registered a trademark under the laws of the United States."

The court then, upon the premise that the proviso is limited to Section 14 and that the main body of that section is limited to importation of merchandise, reaches what seems to us a wholly illogical conclusion to the effect that therefore the Legislature of the Philippines intended to recognize thereby the right of importation into the Islands of merchandise under trademarks registered in the United States, but also intended to deny the right to sell or dispose of the same after such importation. We refuse to believe that this Honorable Court fully realized the import of that conclusion. The phrase "rights that any person may have acquired by virtue of having registered a trademark under the laws of the United States" is couched in the most general form of ex-

pression conceivable, and certainly it cannot be successfully denied that the only right worth considering which is acquired by virtue of the registration of a trademark is the right to sell the wares to which it may be affixed. The right to import merchandise into the Philippines is necessarily and obviously a mere incident to the right to sell the same. The interpretation by this Honorable Court of the proviso above quoted of Section 14 of Act 666 presupposes that the Legislature intended to beguile its own citizens and the citizens of the United States into incurring the expense of importing merchandise into the Philippine Islands only to find that they could not dispose of it after such importation.

Section 29 of the Trademark Act of Congress of February 20, 1905, expressly provides:

> "That in construing this act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof. The United States includes and embraces all territory which is under the jurisdiction and control of the United States * * *."

The trademark laws of the United States (Act of Congress of February 20, 1905 as amended) considered in the light of the proviso above quoted of Section 14 of Act 666 of the Philippine Legislature are so clearly made applicable to the Philippines, that we did not deem it necessary to point out to this Honorable Court in our brief what every merchant in the Islands knows and that is that the

trademark laws of the United States or if you please, the property rights created by the registration of trade marks under such laws have been applied, recognized and protected in the Philippines for the last twenty-five years every day in the month and every month in the year and that too in conformity with customs administrative orders of which the court will take judicial cognizance. For the convenience of the court, we attach hereto as Appendix "A" a certified copy of customs administrative order No. 194 dated January 13, 1926, paragraphs 5 and 6 of which read as follows:

> "PAR. V. Any domestic manufacturer or trader and *any foreign manufacturer or trader who is entitled under the provisions of a Treaty, Convention, Declaration, or Agreement, between the United States and any foreign country, to the advantages afforded by law to citizens of the United States in respect to trade-marks, and commercial names, may in order to protect a trademark or tradename used in foreign commerce, i. e., between the Philippine Islands and foreign countries, or with the several States of the United States, register such trademark or tradename and receive the protection contemplated in section 27 of the Act of Congress of February 20 1905, by furnishing the following information to the Insular Collector of Customs, port of Manila;*
>
> Name of owner;
>
> Residence of owner;
>
> Locality in which goods are manufactured;
>
> Certified copy of the certificate of registration of trademark or tradename in the United States Patent Office, Washington, D. C.;

Nine facsimiles of the trade-name, the name of the locality in which the goods are manufactured, or of the registered trade-mark.

PAR. VI. *All applications for the recording of domestic or foreign trademarks or tradenames shall be made to the Insular Collector of Customs, who, upon compliance with the conditions outlined in Paragraphs IV and V hereof, shall cause the trademark or tradename in question to be recorded in a book to be kept for that purpose in the office of the Appraiser of the Port. Collectors of Customs at subports of entry will be furnished with copies of the facsimiles and statements of recorded trademarks and tradenames, and shall file the same in their respective offices.*" (Italics ours.)

Section 27 of the Act of Congress of February 20, 1905, referred to in the above quoted customs order corresponds to Section 14 of Act 666 of the Philippine Legislature and which last mentioned Act was formulated from the then existing trademark laws of the United States.

The registration mentioned in the foregoing customs administrative order is limited to registration in the customhouse and makes no mention of registration in the Bureau of Commerce and Industry.

Appellee argues that the Act of Congress of February 20, 1905, notwithstanding the language of Section 29 thereof, is not applicable to the Philippines because of other Acts of Congress containing similar wording having been held inapplicable and

because the act itself provides no courts or other machinery for its enforcement. The trial court upheld this erroneous argument of the appellee but this Honorable Court made no attempt to settle the important question other than to affirm the decision of the trial court without discussing its reasons.

We submit that the trial court also erred in so holding. It is true that Section 1 of the Philippine Bill (Act of Congress of July 1, 1902) provides that "the provisions of Section 1891 of the Revised Statutes of 1898 shall not apply to the Philippine Islands."

Section 1891 reads as follows:

> "The Constitution and all laws of the United States which are not locally inapplicable shall have the same force and effect within all the organized territories, and in every territory hereafter organized as elsewhere within the United States."

But the Act of Congress of February 20, 1905, which was promulgated subsequent to the Philippine Bill, in its Section 29, says:

> "SEC. 29. That in construing this Act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof: *The United States includes and embraces all territory which is under the jurisdiction and control of the United States.*" * * * (Italics ours.)

It is also true that Section 5 of the Jones Law (Act of Congress of August 29, 1916) provides:

"SEC. 5. That the statutory laws of the United States *hereafter* enacted shall not apply to the Philippine Islands, except when they specifically so provide, or it is so provided in this act." (Italics ours.)

But it will be noted that said section refers to statutory laws of the United States enacted *after* the Jones Law and that the Act of Congress of February 20, 1905, was enacted *before* the Jones Law.

Tending to support our contention is the fact that all the indices to the Public Laws of the Philippine Islands from Volume 7 on, under the heading "Trade-Marks, and Trade-Names", cite our Act No. 666 and the Act of Congress of February 20, 1905, and its amendments.

The opinion of the Attorney-General of the United States, quoted at length by the trial court in its decision, is not applicable to the present case. That opinion holds that the Narcotic Drugs Import and Export Act of Congress of May 26, 1922, is not applicable to the Philippine Islands, notwithstanding that in fixing its geographical application it refers to "the United States or territory under its control and jurisdiction". That Act having been passed subsequent to the approval of the Jones Law, Section 5 of which expressly provides that "the statutory laws of the United States hereafter enacted shall not apply to the Philippine Islands, except when they specifically so provide", it was perfectly

obvious that the same was not applicable to the Philippine Islands.

The argument about the lack of courts and other machinery to enforce the Act of Congress of February 20, 1905, is entirely without merit. Aside from the contents of the proviso of Section 14 of Act 666, this Honorable Court will surely agree that the registration of trademarks under the laws of the United States confers property rights upon their owners in all parts of the civilized world and that there is no right without a remedy. The Congress of the United States itself had this principle in mind when it inserted Section 23 in the same Act of Congress of February 20, 1905 as follows:

> "SEC. 23. That nothing in this Act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if the provisions of this act had not been passed."

Even without the recognition of the rights conferred upon Wm. A. Rogers, Ltd. by the registration of its trademarks in the United States which is found in the proviso heretofore quoted of Section 14 of Act 666, it could have legally defended its right to use the trademarks on merchandise sold in the Philippine Islands as it has done in this case, although under Section 4 of said Act 666 it could not have maintained a civil action for damages or a criminal action for infringement of its trademarks without first registering the same under Section 11 of the same act.

We quote from the syllabus of the decision of this Honorable Court (written by the ponente in this case) in the case of "Western Equipment and Supply Co., et al, *vs.* Reyes", 51 Phil. 115 (116) as follows:

> "4. IT IS A RIGHT 'IN REM'.—Under such a state of facts, the right to the use of the corporate and trade name of a foreign corporation is a property right, a right in rem, which it may assert and protect in any of the courts of the world even in countries where it does not personally transact any business.
>
> "5. IN SUCH A CASE, IT IS THE TRADE WHICH IS PROTECTED.—In such a case, it is the trade and not the mark that is to be protected, and a trademark does not acknowledge any territorial boundaries, but extends to every market where the trader's goods have become known and identified by the use of the mark." (Italics ours.)

Right to protection in Philippines of Trade-marks registered under the laws of the United States is not dependent upon technical extension of Act of Congress of February 20, 1905, to the Philippines.

It seems too obvious to require argument that the right flowing from the registration of a trade-mark under the laws of the United States extends to the Islands whether the laws themselves do or not, and this Honorable Court possibly overlooked that fact in considering the applicability of the provisions of the United States trade-mark laws to the Islands.

We earnestly submit to this Honorable Court that the right of protection in the Philippines of a trade-mark registered under the provisions of the Act of Congress of February 20, 1905, either with or without the express recognition of that right in Section 14 of Act 666, is just as potent to establish the error of the court as would be an admission of the technical application or extension of that Act of Congress itself to the Philippines. If the property right acquired by the owner of a trademark in registering it under the laws of the United States is entitled to protection in the Philippines, then the discussion of the question of whether or not the Act of Congress itself technically extends or applies to the Philippines is superfluous and academic.

The trademarks of the appellant Wm. A. Rogers, Ltd. here in question would, by virtue of certificates of registration of the Patent Office at Washington, be protected in England, France or any other friendly foreign nations against the pirates of a third person acting as the representative of the United States competitor of the appellant.

Is it the intention of this Honorable Court to lay down the doctrine that trademarks registered under the laws of the United States are entitled to protection in the Philippines, a territory of the United States, than in foreign countries?

Notwithstanding the fact that the decision of this Honorable Court is incompatible with the rights of

Wm. A. Rogers, Ltd. to have its trademarks which have been registered for many decades in the United States protected in the Philippine Islands no response is found in the decision to appellant's discussion upon this subject. Surely, the court should be willing to express its attitude on this important question in black and white. If, as found by the trial court in effect and affirmed by this Honorable Court, the owners of trademarks duly registered under the laws of the United States in the Patent Office at Washington are entitled to no protection in the Philippine Islands by reason of such registration, the quicker citizens of the Dominion of Canada and of other friendly foreign nations find it out the better for them. Moreover, if the citizens of Canada are entitled to no protection in the Philippines by reason of the registration of their trademarks in the United States, then the citizens of the United States for the same reason are in the same unenviable predicament and all the valuable patents, trademarks and tradenames, the registration of which have been granted by the United States government and which have thereby been guaranteed the protection of that sovereign power, are exposed to piracy by anyone in the Philippines who may wish to appropriate them.

It is appellants' contention that the registration of a trade-mark in the United States and the exclusive right to deal in wares bearing that trade-mark in the United States carry with them the exclusive right to deal in the same

wares bearing the same trademarks in the Philippine Islands without registering those trademarks locally.

The only object of the registration of such trademarks in the Bureau of Commerce and Industry of the Philippine Islands is to enable the owner of the trademarks to sue for damages or to institute criminal proceedings for the violation of his right to the exclusive use of the trademark in accordance with Section 4 of Act 666 of the Philippine Legislature.

Section 14 of Act 666 as amended by Act No. 2469 (omitting regulations for its enforcement) provides:

> "SEC. 14. No article of imported merchandise which shall copy or simulate the name of any domestic manufacure, or manufacturer or trader, or shall copy or simulate a trademark or tradename registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the Philippine Islands, shall be admitted to entry at any custom house of the Philippine Islands; * * * *Provided, however, That this section shall not be construed to affect rights that any person may have acquired by virtue of having registered a trademark under the laws of the United States.*" (Italics ours.)

It will be noted from the italicized provision of the above section that the rights of owners of trademarks registered "under the laws of the United States" to deal in wares bearing such trademarks in the Philippines, even though they may clash with

local trademarks registered in the Philippines, are in no manner affected.

The right of Wm. A. Rogers, Ltd. to register with the Bureau of Commerce and Industry of the Philippine Islands such trademarks as it has already registered under the laws of the United States and under which it has been selling its wares in the Philippines is a mere *proforma* proceeding under the provision of Section 11 of Act 666 as amended by Act No. 1407, Sec. 3 (b) and modified by Act No. 2728, as follows:

> "SEC. 11. *The owners of trademarks or tradenames domiciled in the Philippine Islands, or the United States, or in any foreign country which by treaty, convention, or law affords similar privileges to the citizens of the United States and of the Philippine Islands, may obtain registration of such trademarks or tradenames by complying with the following requirements*: (Here follows procedure.)" (Italics ours.)

While the advantages of registering the United States trademarks of Wm. A. Rogers, Ltd. in order to avail itself of the rights of action provided in Section 4 of Act 666 are apparent there can be no reasonable dispute about the fact that notwithstanding the failure to register locally before the commencement of this action the American Trading Company as a dealer in the wares of Wm. A. Rogers, Ltd. had a perfect right to sue the H. E. Heacock Co. for an injunction to prevent interference with its business on the part of the H. E. Heacock Co. by writing letters to the customers of the Ame-

rican Trading Company threatening them with litigation for dealing in the wares of Wm. A. Rogers, Ltd.

III.

The court, after finding *"for the purposes of this opinion it is admitted that the trademarks of Wm. A. Rogers, Ltd. as registered in the United States are now registered in the Philippine Islands"* (p. 13, decision,) erred in affirming the decision of the trial court perpetually enjoining the importation into the Philippines and sales of the wares of the appellant Wm. A. Rogers, Ltd. under such trademarks thus registered both in the United States and in the Philippines.

It was established by undisputed proofs attached to the petition for mandamus to compel the approval of the bill of exceptions in these cases that subsequent to the trial of the case the trademarks in question of Wm. A. Rogers, Ltd. had been duly registered in the Bureau of Commerce and Industry and this Honorable Court, presumably for the laudable purpose of avoiding further litigation based upon such subsequent registration made specific findings with reference thereto as a basis for its decision. (See pp. 10 and 13, decision.)

It seems to the undersigned that if any distinction can be drawn between the many astounding doctrines laid down in the decision that this one should be given a place at the head of the class. The only reason advanced by the court for affirming the per-

petual injunction of the trial court against the importation and sale of the wares of Wm. A. Rogers, Ltd. notwithstanding the proviso of Section 14 of Act 666 heretofore quoted, is that that proviso while authorizing the importation of the wares does not authorize their sale after importation. The court makes no attempt to justify the perpetual injunction against the importation and sale of such wares after the registration of the United States trademark under the provisions of Section 11 of Act 666 of the Philippine Legislature. If this Honorable Court knows of any reason under the sun for perpetually enjoining the sale in the Philippines of the wares of Wm. A. Rogers, Ltd. after the registration of its United States trade-marks in the Philippines our clients are entitled to hear them.

IV.

The court erred in holding that the appellee registered the word "Rogers" with the Bureau of Commerce and Industry in the year 1918 for the use and benefit of the International Silver Company; in holding that the H. E. Howard Co. could legally appropriate and register in its own name as a trademark the family name "Rogers" belonging to the International Silver Co. for its own use and benefit at the time of the dissolution of the International Silver Co.; in refusing and failing to find that the H. E. Howard Co. in registering the family name "Rogers" in the name of the International Silver Co. [illegible]

for the use and benefit of the International Silver Company it was charged with the latter's knowledge of the registration of the trademarks of Wm. A. Rogers, Ltd. in the United States and the sale of its wares under such trademarks in the United States and the court therefore further erred in finding that appellee did not violate Sections 2, 12 and 19 of Act 666 of the Philippine Legislature in obtaining such registration.

VI.

The finding and holding of the court that the word "Rogers" was registered by appellee for the use and benefit of the International Silver Company is in conflict with the rules and regulations governing the registration of trademarks, and is at variance with the pleadings, proofs and theory of appellee and with the judgment of the trial court.

VII.

The court erred in disregarding final decisions of the Court of Appeals of the District of Columbia and of the Federal Courts of the United States between Wm. A. Rogers, Ltd. and its [illegible] in litigation with the International Silver Company and its predecessors, [illegible] in favor of Wm. A. Rogers, Ltd. and the [illegible]

We are attaching to this motion as Appendix "B" a certified copy of Rule (1) of the Rules and Regulations governing the registration of trademarks and tradenames issued pursuant to Section 20 of Act 666 and of which the court takes judicial cognizance under Section 275 of the Code of Civil Procedure.

This rule was in force in the year 1918 when the word "Rogers" was registered as a trademark by the H. E. Heacock Co. and provides:

> "1. Any person, firm, or corporation desiring to register a trademark or tradename for his or its exclusive use shall make application therefor in writing to the Director of the Bureau of Commerce and Industry, who will note on the margin thereof the day, hour, and minute when the same was filed.
>
> Any importer desiring to register the mark of the articles imported by him may do so either in the name of the owner of the mark, or in his own name; in the latter case he shall be required to file in the Bureau of Commerce and Industry with the application, description and affidavit, a document, duly executed and signed by the owner of the mark, authorizing such importer to register the mark in the latter's name."

There is no contention that the H. E. Heacock Company complied with this requirement.

Moreover, the holding of the Court that the alleged trademark "Rogers" was registered by appellee for the use and benefit of the International Silver Co. is based upon the shockingly erroneous assumption that the word "Rogers" alone is the trademark of the International Silver Co. and was

and is subject to registration by it or for its exclusive use and benefit.

The only basis this Honorable Court had in the record for holding that the H. E. Heacock Co. registered the name "Rogers" with the authorization and for the use and benefit of the International Silver Co. is found in the following testimony of Mr. Gaches on cross-examination:

> "Q. If the International Silver Company should take the representation away from the H. E. Heacock Company, would your company insist upon making its mark Rogers prevail against the International Silver Company?
>
> A. Since the International Silver Company knew of and consented previously to the registration of that trade-mark, we would probably consider it necessary to leave that mark to them." (pp. 29-30, transcript.)

This statement of Mr. Gaches is nothing but his uncertain speculative opinion on the subject and would not even tend to obligate the corporation.

The pleadings of the H. E. Heacock Company in the above entitled cases, the certificate of registration of the alleged trademark "Rogers" itself in the light of Sections 2, 12 and 19 of Act 666 of the Philippine Legislature entitled "Trademark and Trade-name Law of the Philippine Islands" as amended, show conclusively that the registration of the alleged trademark was intended for the use and benefit of the applicant and not for the International Silver Company.

The action of the H. E. Heacock Co. is for dam-

ages for infringement of its alleged trademark "Rogers" and for unfair business competition in the sale of the wares of Wm. A. Rogers, Ltd. in competition with the wares sold by appellee under said alleged trademark "Rogers" (pp. 2 to 5, inclusive, B. of E., G. R. No. 31851).

No mention is made of the existence of the International Silver Company nor of the infringement of its trademarks "1847 Rogers Bros." and "Wm. Rogers & Son" nor of unfair business competition in sales of the wares of Wm. A. Rogers, Ltd. in competition with wares sold by appellee under the trademarks "1847 Rogers Bros." and "Wm. Rogers & Son" of the International Silver Company.

Again, the H. E. Heacock Co. in its letter of December 24, 1927, to the American Trading Company (Exhibit "16"), among other things, said:

> "* * * Please be advised that we registered the trade-mark 'Rogers' in the Philippine Islands for use in connection with silverware some years ago, and are the exclusive owners thereof." (Exhibit 16.)

It would seem that this Honorable Court as a foundation for its decision believed it necessary to ignore the pleadings and proofs of appellee and the decision of the trial court and to completely revise the theory upon which counsel for appellee brought and prosecuted its action. At the very threshold of its consideration, the court was confronted by the proposition that the family name "Rogers" is not susceptible to appropriation or use as a trademark

at all by any person other than a Rogers or a successor of a "Rogers" and that therefore the appellee was out of the running as a claimant to the alleged trade-mark "Rogers" on its own account because under the law the right of appellant Wm. A. Rogers, Ltd. (or of any of the other Rogers concerns engaged in the same business) to the use of the word "Rogers" as a trademark is absolute and exclusive against H. E. Heacock Co. which is neither a "Rogers" nor a successor of a "Rogers". But, as a matter of fact, the court in altering appellee's theory by transferring the beneficial interest of the alleged trademark "Rogers" from appellee to the International Silver Co. only made the case for appellee more difficult. The registration being in the name and for the absolute benefit of appellee so far as the record discloses, its validity must be determined upon that basis no matter what the private understanding between appellee and the International Silver Co. may be. Moreover, the finding that the allege trade-mark was registered with the authorization and for the use and benefit of the International Silver Co. carries with it the conclusion that the appellee was charged with the latter's knowledge of the registration and use of the trademarks of Wm. A. Rogers, Ltd. in the United States.

A review of the many decisions of the various courts of the United States with reference to the right to use the family name "Rogers" as a trademark, as well as of other jurisprudence on the same

subject, shows that (1) no Rogers or Rogers concern is entitled to the exclusive use of that family name as a trademark as against other bona fide Rogers or Rogers concerns; (2) that all individuals of the name of Rogers who have devoted themselves in good faith to the silver-plated flatware and tableware business and trade as an occupation are entitled to the use of the word "Rogers" accompanied by other distinguishing words and symbols on their own wares and are likewise entitled to use such trademarks on the wares of any corporation organized in good faith for the purpose of advancing their business; (3) that no individual by the name of Rogers who has not devoted himself in good faith to the trade of silverplated flatware can barter or sell his name for use either by a firm in which he is included or by a corporation in which he may become a stockholder solely for the purpose of enabling such firm or corporation to make use of a trademark containing the word "Rogers" in competition with other bona fide Rogers silverplating concerns.

The judicial history of the entry of Wm. A. Rogers in the silverplated flatware and tableware business commences with the decision of the Circuit Court of Appeals in the case entitled Rogers vs. Wm. Rogers Mfg. Co., 70 Fed. 1019. The appellant in that case was Wm. A. Rogers, the founder of Wm. A. Rogers, Ltd., and the appellee was Wm. Rogers Manufacturing Co., one of the predecessors of the International Silver Co. The decision as hereinafter set forth was

in favor of Wm. A. Rogers, and from that time all decisions of the Federal Courts and of the Court of Appeals of the District of Columbia involving the identical trademarks of Wm. A. Rogers, Ltd. here in question have been decided in favor of Wm. A. Rogers and of the corporation founded by him as his successor, Wm. A. Rogers, Ltd.

We cannot reconcile in our minds the decision of this Honorable Court with a careful reading by it of the many final decisions in favor of Wm. A. Rogers, Ltd. and its predecessor and against the International Silver Company and its predecessors, in which the identical issues with reference to the identical trademarks here in question were decided uniformly in favor of Wm. A. Rogers, Ltd., and its predecessor and founder, Wm. A. Rogers. In the hope that the court may yet read these decisions if it has not already done so, we again set them out.

We quote the entire decision in the case of Rogers vs. Wm. Rogers Manuf'g. Co. 70 Fed., 1019 (1895), as follows:

> "Appeal by the defendant from an order of the circuit court for the Eastern District of New York, which granted an injunction pendente lite against the defendant's causing to be manufactured or selling silver-plated ware stamped with the words 'Wm. A. Rogers.' The order was obtained upon the ground that by the use of this stamp upon the back of silver-plated ware the defendant was endeavoring to deceive the public into the belief that the goods were genuine Rogers goods, to the injury of the complainant. The history of the trade-name

'Rogers', and the law upon the subject, have been briefly given in R. W. Rogers Co. v. Wm. Rogers Manuf'g. Co. (which was decided at the present term) 70 Fed. 1017.

"Wm. C. Beecher, for appellant.

"Chas. E. Mitchell and Hiram R. Mills, for appellee.

"Before WALLACE and SHIPMAN, Circuit Judges.

"SHIPMAN, Circuit Judge. William A. Rogers has sold for a number of years, in the city of New York, small hardware and cheap spoons. In July, 1894, he engaged R. Wallace & Sons Manufacturing Company, a manufacturer of silver-plated ware, to make for him and prepare for market teaspoons, tablespoons, and forks plated upon steel. They were put up in boxes of the ordinary size and shape used for similar ware, which were labeled 'Wm. A. Rogers, N. Y.', and the stamp 'Wm. A. Rogers' was upon the back of each article. They were called 'Brunswick', and were the cheapest known grade of silver plated ware. The manufacturer made and sold the same grade of goods at a very cheap price under the name of 'Victoria'. The defendant sold the Brunswick at a low price, but higher than the manufacturer asked for his Victoria, and for one-fourth or one fifth of the price which the complainant obtains for its genuine Rogers goods. In October, 1894, Rogers stopped the manufacture of Brunswick goods, because they were too poor and obtained goods which he named 'Belmont', which were also of a low grade, but of a better quality than the Brunswick, and were labeled and stamped in the same way. There are indications in the affidavits that he was trading upon his own name to deceive the public. For example, in one of his letters, which gave his prices, and solicited business, he says, 'These prices way below any of the Rogers now, on the market, and you will find

them, at these prices, big sellers.' In another letter of the same kind he says, 'Prices way below any Rogers goods on the market.' On the other hand, he said in another letter, 'In regard to saying they are as good as the other William Rogers, I can not say that, as neither is the price.' He undoubtedly knew that the stamp could and would be used by dishonest peddlers and dealers in cheap ware to deceive customers, but the affidavits do not afford sufficient basis for a finding that he started in the business and used the stamp for the purpose of making the public believe that his washed-steel Brunswick goods were genuine Rogers goods. There are some indicia of an unworthy purpose to gain an advantage from a name well known to the purchasers of silver-plated ware, but the affidavits do not contain sufficient facts to justify the conclusion that Rogers was using his name unfairly and dishonestly in the business in which he was entitled to use it.

"The order of the circuit court is reversed, with costs."

We quote the entire decision in the case of Wm. Rogers Mfg. Co. vs. Rogers, 84 Fed., 639 (1898) as follows:

"This was a suit in equity by the William Rogers Manufacturing Company against *William A. Rogers* for alleged infringement of a trade-name. The cause was heard on a motion for preliminary injunction.

"C. E. Mitchell, for the motion.

"Wm. C. Beecher, opposed.

"LACOMBE, Circuit Judge. Defendant's right to use the ordinary abbreviation of his name, 'Wm. A. Rogers', was settled by the decision of the circuit court of appeals (17 C. C. A. 575, 70 Fed. 1019); and in no instance does it appear that he has put up his goods, or offered them for sale, in any form

of package which directly or indirectly describes them otherwise than as the goods of 'Wm. A. Rogers.' There seems very little doubt that he has availed of the similarity of name, which naturally tends to confound his goods with those of the original Rogers, who built up a valuable trade in plated ware years before defendant went into the business. But so far as the mere name produces such confusion, plaintiff has no cause of complaint. It is a reasonable inference from all the testimony that defendant expected that unscrupulous dealers would offer his goods as those of one or other of the original manufacturers, whose name was well known to, and popular with, consumers. The two advertisements reproduced in complainant's brief are most persuasive to that conclusion. But both of those advertisements contain his own name in prominent type, and the statement 'Our goods are, 'Rogers' goods,' and 'The genuine Rogers Goods, as used by U. S. government', etc., are technically accurate. There are some points of resemblance between this case and those of Baker v. Sanders, 26 C. C. A. 220, 80 Fed. 889, and Hoff v. Tarrant, 22 C. C. A. 644, 76 Fed. 959, but there is not enough to warrant an injunction, so long as defendant's goods are packed and labeled with his own name, Wm. A. Rogers, not collocated with other words in such manner as to induce any greater confusion in the minds of purchasers than would naturally be produced by the use of such name. Motion denied."

"IN THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA

Wm. A. ROGERS, LIMITED, *Appellant*,

vs.

INTERNATIONAL SILVER CO.

No. 400, Patent Appeals

The appeal is from a decision of the Commissioner of Patents sustaining opposition to, and denying the registration of a trade-mark.

On May 25, 1905, Wm. A. Rogers, Limited, a corporation of the Province of Ontario, Dominion of Canada, applied for the registration of a trade-mark, consisting of the words 'Wm. A. Rogers', used in the manufacture and sale of silver-plated flat ware, hollow ware, and table ware. It is displayed by stamping the ware, and by means of labels on packages and cases containing the same. Continuous use was claimed since the year 1894. Right to register is claimed under the proviso of the Act of February 20, 1905, called the 'Ten Years clause'.

After publication, opposition was filed by the International Silver Company, a corporation of the State of New Jersey. The allegations of the opposition are substantially:

1. That it is engaged at Meriden, State of Connecticut, and elsewhere in the manufacture of silver plated table ware, and in its sale throughout the United States and in foreign countries.

2. That the Wm. Rogers Mfg. Co., a corporation organized in Connecticut in 1872, has been engaged since then in the manufacture and sale of silver plated table ware.

3. That in May, 1899, the opposer became the successor to the business of said Wm. Rogers Mfg. Co., and became vested with its good will, including trade-marks and trade-mark rights, and has continued said business since said date.

4. That said Wm. Rogers Mfg. Co., for the purpose of identifying its wares adopted and used from and after 1876 the trade-mark 'Wm. Rogers Mfg. Co.', and 'Wm. Rogers and Son', with and without certain prefixes; and opposer as its successor has used the same throughout the United States and in foreign nations. The conspicuous and characteristic feature of both of said marks being the words 'Wm. Rogers.'

5. That by reason of the long continued association of said trade-marks in the market with the products of opposer and its predecessor, and by reason of extensive advertisement, the same have become very widely known and valuable to opposer; and by reason thereof the goods bearing the same have come to be familiarly known in the market as 'Wm. Rogers goods' and 'Rogers goods,' and the same are the essential part of the good will of opposer's business, and are of great value, so that any injury thereto injures and destroys the value and profits of its said business.

6. That the trade-mark sought to be registered by applicant was adopted by William A. Rogers many years after the adoption by the Wm. Rogers Mfg. Co. of its trade-marks aforesaid, that were subsequently acquired by opposer. That it so clearly resembles the marks of opposer, that its registration will result in the confusion and deception of purchasers and the public generally. And the said applicant has not the exclusive right to use said mark, but others, including opposer, have prior rights either in the identical form, or in such near resemblance thereto as might be calculat-

ed to deceive. That the original Wm. A. Rogers was permitted to use said mark as against the prior use of the marks of opposer, only because it was his name, and he never had the right to any exclusive use thereof, except as he was permitted to use it as his own name concurrently with the use by opposer and others of similar marks.

Demurrer was entered to this opposition on the following grounds:

1. It does not appear that the trade-mark so closely resembles opposer's marks as to result in confusion or deception of purchasers.

2. It does not appear that the opposer will be injured or damaged by the applicant's registration, in that it does not appear that said trade-mark was not in the actual and exclusive use of applicant or its predecessor, from whom it derived title, for ten years next preceding the passage of the Act of February 20, 1905.

Subsequently an affidavit of William A. Rogers, General Manager of applicant, was filed, alleging certain facts relating to the use of the several trade-marks by applicant, opposer, and others not in the combination of the latter. It is unnecessary to set this out, as it cannot be considered. The demurrer must stand as an admission of the allegations of the opposition, insofar as they state facts and not conclusions of law, and cannot be supported by the affidavit. The Examiner of Interferences, expressing the opinion that the similarity of the marks is so great as to produce confusion in the minds of the public, overruled the first ground of the demurrer. He sustained the second ground under his construction of the proviso of the Act relating to ten years prior use. On appeal to the Commissioner the decision of the Examiner on the second ground was reversed. The applicant electing to stand on its demurrer, a final decision was made on the two

grounds: that the similarity between the two marks is so close as to be likely to cause confusion and deceive the public; and that the trade-mark of the applicant has not been in actual and exclusive use for ten years prior to the passage of the Act. For these reasons, registration was denied.

From the opinion of Judge Shipman in R. W. Rogers Co. v. Wm. Rogers Mfg. Co. (70 Fed., 1017) it appears that about fifty or more years ago, in the State of Connecticut, Rogers Bros., a firm composed of three brothers, first applied the art of electro-plating to the manufacture of silver plated ware in this country, and established and maintained a high reputation for the sterling quality of their wares. The name of Rogers Bros. stamped upon the back thereof obtained a widely extended reputation. Since then, apparently, the surname Rogers has been used by many different persons, natural and artificial, in various collocations. The Wm. Rogers Mfg. Co.—predecessors of the opposer—as appears from the allegations of the opposition, was one of the early ones of these. William A. Rogers, a natural person, was another. Whether he is the same person who is the general manager of the appellant, Wm. A. Rogers, Limited, does not clearly appear; apparently he is. In 1894, he engaged a manufacturing firm to make silver plated ware for him. This was stamped on the back, 'Wm. A. Rogers', and put in boxes of the ordinary size and shape for such ware, labeled 'Wm. A. Rogers, N. Y.' On a bill filed against him by Wm. Rogers Mfg. Co., an injunction pendente lite was granted against his causing to be manufactured, or selling silver plated ware stamped with the words, 'Wm. A. Rogers.' On appeal, the Circuit Court of Appeals, for the second Circuit, reversed this order. It was said that while there were indicia of an unworthy purpose to gain ad-

vantage from a name well known to the purchasers of silver-plated ware, the facts were not sufficient to justify the conclusion that he was using his name unfairly and dishonestly in the business in which he was entitled to use it. Rogers v. Wm. Rogers Mfg. Co. 70 Fed. Rep. 1019. In 1898, the Wm. Rogers Mfg. Co. filed another bill against William A. Rogers for alleged infringement of its trade-mark, and moved for a preliminary injunction, which was denied by Lacombe, Circuit Judge. In a brief opinion, he said that defendant's right to use the ordinary abbreviation of his name 'Wm. A. Rogers' had been settled in the former case. (70 Fed. Rep., 1019). And that it did not appear that he had put up his goods, or offered them for sale, in any form of package describing them otherwise than as the goods of 'Wm. A. Rogers'. While he had, doubtless, availed himself of the similarity of name which naturally tends to confound his goods with those of the original Rogers, yet, so far as the mere name produces such confusion, the plaintiff has no cause of complaint. After reciting some of the facts, relating to defendant's probable motives, he said there was not enough to warrant the injunction, 'so long as defendant's goods are packed and labeled with his own name, 'Wm. A. Rogers', not collocated with other words in such manner as to induce any greater confusion in the minds of the public than would naturally be produced by the use of such name.' Wm. Rogers Mfg. Co. v. Wm. A. Rogers, 84 Fed. Rep., 689 (Affirmed by C. C. A.); 95 Id., 1007.

The principle applied in those cases, between the predecessors of the parties to this opposition and involving the same trade names, has been maintained by the Supreme Court of the United States. Howe Scale Co. v. Wyckoff, Seamans and Benedict, 198 U. S., 118, and cases cited. That case involved the use of the name, 'Remington'.

The conclusion of the court was thus declared by Mr. Chief Justice Fuller: 'We hold that, in the absence of any contract, fraud, or estoppel, any man may use his own name, in all legitimate ways, and as the whole or a part of a corporate name.' As an ordinary surname cannot be appropriated as a trade-mark, to the exclusion of others of the same name, it follows that the rules of law relating to the similarity of technical trade-marks cannot be applied to the use of such surname as a mark, notwithstanding the confusion that may result from its legitimate use by such others. The law relating to unfair competition may apply, under certain conditions, but not that of infringement.

This brings us to the chief point of contention: Whether, under the last proviso of the fifth section of the Trade-Mark Act, approved February 20, 1905, the appellant is entitled to have registration of the name, 'Wm. A. Rogers', by reason of its ten years previous use as a trade-mark. The provision reads as follows:

'*And provided further* that nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this Act.'

The intention of Congress in adopting this proviso was declared in the recent case of — *In re* Cahn, Belt & Co., 27 App. D. C., 173, 177. Mr. Justice McComas, who delivered the opinion of the court, said: 'The last proviso of this section which was in the bill when it passed the House of Representatives, was amended in the Senate by twice substituting the word 'mark' for the word

'trade-mark', and by inserting in lieu of 'and lawful', the word 'exclusive'. It is clear to us that these changes were made for the purpose of permitting the registration of marks which were not in either of the classes prohibited by this section, used as trade-marks, by the applicants or their predecessors, from whom they derive title, and in which the user had acquired property rights for more than ten years next preceding the passage of the Act. The last proviso of Section 5, as amended and passed, was not intended to provide for the registration of technical trademarks, for such marks had been cared for elsewhere in this Act. This proviso permitted the registration of marks, not in either of the clases prohibited by this section, if such marks were in actual and exclusive use as a trademark for ten years next preceding the passage of the Act. In respect of technical trademarks, this proviso was absolutely useless. It was intended to save the right of registration to the marks described in the proviso. The section had prohibited the registration of immoral or scandalous matter, and public insignia as trade-marks, no matter, how long the same had been before registered, and the proviso only extended the right of registration to marks not within either of the prohibited classes, if such marks had been in actual and exclusive use as a trademark during the ten years preceding the passage of the Act.'

As the name of a person could not be appropriated as a technical trademark, but might, nevertheless, have been used by him as a mark to indicate the origin of his goods, it is, under this interpretation of the proviso, entitled to be registered if in actual and exclusive use as such a mark for more than ten years next preceding February 20, 1905. That this name, 'Wm. A. Rogers', was so used by him, and by the applicant under right

derived from him, is not denied in the allegations of the opposition, but is practically admitted. The exclusive right to its use only is denied, and that on the ground that it so closely resembles the marks acquired by the opposer from its predecessors, namely, 'Wm. Rogers Mfg. Co.', and 'Wm. Rogers and Son', as to be calculated to confuse and deceive purchasers, and the public generally. This, of course, is a conclusion of law that is not admitted by the demurrer. As heretofore stated, this rule relating to similarity and simulation as applied in the case of recognized trademarks, is not applicable to the names of persons legitimately used as marks for their goods. The Commissioner failed to recognize this distinction and held that the use of the name by the applicant had not been exclusive because it was a simulation of the marks of the opposer that had also been in use during the same period. As authority for his conclusion he quoted the following extract from the opinion in the Cahn Belt & Co. case: 'The application in this case admits that the mark we are now considering is a simulation of the arms or seal of the State of Maryland, with variations it is true, but still a simulation of the coat of arms of Maryland. The coat of arms of Maryland was never in the exclusive use of the applicants during any period, nor could the applicants ever acquire an exclusive use as a trademark of the State coat of arms. In the sense of this proviso, the applicants had the actual but never had the *exclusive* use of this simulation of the Maryland coat of arms, and for this reason the appellant's trademark sought to be registered does not come within the last proviso of the fifth section. The appellants never could acquire such property right in the coat of arms of Maryland, or any simulation thereof, against the State of Maryland.'

What was there said had relation to a different state of facts from those presented in this

case. The mark was not the name of the applicants or of any one of them, but a device claimed as a technical trade-mark. It was, as said, nothing more than a simulation of the arms and seal of the State of Maryland. As the applicants could not register it for that reason, they claimed the right to do so under the proviso because of its exclusive use by them as a trademark for more than ten years before the enactment of the Statute. But as it was of the nature of a technical trademark, the exclusive right to the use of which was in the State of Maryland, it was held that they could not evade that exclusive right by using it in a slighly changed form. Here, however, the applicant was lawfully entitled to use the name, 'Wm. A. Rogers', as a mark upon his goods, though any other person, of the identical name, might also have used it upon his own goods. But it was not made to appear that there was another Wm. A. Rogers making the same goods and using his name as a mark upon them during that time. The sole use of his name for the time prescribed was enough, we think, to constitute an exclusive use of the mark within the meaning of the proviso. The opposer did not show any right to use the mark or name, 'Wm. A. Rogers', but only those of 'Wm. Rogers Mfg. Co.,' and 'Wm. Rogers and Son'. In view of what has been heretofore said, it is unnecessary to consider whether, if these were all technical trademarks, the applicant's mark so closely resembles the others as to constitute an infringement. Each party is entitled to use his own name, actually or legally acquired, without regard to the confusion that may result from similarity. No right of property will be concluded by the registration of appellant's mark. All parties affected are free to maintain whatever rights they may have in law or equity in the courts having jurisdiction therein.

The decision will, therefore, be reversed; and

this decision will be certified to the Commissioner of Patents as the law requires. *Reversed.*

SETH S. SHEPARD,
Chief Justice.

Endorsed: No. 400 Patent Appeal. Wm. A. Rogers, Limited, Appellant, vs. International Silver Company. Opinion of the Court per Mr. Chief Justice Shepard. Court of Appeals. District of Columbia. Filed June 4, 1907. Henry W. Hodges, Clerk."

"IN THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA

Wm. A. ROGERS, LIMITED, *Appellant,* vs. INTERNATIONAL SILVER CO.	Patent Appeal Docket No. 585

In this appeal appellant seeks a reversal of the decision of the Commissioner of Patent sustaining the opposition of appellee to the registration of a mark consisting of the word 'Rogers', containing '1881' above and the word 'Quadruple' and 'New York' below, and on either side wreaths surrounding the letter 'R'.

The ground of the opposition is conflict between certain of appellee's marks and appellant's mark. The facts briefly stated are these: Wm. A. Rogers, the predecessor and present manager of appellant, established a silver plated ware business in 1881. Twenty years later he incorporated his business. For several years prior to the filing of this opposition appellant sold goods under the mark for which

registration is sought. The extent of these sales does not clearly appear, owing to the similarity of this mark and another mentioned in the testimony. In 1889 the appellee became the successor to the 'Wm. Rogers Mfg. Co.' In 1888 appellee's predecessor adopted and caused to be registered as one of its trademarks the word 'Rogers', preceded and followed by an anchor. Appellee's predecessor also adopted as trademarks 'Wm. Rogers Mfg. Co.' and 'Wm. Rogers & Son'. Each of these marks has been in use by appellee, since a time antedating the date of adoption of appellant's mark.

'Rogers' being a surname it is not susceptible of exclusive appropriation as a trade-mark by anyone since 'Any man may use his own name in all legitimate ways and as the whole or a part of a corporate name.' Howe Scale Company vs. Wyckoff, Seamans, Etc., 198 U. S. 118; Wm. A. Rogers, Limited vs. International Silver Company, 30 App. D. C., 97. The most the courts will do where two individuals are entitled to use the same name is to correct any abuse by either of that right. Donnell vs. Herring—Hall—Marvin Safe Company, 208 U. S. 267. Appellant's right to the use of the word 'Rogers' has been judicially determined. R. W. Rogers Co. vs. Wm. Rogers Mfg. Co., 70 Fed. 1017; 95 Fed. 1007.

The trade-mark Act is framed with a view to obviate, so far as possible, the confusion naturally resulting in the use of the same name by individuals or corporations engaged in the same line of business, for it prohibits the registration of any mark consisting merely in the name of an individual, firm or corporation, unless applied in some particular or distinctive manner or in association with a portrait of the individual. Each party to this proceeding having the right to use the word 'Rogers' it becomes apparent that this inquiry is narrowed to the ques-

tion whether the accessories employed by applicant, or, in the language of the statute, the particular and distinctive manner in which it has made use of the word, is deceptively similar to the particular or distinctive manner in which the opposer has made use of the word. In other words, conceding the right of each to use this name, has applicant differentiated its use from that of the opposer.

Of the three marks cited the opposer the one nearest like that of the applicant is that containing an anchor on either side of 'Rogers'. A comparison of this mark with applicant's mark, in the light of the foregoing observations, impels us to the conclusion that these marks are not deceptively similar. It cannot be disputed that the ordinary observer would note a difference between the anchors of opposer and the wreaths enclosing the letter 'R', the numeral '1881', 'Quadruple' and 'New York', as employed by the applicant. Doubtless some confusion may arise because of the common use of 'Rogers' by these two concerns, but that is a matter with which we are powerless to deal. The fact disclosed by the record that the opposer has taken no steps against the applicant because of its use of this mark, and that actual deception has not been shown, should be given weight here. Gaines vs. Knecht, 27 App. D. C., 534.

Johnson vs. Brandau, 32 App. D. C., 348, cited by appellee, contains nothing inconsistent with this opinion. In that case an attempt was made to register, as an essential feature of a mark, the descriptive word 'Asbestos', and we held that since the word was not registrable so also was the mark. Here 'Rogers', if applied in a particular or distinctive manner, may be registrable. The distinction between the cases is obvious.

We rule that applicant's mark is not deceptively similar to that of appellee, and hence that it

may be registered. It follows that the decision of the Commissioner must be reversed. The clerk will certify these proceedings as by law required. Reversed.

CHAS. H. ROBB,
Associate Justice.

Endorsed: No. 585 Patent Appeal. Wm. A. Rogers, Limited, Appellant, vs. International Silver Co. Opinion of the Court per Mr. Justice Robb. Court of Appeals. District of Columbia. Filed February 1, 1910. Henry W. Hodges, Clerk."

"IN THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA

Wm. A. ROGERS, LIMITED, Appellant,

vs.

INTERNATIONAL SILVER CO.

Patent Appeal Docket No. 587.

This case involves the same parties as the two preceding cases. Appellant's mark herein, however, is 'Wm. A. Rogers, A. I.', followed by a horseshoe enclosing the letter 'R'. Appellee contends that this mark is deceptively similar to its marks 'Wm. Rogers Mfg. Co.' and 'Wm. Rogers & Son'. We think the accessories employed by appellant in its use of the word 'Rogers' reasonably differentiates its mark from appellee's. William A. Rogers, as appears in case No. 585, was the predecessor of appellant and is now its manager. The use, therefore, of the mark herein involved is not without reason. The goods sold under such a mark would probably be known as the 'Horseshoe Brand'. At all events, the mark in its entirety is not readily to be confused with the marks of appellee.

The decision is reversed and the clerk will certify this opinion as by law required.

CHAS. H. ROBB,
Associate Justice.

Endorsed: No. 587 Patent Appeal. Wm. A. Rogers, Ltd., Appellant, vs. International Silver Company. Opinion of the Court per Mr. Justice Robb. Court of Appeals. District of Columbia. Filed February 1, 1910. Henry W. Hodges, Clerk."

We also quote the entire decision in the case of Wm. A. Rogers, Ltd. vs. Rogers Silverware Redemption Bureau, Inc., (1917) 247 Fed., 178, in which the District Court for the Southern District of New York quoted with approval from the decision of the Court of Appeals of the District of Columbia as follows:

"MANTON, District Judge. The complainant is a manufacturer of silver-plated ware. The defendant is engaged in a trading stamp business. On January 26 and May 5, 1916, plaintiff and defendant contracted, among other things, that the defendant might use the name 'Rogers' in its corporate name in accordance with the terms of said agreement, and the defendant contracted to purchase the silver-plated ware of the plaintiff, and no other, in redeeming the trading stamps which it contracted to redeem for its various customers throughout the country. The defendant further agreed to carefully avoid misleading representations, and promised 'strict performance' of the contract on its part. The plaintiff sues, claiming that the defendant violated the terms of the contract in failing to carefully avoid misleading representations and in carrying on its business in a way to violate this provision of the contract. Defendant alleges that the plain-

tiff did not have the right to use or license others to use the name 'Rogers' in connection with marketing or selling silver-plated ware, and that the exclusive right to use the name 'Rogers' in connection with silver-plated ware belongs solely to the International Silver Company, and it asks, as affirmative relief, that the plaintiff specifically perform the agreements, and that the defendant be decreed the right to use the prefix 'Wm. A.' in conjunction with the name 'Rogers' in its corporate title and in its business of redeeming silver-plated ware of the plaintiff's manufacture in the operation and prosecution of its business.

"(1, 2) Prior to the date of these contracts, the defendant began the use of the name 'Rogers' in its corporate name, and this resulted in a notice of protest sent to it by the plaintiff. Negotiations followed, and resulted in the contracts in question. The contract recites that:

> 'Whereas, the party of the second part desires to continue to make use of the name 'Rogers' as a part of its corporate name under which it does business, and to make certain defined use of the name of the party of the first part in connection with its business of the redemption of silver-plated ware'; and whereas, 'the party of the first part is, for itself and *solely* for the parties hereto, willing to consent to such use, subject to the strict performance by the party of the second part of each and all of its covenants and agreements as heretofore set forth,' etc.

"In view of these negotiations and the phraseology of the contract, I think that the claim of the defendant that the plaintiff undertook to confer the right to use the name 'Rogers' upon the defendant is unfounded. All the contracts of January 26 and May 5, 1916, provided was that the defendant con-

sented for itself alone to the use of the name 'Rogers' so long as the defendant made no misleading representations, and maintained the standard of business conduct promised by it. The defendant's attack upon the plaintiff's right to the name 'Rogers' and the validity of its various trademarks need not be passed upon on this application, for it is not necessary to this decision. Plaintiff's right, however, to its trademark, and to use the name 'Rogers' has been the subject of much prior litigation, and the attack made upon it is without merit. The plaintiff has a valuable property right in its name and trade-marks, and this has been fully determined heretofore by judicial authority. Rogers v. Wm. Rogers Mfg. Co., 70 Fed. 1019, 17 C. C. A. 575; Wm. Rogers Mfg. Co. v. Rogers (C. C.) 84 Fed. 639, affirmed 95 Fed. 1007, 37 C. C. A. 358; William A. Rogers, Limited v. Cohannet Silver Co. (C. C.) 186 Fed. 241; William A. Rogers, Limited v. H. O. Rogers Silver Co. (D. C.) 237 Fed. 887; Wm. A. Rogers, Limited v. International Silver Co., 30 App. D. C. 97; Wm. A. Rogers, Limited v. International Silver Co., 34 App. D. C. 410; Wm. A. Rogers, Limited v. International Silver Co., 34 App. D. C. 413; Wm. A. Rogers, Limited v. International Silver Co., 34 App. D. C. 484.

"The plaintiff does not contend that it has an exclusive right to the use of the name 'Rogers', but claims the exclusive right to the name 'William A. Rogers', and to the use of its own trademark as registered, with the name 'Rogers' and particular symbols, and it also has a qualified right in the use of the name 'Rogers' standing alone, which, while not permitting it to enjoin the use of the name by any other legitimate Rogers Company, whose rights have been established, does permit it to enjoin the unauthorized use of the name 'Rogers' by persons having no right therein. It appears that the International Silver

Company also has a right to the use of the name 'Rogers', and that it has protested against the use of the name 'Rogers' by the defendant. There is nothing in the contract, nor can it be read in the contract, that the plaintiff has guaranteed the defendant the use of the name 'Rogers' as against any other who may have a qualified use of the name 'Rogers'. The plaintiff has not contracted nor obligated itself in any such terms. *Neither the plaintiff nor the International Silver Company has the right to the name 'Rogers' per se, unaccompanied by their own particular initials or trademark, but both the International Silver Company and the plaintiff have the right to restrain the unauthorized use of the name 'Rogers' by persons without rights therein.* (Italics ours.) Their mutual rights were considered in the cases of Wm. A. Rogers, Limited v. International Silver Co., 30 App. D. C. 97, and Id., 34 App. D. C. 410. There it was said:

> 'The sole use of his name for the time prescribed was enough, we think, to constitute an exclusive use of the mark within the meaning of the proviso. The opposer did not show any right to use the mark or name 'Wm. A. Rogers', but only those of 'Wm. Rogers Mfg. Co.' and 'Wm. Rogers & Son'. In view of what has been heretofore said, it is unnecessary to consider whether, if these were all technical trademarks, the applicant's mark so closely resembles the others as to constitute an infringement. Each party is entitled to use his own name, actually or legally acquired, without regard to the confusion that may result from similarity. No right of property will be concluded by the registration of appellant's mark.'

'Therefore, the defendant having begun an unlawful use of the name 'Rogers', and after protest having contracted with the protestor, and having ob-

tained a consent from the plaintiff alone that it might use the name 'Rogers' on condition of the defendant's living up to its promises, it remains to be determined whether or not there has been a breach of the agreement on the part of the defendant.

"The plaintiff must be charged with full knowledge of the kind of business the defendant was engaged in, and with the fact that it was necessary to send selling agents or canvassers about the country in the furtherance of its business. It is claimed by the plaintiff that in at least 13 cases statements were made by canvassers which were misleading, and which were not truthful, and that such misleading representations were violations of the 'strict performance' provision of the contract. I am asked to accept the claim of the defendant, for the reason that the 13 different instances of misstatements or misrepresentations are found in widely scattered parts of the country, and that this constitutes strong evidential proof of its truthfulness. The testimony of the 13 witnesses was taken by deposition, and has resulted in the use of most general language, the substance of which is that the agents of the defendant stated that in some instances they represented Wm. A. Rogers, Limited, and that this was a new medium of advertising by the plaintiff; that it was found much cheaper than extensive advertising in the Saturday Evening Post and other magazines. The language used by each witness, however, is given with some hesitancy as to recollection, and lacks probative force. Then, too, each of the 13 witnesses received a communication from the plaintiff or its attorney, which to some extent indicated about what they testified to.

"I do not say that this was improper, for, indeed, it was the least costly way for the plaintiff to secure information, in view of the distance the wit-

nesses lived from the plaintiff's place of business; but, on the other hand, it can readily be seen that distant merchants, whose suspicions were aroused as to the legitimacy of the defendant's business, might well add to their suspicion by such an inquiry from the plaintiff, and let it culminate in the belief that the defendant and its agents were perpetrating a fraud. It is possible to conceive of a visit in search of business and explanation of its scheme by the defendant's agents, without some coloring of their proposition in the hope of obtaining business. Unless this reached the stages of fraudulent misrepresentations, and such were made with knowledge by the officers of the company, it does not reach the standards of such conduct as should result in a cancellation of this contract under its provisions. The defendant's officer have testified and disclaimed any such knowledge of misrepresentations, and have stated that each agent was instructed to guard against making misrepresentations; each agent was told to state the proposition as an advertising medium for the merchant, with profit to the customers and with profit to the defendant.

"The defendant was trying for success in its business, and could only reach this goal by legitimate business methods; for otherwise it would soon not only be discovered, but fail. Its scheme of business is ingenious. It is illustrative of the magnitude of small profits with large volume of business. Where, as here, there may have been some misrepresentation—for I am inclined to believe that there was—I am satisfied that it was not with the consent or knowledge of the officers of the company, and I do not think that, under those circumstances, the plaintiff should be relieved from the terms of the contract.

"Then, too, it must be remembered that a statement, made by an agent, that he represented the Wm

A. Rogers Company, is to some extent true; for he did indirectly, in the sense that the contract provided for the sale only of the Wm. A. Rogers silver-plated ware, and the use therefore of the name of the plaintiff was not forbidden. In the Puckett Case, where a card was used improperly, it was satisfactorily explained that the card was printed through error, and this error was at once corrected, and immediate steps taken to prevent its recurrence. In the case of the Hygenic Baking Company, the dissatisfaction there expressed seems to be pivoted about a dissatisfaction with the terms of the contract. One can well conceive how, in informing the merchant of the source of the goods, by whom manufactured, that the curiosity or imagination of the visited merchant would lead him to believe the agent represented the plaintiff. Indeed, I think the plaintiff should be charged with the expectation that this would flow as the consequence of such a contract as it has made.

"This confusion is illustrated by statements of the witnesses, on the one hand, that they have seen advertisements for Rogers' silver-plated ware in the Saturday Evening Post, when it is conceded that the plaintiff did not advertise in the Saturday Evening Post but the International Silver Company did so advertise, using its trademark 'Rogers' and symbols. This is simply illustrative of the error into which the witnesses may have fallen. There were many thousands of contracts made throughout the country, and the only alleged misrepresentations or false statements are charged in 13 instances alone, and these are denied by defendant's agents and knowledge thereof is denied by the defendant's officers.

"In Jos. Schlitz v. Houston Ice Co., 241 Fed. at page 824, 154 C. C. A. at page 519, it was said:

'There is evidence in the record that agents

of the defendants advised purchasers of defendants' bottled beer in brown bottles with brown labels that it might be sold as plaintiff's beer to their customers. The defendants deny any knowledge of any such representations by their agents, and deny that any authority was given their agents to make such representations. The District Court found the facts against the plaintiff on this issue, and dismissed the bill, either because not satisfied that the representations were made by the agents, or, if made, that they were authorized by the defendants, or known to them. Occasional misrepresentation of soliciting agents, not shown to have been known to or authorized by defendants, would afford no ground of relief on the ground of unfair competition, apart from an improper dress for their goods.'

"The evidence here does not warrant my finding that there was a breach of the provision which says:

'The party of the second part further agrees at all times to maintain and conform to the high standards and business conduct, and careful to avoid making misleading representations of any kind and particularly as to the source of manufacture or character of silver-plated ware in which it deals or in respect to its business.'

"(3) As affirmative relief, the defendant asks that the contract be reformed, so as to allow the defendant to use the name 'William A. Rogers' as part of its corporate name. The contract recites that the defendant 'desires to continue the use of the name 'Rogers' as a part of its corporate name', and, further, that the parties are willing to consent to such use, and then it is agreed that, upon the performance of the conditions of the contract, such consent is given. Since the plaintiff had but a qualified use in the name 'Rogers' in connection with Rogers silver-plated ware, the question is

presented whether the contract should be so reformed that, in addition to the permission thus qualifiedly given to the use of the name 'Rogers', the plaintiff should be obliged to consent to the use of the prefix 'William A.' in connection with the name 'Rogers'. The defendant in its brief says:

'The meaning conveyed (by the contract) was that as far as the plaintiff could give the right to use the name 'Rogers' the defendant should have that right.'

"And it is argued that the defendant had no right to the use of the name 'Rogers', except only in connection with the prefix 'William A'; that is, in combination, 'William A. Rogers'.

"Above I pointed out that the plaintiff had a qualified use in the name 'Rogers'. It is only this qualified use that the plaintiff consented the defendant might have. In other words, it has but conferred the right of toleration in the use of the name 'Rogers' upon the defendant; this is the contract the parties made. The plaintiff parted with consideration when it consented to such use, and it is not for the court to impose a further consideration by reforming the contract. The evidence satisfies me that the defendant was fully informed at the time it made the contract; if not, it should have made inquiry, and now, when it is confronted with the objection of the International Silver Company, it is too late to ask the plaintiff to give something more.

"A decree may be entered, dismissing the complaint and denying the affirmative relief sought by the defendant." (Italics ours.)

We quote from an 1885 Connecticut decision on the trademark rights of members of the Rogers family as follows:

"* * * Where a person is selling goods under a particular name, and another person, *not having that name*, is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses; but where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence, in each case, whether there is false representation or not. Considered in the ordinary course of trade, it is a contradiction of terms to say that a man selling goods under his own name sells them as the goods of another, even if that other have the same name. The cases seem to require some element of false representation other than that implied in the fair, honest, and ordinary use of a person's own name.

"An examination of the following and kindred cases, wherein the use of a person's name has been regulated, will show that in most instances conscious, intentional, fraudulent misrepresentation on the part of the defendant had been resorted to; in others, there was such a combined use of the name with other marks, characters, figures, or form, and arrangement of circulars, advertisements, etc., as to amount to a false representation, and the combination only was enjoined. No instance can be found where the use of the name only, in good faith, has been stopped. See Croft v. Day, 7 Beav. 84; Holloway v. Holloway, 13 Beav. 213; Clark v. Clark, 25 Barb. 78; Sykes v. Sykes, 3 Barn & Co. 541; Metzler v. Wood, 8 Ch. Div. 608, 610; Fullwood v. Fullwood, 9 Ch. Div. 179; Devlin v. Devlin, 69 N. Y. 214; Landreth v. Landreth, 22 Fed. Rep. 41; Shaver v. Shaver, 54 Iowa, 213; S. C. 6 N. W. Rep. 188; Stonebraker v. Stonebraker, 33 Md. 268; Williams v. Brooks, 50 Conn. 278; Meriden Brit. Co. v. Parker, 39 Conn. 450.

"Upon the other hand, there has been, from the first to the present time, a general concensus of judicial opinion that the use of a personal name in a fair, honest, and ordinary business manner, could not be prevented, even if damage resulted therefrom. Croft v. Day, 7 Beav. 84; Holloway v. Holloway, 13 Beav. 213; Burgess v. Burgess, 3 De Gex, M. & G. 896; Faber v. Faber, 49 Barb. 357; Clark v. Clark, 25 Barb. 80; Meneely v. Meneely, 62 N. Y. 427; Comstock v. Moore, 18 How. Pr. 424; Gilman v. Hunnewell, 122 Mass. 139; McLean v. Fleming, 96 U. S. 252; Carmichel v. Latimer, 11 R. I. 395; Landreth v. Landreth, 22 Fed. Rep. 41; Singer Manuf'g. Co. v. Loog, 18 Ch. Div. 412. Other cases and dicta might be cited, but it is deemed unnecessary.

"In one brief filed for the plaintiffs, it is said that they make no exclusive claim to the word 'Rogers'; but he couples with that disclaimer a statement that the word 'Rogers' is the conspicuous and valuable part of their mark, and that any use of it by the defendants, in the ordinary way of manufacturers, by stamping their goods with it, either alone or in any combination, will indubitably produce results which they are now striving to prevent; and in the brief filed by the other counsel, the broad claim is made that the word 'Rogers' used as a stamp should be stopped. And as we have before said, this is the only contention left to the plaintiffs by the finding of the court below.

"In conclusion, we think there is neither authority nor reason in support of the doctrine that the fair, honest use of a name can be enjoined, when it is used in the ordinary course of business, in the way and manner in which other manufacturers of similar goods are accustomed to use their own name in the preparation for sale or sale of goods; that such a rule would operate in restraint of trade,

and prohibit a person from using the ordinary means that all are entitled to use in the prosecution of business enterprises; that such use contains no element of false representation or personation in any just and true sense, and that while it may be true that a possibility exists that the goods of one will be purchased to some extent by persons who either know no distinction, or even by the occasional few who suppose them to be the goods of another, that this condition of things is inevitable in trade and commerce, inhering in the nature of things, and attaches in kind, if not in degree, in all cases where a manufacturer, sending goods of any particular description, but without distinguishing mark, into a district or country where such goods were before that time unknown, and establishing a reputation in that district or country as the manufacturer and vendor of such goods. *Any new comer in the same district with similar goods would undoubtedly profit by the reputation of the former's goods, yet the benefit to the public generally of free competition, and the natural rights of all to seek any and all markets., would render ineffectual all attempts to shut out such new-comer.*

"Since the preparation of the foregoing opinion, the second edition of Brown on Trade-marks has been distributed. That author, upon a review of the cases, lays down this proposition: 'A manufacturer has a right to affix his own name to an article of his own production; and any injury which another manufacturer, having the same surname, may suffer in consequence thereof is *damnum absque injuria.*' Section 420. And in his commentary upon Howe v. Howe Sewing Machine Co., 50 Barb. 236, he says: 'This case is apt to mislead the superficial observer, and even for a moment stagger the preconceived notions of one used to critical examination. It has been cited more than once in support of this absurd proposition, to wit: When the two men in the same trade have the same

surname, one may employ that surname as a trade-mark, to the exclusion of any such right by the other; that is, when the two brothers have made and sold sewing machines, the one who first stamped his surname upon a machine was the sole possessor of the right to stamp his workmanship with his true name. This conclusion has no warrant from any authoritative source.' Section 423.

"There is no error in the judgment of the superior court." (Rogers v. Rogers, 1 Atlantic Reporter, 807, 813-815; italics ours.)

NOTE:—In reviewing the many decisions in Rogers cases the court should take care not to confuse Wm. H. Rogers with Wm. A. Rogers, the founder of Wm. A. Rogers, Ltd., the appellant in this case. While Wm. H. Rogers and the Wm. H. Rogers Corporation have been defeated in some litigation with the International Silver Co. and its predecessors, neither Wm. A. Rogers nor the corporation founded by him has ever been defeated by the final decision of any court in the United States.

VIII.

The court, having held that the alleged trade-mark "Rogers" was registered by the H. E. Heacock Co. with the authorization and for the use and benefit of the International Silver Co., erred in failing to hold that the final decisions of the Federal Courts of the United States and of the Court of Appeals of the District of Columbia in the litigation between Wm. A. Rogers, Ltd. and its predecessor and founder, Wm. A. Rogers, on one side and the International Silver Co. and its predecessors on the other are *res adjudicata* of the present litigation.

The decisions heretofore quoted are binding upon the appellee, the H. E. Heacock Co., as the representative of the International Silver Co., to the effect also that the appellant Wm. A. Rogers, Ltd. is the owner of and has the exclusive right to use the trade-marks in question consisting of the word "Rogers" and its accompanying words, letters and symbols to distinguish them from the other Rogers trademarks, and that the same are not an infringement of the trademarks of the International Silver Company. This point serves to further emphasize the error of this court in deciding the case upon a state of facts completely at variance with appellee's pleadings. Had appellee pleaded that the alleged trademark "Rogers" was registered for the use and benefit of the International Silver Company, appellant would have expressly pleaded the United States decisions as *res adjudicata*.

Again, the finding of this court as to the beneficial interest of the alleged trademark in no manner sustains the right of the International Silver Company through appellee to acquire the exclusive right to the use of the word "Rogers" as a trademark either against the Wm. A. Rogers, Ltd., or against any of the other independent Rogers concerns. Aside from the decisions of the United States courts upon the precise questions here involved between Wm. A. Rogers, Ltd. and the International Silver Co. the general jurisprudence on the subject is conclusive. We quote from 26 R. C. L. under the title

"Trademarks, tradenames, etc." Sec. 33, pp. 854, 855 and 856 as follows:

> "33. USE OF OWN NAME.—In general it may be stated that a person cannot obtain a monopoly in a trademark consisting of his name merely, so as to debar others having the same name from using it in their own business. The right of a person thus to use his family name is regarded as a natural right and he may put it on his own goods, notwithstanding another person of the same name may, in that name, manufacture and sell goods of the same kind. The rule is that while, as against persons bearing a different name, a person's right in his name trade-mark is absolute and exclusive, yet as against other persons bearing the same name no such exclusive right can be set up. Therefore an individual may use his own name in his business, even though he may thereby interfere with or injure the business of another person of the same name, provided he does not resort to any artifice or contrivance for the purpose of producing the impression that the establishments are identical, or do anything calculated to mislead. Such inconvenience or loss as may result from an honest use of a person's name in his business, by reason of its interference with the business of another having the same name, is regarded as *damnum absque injuria*."
>
> (See citations, Supreme Court of the United States, in support of foregoing text.)

Contradictory Findings and Theories of Court

The court in its decision apparently treats the H. E. Heacock Company as the owner of the trademark "Rogers" whenever that theory supports its reasoning, notwithstanding the concrete finding at page

10 that the H. E. Heacock Company registered the word "Rogers" with the knowledge, consent and approval and for the use and benefit of the International Silver Company. Attention is called to pages 15, 16, 17 and 18 of the decision in which the court assumes that the H. E. Heacock Company is itself *the owner of the trademark.* We quote from page 17 of the decision as follows:

> "If appellants' contention is sustained, any old established firm here which in good faith had applied for, and obtained, the registration of a given word as its trade-mark, and through its skill, energy, and business dealings had built up a good business, largely founded on that trademark, could after many years of such business wake up some fine morning and find that its trademark was of but little, if any, commercial value, because some other firm in the United States had registered its trademark in the Patent Office of that country, in which it made use of the word which the local merchant had registered as its trade-mark in this country. What would be the value of an old registered trademark in the Philippine Islands upon which a merchant had established his business here, if in later years another person in the same line of business, and on the strength of a similar registered trademark in the United States, could enter the field here and become a competitor in the sale of similar wares under similar trademark?"

In open conflict with the proofs and with the decisions of the Court of Appeals of the District of Columbia and of the Federal Courts showing that the trademarks of Wm. A. Rogers, Ltd., and of its predecessor have been duly registered in the United

States Patent Office at Washington since at least the year 1897, the court in the statement contained in the foregoing quotation and in other parts of the decision assumes by implication that the trademarks of Wm. A. Rogers, Ltd. were registered in the United States after the registration in 1918 in the Philippines of the word "Rogers," notwithstanding the fact that at another point in its decision the court finds:

> "It is admitted that the wares of the American Trading Company are manufactured in the United States by Wm. A. Rogers, Ltd. which has its trademarks duly registered in that country, as it alleges." (See page 10, decision.)

The allegation of Wm. A. Rogers, Ltd., and of the American Trading Co. to which the foregoing quotation from the decision of the court refers, after describing the trademarks, says:

> "3. That such trademarks were duly registered in the United States of America at different times from 1897 to 1917 and since their registration have been continuously used in trade by the said Wm. A. Rogers, Ltd., in the United States, in the Philippine Islands and throughout the world." (p. 8, B. E., G. R. No. 31852.)

The court, after finding that the alleged trademark "Rogers" was registered in the Philippines by H. E. Heacock Co. with the authorization and for the use and benefit of the International Silver Company, indulges in the following reasoning:

> "How could Heacock Company in 1918 know

> that seven years later the American Trading Company or Wm. A. Rogers, Ltd. would appear on the scene, claiming the right to the use of the word 'Rogers' as a family name? *How could it then know that Wm. A. Rogers, Ltd. had registered its trademarks in the United States Patent Office?* The construction of this section should be confined and limited to actual matters and things as they existed in 1918 when Heacock Company applied for and obtained the registration of the word 'Rogers' ". (pp. 15-16, decision; italics ours.)

We presume that the court will require no jurisprudence to support us in the statement that if the registration was made under the authorization and for the use and benefit of the International Silver Company, then the H. E. Heacock Co., as the agent of the International Silver Company in such registration, was and is charged with the knowledge of its principal, the International Silver Company, with reference to the registration of the trademarks of Wm. A. Rogers, Ltd., and it will probably not be claimed that the International Silver Company was ignorant of the registration of the trademarks of Wm. A. Rogers, Ltd., after so many years of litigation in the United States regarding the same trademarks and in which litigation the International Silver Company was invariably vanquished by Wm. A. Rogers, Ltd. Whatever the H. E. Heacock Co. may have expected to happen, the International Silver Co. knew that Wm. A. Rogers, Ltd. would, whenever the market justified, undertake to sell its wares in the Philippines as it had been doing in the United

States in competition with the Rogers wares of the International Silver Company.

As a matter of law, it is immaterial, except upon a question of fraud, whether the H. E. Heacock Company had knowledge or not of the registration of the trademarks of Wm. A. Rogers, Ltd. in the United States at the time of the registration by it of the word "Rogers" in the Philippines. If ignorance of the registration of trademarks as the property of any person or entity were sufficient justification for the appropriation and registration of the same trademarks by another, the ignorance of applicants for the registration of trademarks would become appalling and there would be little protection for the rights of property in trademarks.

See 38 Cyc. 750-752.
26 R. C. L. 874-875.

Nevertheless, the testimony of Mr. Gaches indicates that he had such knowledge and certainly it cannot be interpreted to negative such knowledge. We quote from Mr. Gaches' testimony as follows:

"Q. Did you know prior to the year 1927 that there was a company known as William A. Rogers, Ltd.?
A. Yes, sir; I knew.
Q. Do you also know that this company was engaged in the manufacture of plated and nickel tableware and articles?
A. Yes, sir.
Q. And you also knew that they sold these articles using the name Rogers as part of their trademark?

A. Yes, sir.
Q. Since how long ago do you know this?
A. I couldn't tell you.
Q. Is it not true that you knew this prior to the year 1927?
A. Yes, sir.
Q. Is it not true that you knew it in 1905?
A. No sir.
Q. Did you know it in 1909?
A. I don't know.
Q. How long have you been in the jewerly business?
A. Eighteen years." (pp. 24-25, transcript.)

Inasmuch as the court has found that the H. E. Heacock Co. registered the alleged trademarks "Rogers" for the use and benefit of the International Silver Company, it goes without saying that if the latter could not have legally registered the word "Rogers" alone as a trademark in the Philippines the H. E. Heacock Co. could not legally register that word for the use and benefit of the International Silver Company in the Philippines. The various decisions of the Court of Appeals of the District of Columbia and of the Federal courts rendered in litigation between Wm. A. Rogers, Ltd., and its predecessor and the International Silver Company and its predecessor heretofore cited have established beyond question that none of the many Rogers concerns or branches or successors of Rogers concerns engaged in the business of manufacturing and selling flatware and tableware have the exclusive right to the use of the word "Rogers" unaccompanied by distinguishing words or symbols, or can acquire it.

No greater right to register a family name as a trademark in the Philippines than in the United States

It would appear from the decision that the court probably considered the right to register family names such as "Rogers" in the Philippines stronger than the right to register such a name as a trademark in the United States, because section 5 of the Act of Congress of February 20, 1905, among other things, provides:

> "* * * That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act."

whereas, Section 2 of Act 666 of the Philippine Legislature contains no such express prohibition against the use of the name of an individual as a trademark.

As a matter of fact, the prohibition contained in the part of Section 5 of the Act of Congress of February 20, 1905, above mentioned is merely a codified expression of the universal rule of law on the subject which denies to any person, firm or corporation the right to the exclusive use of a family name as a trademark. (See Nims on Unfair Business Competition under the title "Family Names or

Surnames as Tradenames," Chapter VI, pp. 124, et seq.)

IX.

The court erred in failing to hold that if the appellee registered the alleged trademark "Rogers" with the authorization and for the use and benefit of the International Silver Co., then such registration must have been consummated for the purpose of wrongfully depriving Wm. A. Rogers, Ltd. and all other independent Rogers concerns engaged in the same business of the rights acquired by virtue of the registration of their trademarks in the United States Patent Office at Washington.

It is impossible to reconcile the finding of this Honorable Court that the alleged trademark "Rogers" was registered with the authorization and for the use and benefit of the International Silver Co. without concluding for the same reason that the registration was consummated in that form for the purpose of wrongfully depriving the appellant Wm. A. Rogers, Ltd. and other independent Rogers concerns of the rights acquired by them by virtue of the registration of their trademarks in the United States Patent Office at Washington. Otherwise, why did the appellee not register the trademarks of the International Silver Co. "1847 Rogers Bros." and "Wm. Rogers & Son" as registered in the United States Patent Office at Washington and under which the wares of the International Silver Co. have been sold by appellee? Did this Honorable Court reflect

upon this significant circumstance when it rendered its decision?

X.

The court erred in assuming and holding in effect that the word "Rogers" as registered by the appellee embraced all the trademarks of the International Silver Co. and that such registration protected appellee's trade in the wares of the International Silver Co. in the Philippines and that the sale of the wares of the International Silver Co. before and after the registration of the word "Rogers" by appellee constituted the use and application of the alleged trademark "Rogers" to the merchandise sold by appellee.

The trademarks of both the International Silver Company and Wm. A. Rogers, Ltd., admittedly registered in the United States and in nearly all of which the word "Rogers" occurs are in no instance composed of the word "Rogers" alone, but that word is accompanied by prefixes and suffixes consisting of letters, words and symbols to distinguish the trade-marks of one company from those of the other, and also to distinguish the trademarks of each company from its other trademarks. It is idle to expect that if the rights of the parties have been settled as a result of registration of all the trademarks involved in this litigation in the United States Patent Office and as a result of years of litigation in the courts of the United States, that the Supreme Court of the United States will

tolerate repudiation by the International Silver Company or by its representative, the H. E. Heacock Company, of such registration proceedings and final decisions between the parties in the United States.

The court, at page 8 of its decision, makes the following finding:

> "The Heacock Company was established in the City of Manila in the year 1909 as the successor of the firm of Heacock & Frier, which was established here in 1901, and has been in business ever since and importing into the Philippine Islands plate tableware, silverware, flatware and hollow-ware, and plated goods bearing the trade-mark 'Rogers' and it is admitted that on June 27, 1918 it registered here in the Bureau of Commerce and Industry the trade-mark 'Rogers'. *That it has been in the use and enjoyment of that trademark ever since.* The tableware and goods sold here by Heacock Company are manufactured by the International Silver Company, and such plated goods bearing the mark 'Rogers' have become widely and generally known in the Philippine Islands due to the publicity and advertisements given to them by Heacock Company." (Italics ours.)

The assumption of the court in the part of the decision above quoted to the effect that the registration of the alleged trademark "Rogers" was in effect a registration of the trademark of the International Silver Company and that the sale of the wares of the International Silver Company under the latter's own trademarks as registered in the United States was in effect the sale by the H. E. Heacock Company of wares under the alleged trademark

"Rogers" as registered by it in the Philippines is too inconsistent and illogical to merit serious discussion.

There can be no doubt but that the alleged trademark "Rogers" registered by the H. E. Heacock Company is an infringement of every trademark containing the word "Rogers", but to say that the same word "Rogers" embraces or is equivalent to all the registered trademarks of the International Silver Company is a contradiction of terms.

The trademarks of the International Silver Company which are duly registered in the United States and under which the H. E. Heacock Company has been selling the wares of the latter in the Philippines are as follows:

> "1847 Rogers Bros." (See Exhibits I, J, K, and 1, 2 and 3.)
>
> "Wm. Rogers & Son" (See Exhibits L and M).

There is no more reason for saying that "Rogers" alone is equivalent to either or both of the above trademarks than there is for saying that "1847" alone or "Bros." alone is equivalent to the trademark "1847 Rogers Bros.", or of saying that "Wm." alone or the character "&" alone or "Son" alone is the equivalent of "Wm. Rogers & Son."

The court says,—

> "It is conceded that Heacock Company is not the manufacturer of the wares which it sells under that trademark." (p. 10, decision.)

The court obviously refers in the above state-

ment to the alleged trademark "Rogers" registered by the H. E. Heacock Co.

It is an undisputed fact that the H. E. Heacock Co. has never sold any wares under the alleged trademark "Rogers" and that the only flatware or tableware sold by it has been that of the International Silver Company and that all those wares have borne the trademarks of the latter which are registered in the United States and which trademarks of the International Silver Company have never been registered in the Philippines. To say that the trademarks of the International Silver Company "1847 Rogers Bros." and "Wm. Rogers & Son" which are registered in the United States Patent Office at Washington in that form and under which the H. E. Heacock Co. sells the wares of the International Silver Company are equivalent to or embraced in the single word "Rogers" as registered by the H. E. Heacock Co. in the Philippines is to call black white, and daylight darkness. If "1847 Rogers Bros." is not "Rogers" alone and if "Wm. Rogers & Son" is not "Rogers" alone, then for that reason the H. E. Heacock Co. did not register the trademarks of the International Silver Co. and has never sold any wares under the alleged trademark "Rogers" or, in other words, has never used that word as a trademark, and consequently under the provisions of Sections 1 and 2 of Act 666 the word "Rogers" alone was not and could not have been legally appropriated or subject to registration by

the H. E. Heacock Co. even if otherwise legally available for that purpose.

That the word "Rogers" or any other part of the trademark "1847 Rogers Bros." cannot be considered to be the same trademark as "1847 Rogers Bros." or to embrace the trademark "1847 Rogers Bros." has been expressly decided in the case of Meriden Britannia Company vs. Parker 39 Conn. 450, 12 Am. Rep. 405, in a case involving precisely one of the trademarks under which appellee sells the wares of the International Silver Co. in the Philippines. We quote from the Connecticut decision as follows:

> *"It is necessary to observe that the trade-mark, in the use of which the petitioners claim protection, is not 'Rogers Brothers', but 'Rogers Bros.', with the figures '1847', prefixed, and the letter and figure 'A 1' annexed. The combination constitutes the trademark. The mere fact that the name 'Rogers Brothers', had been previously used by other persons and corporations cannot, of itself, operate to prevent the petitioners from acquiring a right to the use of the same name as a part of their trademark. All the corporations which had a right to use that name had ceased to exist on the 7th day of November, 1862. The corporation of 'Rogers & Brother', of Waterbury, were stamping goods, 'Rogers & Brother, A 1' and 'Rogers & Bro., A 1' but such stamps differ from that of the petitioners, and the committee finds that the parties themselves regarded their respective stamps as independent trademarks.*
>
> "The reputation which attached to the Rogers goods had its origin in the skill, taste and judgment

of the three brothers. They had a right, superior to all others, to avail themselves of that reputation. Although they had, in certain instances, imparted to certain corporations the right to use their name, yet, in every instance, that right was connected with their own services and profits. Every such corporation, except the Waterbury Company, had lost or surrendered that right, by ceasing to manufacture goods. The right to the use of their own name therefore, must revert to the Rogers brothers, or we must practically deprive them, and, in some measure, the public, of all future advantage to be derived from their superior skill and industry. Policy, as well as the dictates of reason and justice, require the former. *The fallacy in the argument of the counsel for the respondent seems to be this: they assume that the petitioner's trademark is identical with a trademark adopted and used by the several partnerships and corporations preceding them.* But it is not a case of a continuing trademark, used by successive partnerships and corporations. *It is rather a question relating to the right of parties to the use of their own name as a component part of several trademarks, used respectively by partnerships and corporations with which they are connected.* Viewed in that light, we see no difficulty in allowing these parties to use their own names freely, except as their right to do so is limited by their obligations to the Waterbury company. That corporation only acquired the right from two of the brothers to use the name 'Rogers & Brother', and 'Rogers & Bro.' That right continues and is entitled to protection as against the parties from whom was acquired, and others claiming under them. But they do not complain; on the contrary, the circumstances are such that both they and the petitioners are satisfied; and we do not see that the respondent has any cause of complaint, [illegible] to derive any advantage from the fact that

the trademarks of the two parties resemble each other. We are satisfied, therefore, that the Messrs. Rogers had, as against the respondents, a right to the use of their own names, and might, under certain legal restrictions, impart that right to the petitioners." (Meriden Britannia Company vs. Parker, 12 Am. Rep. 405-406; italics ours.)

Counsel for appellee and this Honorable Court in assuming that the alleged trademark "Rogers" is identical with and embraces the trademarks of the International Silver Co. "1847 Rogers Bros." and "William Rogers & Son" has adopted precisely the same fallacy with reference to the same trademark.

XI.

The court erred in failing to find that the registration in the Philippines of the alleged trade-mark "Rogers" was and is a nullity first, because it was never applied to any wares previous to its registration and second, because it was never used after its registration.

It is an undisputed fact recognized in the decision of this court that the alleged trademark "Rogers" alone as registered in the Philippines has never been applied to any wares and that the only trademarks applied to the wares of the International Silver Co. sold by the H. E. Heacock Co. are "1847 Rogers Bros." and "Wm. Rogers & Son", the United States trademarks of said International Silver Company.

We have shown under other assignments of error supported particularly by the decision of the

Supreme Court of Connecticut in the case of "Meriden Britannia Company *vs.* Parker" (12 Am. Rep., 405) that the word "Rogers" or "Rogers Bros." as trademarks are entirely distinct from the trademark "1847 Rogers Bros." and therefore it follows that the alleged trademark of appellee "Rogers" has never been applied to or used on any merchandise in the Philippines.

We quote from Ruling Case Law on the subject of "Trademarks, Tradenames, etc." as follows:

> "15. APPLICATION OF MARK.—The mere declaration of a person, however long and extensively published, that he claims property in a word or device as a trademark does not make it his property. It must have a practical existence, and in the strict sense of the term it is applicable only to a vendible article on which it is in some manner affixed or represented as a symbol to indicate the origin or ownership of the article on which it is placed. It may, however, be put either on the article itself, or its case, covering or wrapper." (26 R. C. L., Sec. 15, p. 842.)
>
> (See also numerous decisions of the Supreme Court of the United States and Federal Courts cited under footnotes.)

The alleged trademark "Rogers" never having been applied to or used on any wares it can not be said to have been abandoned. Nevertheless, its nonuser would have constituted "abandonment" if its use or application had ever begun.

See 26 R. C. L., pp. 909-910.

See also 38 Cyc., 879, under the heading "abandonment and non-user."

We quote from Cyc. under the heading "Trademarks, tradenames, etc." as follows:

"2. ACTUAL USE NECESSARY.—A trademark right can be acquired only by actual use of the word or mark in the manner that trade-marks must be used. The goods with the mark must be placed upon the market. Mere adoption with intent to use in the future will not creat trademark." (38 Cyc., 691.)

XII.

The court erred in failing to find that the action of the appellee is prohibited by Section 4 of Act 666 of the Philippine Legislature.

Section 4 of Act 666 provides:

"Sec. 4. No action shall be brought for damages for the violation of the rights to use trademarks defined in the preceding sections nor shall criminal proceedings be entertained as provided in section 6 of this Act, unless it be first shown that the trademark or tradename alleged to have been violated or which gave rise to the criminal action has been duly registered in the Bureau of Commerce and Industry, in accordance with the provisions of this Act. (As amended by Act No. 3332, sec. 1.)"

It is alleged by appellee that the trademark violated by appellants in the sale of the wares of Wm. A. Rogers, Ltd. was the alleged trademark "Rogers" registered by appellee in its own name in the Bureau of Commerce and Industry of the Philippines in 1918, but the proofs show and it is an admitted and undisputed fact as recited by the decision

of this Honorable Court that the only trademarks under which appellee sold its flat wares in the Philippines were the trademarks of the International Silver Co. known as "1847 Rogers Bros." and "Wm. Rogers & Son", which were registered in the United States Patent Office at Washington but have never been registered in the Bureau of Commerce and Industry of the Philippines as required by Section 4 of Act 666.

Section 4 of Act 666 requires that the particular trademark claimed to have been violated must be first registered as a condition precedent for the maintenance of such an action as that of appellee against appellants.

It is true that an action for unfair business competition may lie without the registration of any trademark by the complainant but such complainant cannot recover for alleged unfair business competition with its wares sold under the alleged trademark "Rogers" upon proof of competition with its wares sold under the trademarks "1847 Rogers Bros." and "Wm. Rogers & Son".

Unless the alleged trademark "Rogers" is the identical trademark affixed to the wares of the International Silver Co. which have been and are being sold by the appellee in the Philippines, that is to say, if the alleged trademark "Rogers" is not the identical trademark "1847 Rogers Bros." and is not

the identical trademark "Wm. Rogers & Son" then the registration by the appellee of the word "Rogers" alone is not a compliance with the requirements of Section 4 of Act 666 "that the trademark alleged to have been violated" be registered as a condition precedent to the bringing of the action. It is true that appellee did allege that the trademark violated was the alleged trademark "Rogers" but it now admits and this court finds that the only trademarks affixed to the flatware and tableware sold by the appellee in the Philippines were the United States trademarks of the International Silver Co. Therefore, it is an undisputed fact that the only trademarks if any violated by the sale of the wares of Wm. A. Rogers, Ltd. were the trademarks "1847 Rogers Bros." and "Wm. Rogers & Son".

The finding of this court that the appellee registered the trademark "Rogers" for the use and benefit of the International Silver Co. and that the word "Rogers" is the essential part of all the trademarks containing the word "Rogers" even if correct, does not make that alleged trademark "Rogers" of Philippine registration under the name of appellee the same trademark as "1847 Rogers Bros.", or the same trademark as "Wm. Rogers & Son". "Rogers" cannot be said to include "1847" or "Bros.", nor can it be said to identify "William" nor to include William's "Son". We made this point in mild, but as we thought convincing language in our argu-

ment and briefs before this Honorable Court, but in view of the fact that we failed to elicit the slightest response in the decision we conclude that it was overlooked for lack of sufficient emphasis. The doctrine of the court, if we understand it, is that A, after registering one trademark in his own name, may sell wares under a different trademark of B, and if C enters the field and competes with A in the the sale of such wares A may recover against C for the violation of A's unused trademark although he have no cause of action for the violation of the trademarks (of B) affixed to the wares sold by him.

XIII.

The court erred in assuming and finding in effect that the sworn declaration of the applicant for registration of a trademark required under Sections 12 and 19 of Act 666 to the effect that "no other person, firm or corporation has the right to the use of the trademarks sought to be registered," is limited to persons, firms or corporations in the Philippines and does not apply to persons, firms or corporations whose trademarks are registered only in the United States.

This assignment requires no argument to support it. The language used in Sections 12 and 19 is general and by no rule of interpretation can be held to refer exclusively to persons, firms or corporations in the Philippines. Any such interpretation would amount to a license to residents of the Philippines to pirate all the trademarks registered in the United States.

XIV.

The court erred in the following conclusion: "If in June, 1918, when the Heacock Company applied for the registration of the word 'Rogers', the Wm. A. Rogers, Ltd. had then been in the field with its wares, another and a very different question would be presented" (p. 17, decision).

We beg to differ with the Honorable Court upon the foregoing conclusion. If in June, 1918, the appellant Wm. A. Rogers, Ltd. would have had the right to sell wares bearing its legitimate trademarks, it has that same right now or at any other time during the life of its trademarks. The life of any trademark registered in the United States is twenty years subject to renewals of twenty years each as often as desired in accordance with Section 12 of the Act of Congress of February 20, 1905.

The last renewal of the registration of the trademarks of Wm. A. Rogers, Ltd. in the United States Patent Office at Washington was in the year 1917 as per paragraph 3 of the complaint in the case of "Wm. A. Rogers, Ltd., et al, *vs.* H. E. Heacock Co." (p. 3, B. E. G. R. No. 31852) which is recited by the decision of this Honorable Court to be true (p. 10, decision). We shall not inquire whether this Honorable Court intended to judicially amend Section 20 of the United States Trademark Laws although the decision would have that effect according to our version of the law. The court's distinction between the rights of the appellant Wm. A. Ro-

gers, Ltd., had it entered the Philippine market in 1918 and its right in 1924 or 1925 when it did enter the market, is obviously based upon the theory that the appellee built up a business reputation for the wares of the International Silver Co. subsequent to the year 1918, and having in that year registered the word "Rogers" as its trademark for the use and benefit of the International Silver Company, it became entitled, by virtue of its priority in entering the market and by virtue of its priority in registering the word "Rogers" as a trademark, to exclude from the Philippine market the wares of all other Rogers concerns bearing trademarks containing the word "Rogers". But why we ask, does such exclusive right flow from priority in the Philippine market and priority of registration of the word "Rogers" in the Philippines if it is not by reason of the expiration of some prescriptive period?

It must be assumed by the court for the purpose of this phase of its decision that the registration and use of the respective trademarks of Wm. A. Rogers, Ltd., and of the International Silver Company in competition with each other in the sale of their wares under such trademarks in the United States and the final decisions of the Court of Appeals of the District of Columbia and the Federal decisions already quoted have definitely settled the proposition that the trademarks of Wm. A. Rogers, Ltd. were not an infringement upon the trademarks of

the International Silver Company and its predecessors and that the sales under the trademarks of the latter did not constitute unfair business competition.

If Wm. A. Rogers, Ltd. would have had the right to enter the Philippine market with its wares in the year 1918 or earlier, why had it not the right to enter the Philippine market at any later date during the renewal period of twenty years from 1917? If its trademarks would not have been an infringement of the trademarks of the International Silver Co. and the sale of its wares under those trademarks in the Philippines would not have constituted unfair business competition in the year 1918 or earlier, why has the use of these trademarks from the year 1924 up to the present time constituted an infringement of the trademarks of the International Silver Co. and why has the sale of the wares of Wm. A. Rogers, Ltd. under the same trademarks in the Philippine market from the year 1924 to the present time constituted unfair business competition with the sale of the wares of the International Silver Co. in the Philippines unless by virtue of some prescriptive period? In other words, if the trademarks of Wm. A. Rogers, Ltd. were not an infringement on the trademarks of the International Silver Co. in the year 1918 or earlier, how and why did the same trademarks of Wm. A. Rogers, Ltd. become an infringement of the same trademarks of the International Silver Co. at a later date, and if the sale of

its wares by Wm. A. Rogers, Ltd. under its United States trademarks in the Philippine market in 1918 or earlier in competition with the wares of the International Silver Company under its United States trademarks would not have constituted unfair business competition, why has the sale of the same wares of Wm. A. Rogers, Ltd. under those trademarks in competition with the same wares of the International Silver Company under its trademarks at a later period amounted to unfair business competition?

Is it seriously contended by the court that mere priority of the International Silver Co. in entering the Philippine market through the H. E. Heacock Co. with its Rogers wares gives it a monopoly of such market as against Wm. A. Rogers, Ltd., and all the other Rogers competitors in the United States? And if such priority confers such monopoly, how many years of such priority are required for the purpose? If ten or twelve years priority are enough to confer the monopoly, why isn't one year, one month or one day enough?

We conclude that the only logical foundation for the decision of the court is that the registration in 1918 by the appellee H. E. Heacock Co. of the word "Rogers" in its own name as its own trademark in the Philippines, whether for its own use and benefit or for the use and benefit of the International Silver Company, conferred on it, the appellee, then and there the exclusive right to sell wares under the word "Rogers" as a trademark or under any com-

bination of words or symbols containing the word "Rogers" as a trademark, and then and there debarred Wm. A. Rogers, Ltd. and all the other numerous independent Rogers concerns from entering the Philippine market. If that in reality is the basis of the court's decision all of its other findings and conclusions are wholly superfluous and its decision after the statement of facts should not have occupied more than one page at the outside.

XV.

The court erred in assuming and holding in effect that appellants were guilty of unfair business competition solely by dressing the wares of Wm. A. Rogers, Ltd. in their legitimate trademarks registered in the United States Patent Office at Washington, and that such unfair business competition continued even after such trademarks were duly registered in the Bureau of Commerce and Industry of the Philippine Islands.

Section 7 of Act 666 as amended by Act 3423 of the Philippine Legislature contains the usual definition of unfair business competition and concludes with the following provisions:

" * * This section applies in cases where the deceitful appearance of the goods, misleading as to origin or ownership, is effected not by means of technical trademarks, emblems, signs, or devices, but by the general appearance of the package containing the goods, or by the devices or words thereon, even though such packages, devices, or words are not by law capable of appropriation as trademarks; and in order that the action shall lie under

this section, actual intent to deceive the public and defraud a competitor shall affirmatively appear on the part of the person sought to be made liable, but such intent may be inferred from similarity in the appearance of the goods as packed or offered for sale to those of the complaining party." (Italics ours.)

There is no evidence in the record and no finding or suggestion in the decision of this Honorable Court to the effect that there is any resemblance between the wares of Wm. A. Rogers, Ltd., and those of the International Silver Co. sold by the appellee other than the necessary resemblance between all spoons and flatware and that arising from the use of the legitimate trademarks of each concern as registered in the United States Patent Office at Washington.

It must also be remembered that unfair business competition can never be predicated on the possible confusion or deception caused by the legitimate use of a duly registered trademark and that the use by Wm. A. Rogers, Ltd. of the particular trademarks on the particular wares imported into the Philippines is legitimate for the same reason that the sale of the wares under the same trademarks in the United States is legitimate. Inasmuch as the wares of each competitor like spoons for example (each with a handle and a bowl) are necessarily practically alike in shape and general appearance, and inasmuch as no competitor can have any monopoly on such shape or general appearance, it follows that the

only clothing of the wares which could possibly create any confusion in the minds of the purchasing public would be the word "Rogers" which is the common denominator of both the trademarks of the International Silver Co. and of Wm. A. Rogers, Ltd. This being true, Wm. A. Rogers, Ltd. has the same right to use its own trademark as the H. E. Heacock Co. or the International Silver Co. has to use the trademarks of the latter. Presumably, their damage to each other by the use of the same word "Rogers" as a part of their respective trademarks is equal and the damage to one necessarily offsets that to the other.

It is perfectly clear that the provision against unfair competition is meant to apply only to cases in which the wares are dressed in something besides a legitimate trademark to make them resemble the wares of the competitor. Taking the spoons again as an example, all spoons being of the same general shape and appearance, no prospective buyer could possibly be confused by the resemblance in shape and general appearance of the wares of Wm. A. Rogers, Ltd., and those of the International Silver Co. Therefore, the only possible confusing resemblance must necessarily be confined to the legitimate trademarks of each competitor. In other words, there are no facts whatever in the case at bar to which the law of unfair competition may even remotely apply.

It is impossible to determine what the basis of the court's decision is, but if it means to assume that the purchasers of the wares of Wm. A. Rogers, Ltd. were deceived into believing that they were the wares of the International Silver Co. sold by appellee, such an assumption is absolutely incompatible with the undisputed proofs that ninety-five per cent of the sales of the American Trading Co. were by indent orders which were filled and shipped by Wm. A. Rogers, Ltd. from its factory to the customers (p. 94, transcript).

It further appears from the above quoted section 7 of Act 666 of the Philippine Commission as amended that in order to be guilty of unfair competition the person who manufactures or sells the wares must clothe them with an appearance resembling the wares of the competitor for the purpose of deceiving the public and defrauding the competitor. It goes without saying that Wm. A. Rogers, Ltd., in clothing its wares with its own legitimate registered trademark without any other device to make them resemble the wares of the International Silver Company cannot be held to have done so for the purpose of deceiving the public or defrauding H. E. Heacock Co. as the dealer in the wares of the International Silver Co. and the same must be held to be true with reference to the selling by the American Trading Co. in the Philippines of the wares of Wm. A. Rogers, Ltd. under the same registered trademarks.

Aside from the fact that the claim of unfair competition made by the H. E. Heacock Co. is based upon its illegal registration of the word "Rogers" which has never been used upon any of the wares sold by it, the whole foundation of such alleged unfair competition must give way to the undisputed fact as previously stated that the wares of Wm. A. Rogers, Ltd., handled by the American Trading Co., in the Philippine Islands in competition with the wares of the International Silver Co., handled by the H. E. Heacock Co., are the same wares bearing the same trademarks which are manufactured and sold by Wm. A. Rogers, Ltd. in the United States in competition with the same wares under the same trademarks of the International Silver Co. which are now being sold by appellee in the Philippines. Upon what theory or by what system of reasoning can it be successfully maintained that the International Silver Co. is entitled to any more favorable consideration and treatment by the courts with reference to its business competition with Wm. A. Rogers, Ltd. in the sale of their respective wares in the Philippines than in the United States in the sale of the same wares under the same trademarks? Certainly, the appellee cannot claim any greater rights in the sale of the wares of the International Silver Co. in the Philippines than the latter itself would be entitled to claim were it defending its own trademarks directly instead of through the appellee as the importer of its wares.

The right to the exclusive use in the United States of the respective trademarks of Wm. A. Rogers, Ltd. and its predecessors and of those of the International Silver Co. and its predecessors have been finally determined by registration in the United States and by decisions of the Courts of the District of Columbia in contested patent appeals and by the following decisions of the Federal Courts of the United States and of the Appellate Court of the District of Columbia:

Rogers v. Wm. Rogers Mfg. Co., 70 Fed. 1019; Wm. Rogers Mfg. Co. v. Rogers, 84 Fed. 639; Wm. A. Rogers, Ltd. v. Rogers Silverware Redemption Bureau Inc. (1917), 247 Fed. 178; Wm. A. Rogers, Ltd. v. Cohannet Silver Co., 186 Fed. 241; Wm. A. Rogers, Ltd. v. H. O. Rogers Silver Co., 237 Fed. 887; Wm. A. Rogers, Ltd. v. International Silver Co., 34 App. D. C. 410; Wm. A. Rogers, Ltd. v. International Silver Co., 34 App. D. C. 413; Wm. A. Rogers, Ltd. v. International Silver Co., 34 App. D. C. 484; Wm. A. Rogers Ltd. v. International Silver Co., 30 App. D. C. 97.

The foregoing decisions having definitely and finally settled the right of Wm. A. Rogers, Ltd., and its predecessors and of the International Silver Co., and its predecessors to the exclusive use of their respective trademarks, all other jurisprudence on the subject of trademarks may be said to be superfluous and academic.

Inasmuch as the right to the exclusive use in the

United States of the trademarks of Wm. A. Rogers, Ltd. as established by the registration thereof and by the decisions above mentioned carries with it the right to use the same trademarks in the Philippine Islands, it makes no difference which of the two competing concerns, Wm. A. Rogers, Ltd., or the International Silver Co., first introduced its wares into the Philippine Islands or in other words first began to establish a reputation for Rogers' wares. The fact that the International Silver Co. through the H. E. Heacock Co. saw fit to begin selling its wares under its registered trademarks in the Philippine Islands before Wm. A. Rogers, Ltd. saw fit to begin selling its wares under its registered trademarks through the American Trading Co. cannot, under the law, have the slightest effect upon the rights of Wm. A. Rogers, Ltd., or of the American Trading Co.

It is fairly deducible from the testimony of Mr. Gaches heretofore quoted that the H. E. Heacock Co. from the time it began selling the wares of the International Silver Co. had actual knowledge of the registration of the trademarks heretofore described of Wm. A. Rogers, Ltd. in the United States and of its exclusive right to the use of the same on the wares subsequently imported by the American Trading Co., but without reference to such actual knowledge on the part of the H. E. Heacock Co., there can be no doubt about the actual knowledge of

the International Silver Co., with reference to the rights of Wm. A. Rogers, Ltd., with which it and its predecessors had carried on the protracted litigation heretofore mentioned. As we have pointed out the H. E. Heacock Co. cannot recover for a violation of the trademarks of the International Silver Co. on its allegations of a violation of its own registered trademark "Rogers", nor under any theory of the case can the H. E. Heacock Co. have any rights whatever with reference to the use of the trademarks of the International Silver Co. except as a representative of that company and as such representative it is charged with the knowledge of its principal, the International Silver Co., with reference to the rights of Wm. A. Rogers, Ltd. in the United States and as a necessary consequence in the Philippine Islands. Therefore, when the H. E. Heacock Co. began importing and selling the wares of the International Silver Co. it did so with the full knowledge and expectation that Wm. A. Rogers, Ltd. would eventually begin selling its wares under its trademarks in the Philippine Islands, and that it would have the right to do so even though the previous handling of the wares of the International Silver Co. should redound to its benefit by virtue of the trademarks of each concern containing the common denominator "Rogers".

If Wm. A. Rogers, Ltd. had entered the Philippine market with its ware through the agency of the American Trading Co. before the International Silver Co., is it claimed that that would have given

Wm. A. Rogers, Ltd. a monopoly of the Philippine market, and if so why? If priority of Wm. A. Rogers, Ltd. in the market of the Philippines would not have precluded the introduction of the wares of the International Silver Company, by what reasoning can it be contended that priority in the Philippine market of the International Silver Co. precludes the subsequent introduction of the wares of Wm. A. Rogers, Ltd.? It is a poor rule that doesn't work both ways and it would be an astounding proposition to hold that the introduction of the wares of Wm. A. Rogers, Ltd. should be precluded by reason of the previous introduction into the market of the wares of the International Silver Co. Such a holding would be contrary to public policy in that it would have a tendency to destroy competition.

Referring to the sale of the Wm. A. Rogers, Ltd. wares after the registration of its United States trademarks with the Bureau of Commerce and Industry of the Philippines in accordance with Section 11 of Act 666, it is simply incredible that this Honorable Court should have intentionally affirmed the unqualified perpetual injunction of the trial court against such sales even after such registration with the Bureau of Commerce and Industry. Whatever else may be said of such sales it is inconceivable that they would constitute unfair business competition when both the registration under the United States laws and that under the Philippine laws were equivalent to a license to sell the merchandise designated by such trademarks. Again, we are

forced to the conclusion that there can be no consistent basis for the perpetual injunction against the sale of the wares of Wm. A. Rogers, Ltd., either before or after the registration of the United States trademarks in the Philippines other than a holding that the appellee solely by virtue of the registration of the word "Rogers" with the Bureau of Commerce and Industry of the Philippines has acquired the exclusive right to the use of that word as a trademark in the Philippines, notwithstanding the fact that the word "Rogers" as thus registered has never been applied as a trademark to any wares sold by the appellee or any one else in the Philippines and notwithstanding the holding in the decisions of the United States courts to the effect that neither the International Silver Co. or its predecessors in interest, nor Wm. A. Rogers, Ltd., or its predecessors in interest, or any of the other many Rogers concerns engaged in the same business were entitled to the exclusive use of the werd "Rogers" as a trademark.

XVI.

Where the duly registered legitimate trademarks of both litigants contain the same family name or other common denominator the court has no power to enjoin the use of such name by either litigant or to go beyond regulating their use in such form as to avoid deception of the public.

The decision of this Honorable Court is ambiguous in that it fails to state whether the decision

of the trial court is affirmed on the ground of unfair business competition or because of the infringement of the trademark "Rogers" registered in the name of the appellee, or the trademarks of the International Silver Company under which appellee sells the latter's wares.

It is an undisputed fact that the wares of Wm. A. Rogers, Ltd., which were and are sold in the Philippines, are manufactured in the United States and the proofs establish by implication and the court assumes and finds in effect that the wares thus sold in the Philippines were and are the same kind of wares put up in the same manner as the wares which were and are sold in the United States in competition with the wares of the International Silver Co. In addition to the manifest assumption of these facts in the decision of the court, they are also found by implication in the holding heretofore referred to as follows:

> "If in June, 1918, when the Heacock Company applied for the registration of the word 'Rogers' the Wm. A. Rogers, Ltd. had been in the field with its wares, another and a very different question would be presented." (p. 17, decision.)

The finding by implication by the court that the sale in the Philippines of the wares of Wm. A. Rogers, Ltd. in 1918 would not have constituted unfair business competition with the wares of the International Silver Co. is a finding in effect that the wares of Wm. A. Rogers, Ltd. are not now a simulation or imitation of the wares of the Interna-

tional Silver Co., and their sale cannot, therefore, constitute unfair business competition now anymore than in 1918.

But even assuming (contrary to all the facts and circumstances) that there may have been some misleading artifices employed by the American Trading Co. in the sale of the wares in the Philippines, there would be no excuse for the unconditional perpetual injunction against the sale of the wares of Wm. A. Rogers, Ltd. under its trademarks. In all cases where colorable artifices have been found which might mislead the public the farthest the court have gone has been to regulate the sale by requiring the omission of such artifice or misleading feature. In no cases have the courts enjoined unconditionally the sale of the wares or the use of the trademarks.

In the case of Meriden Britannia Company vs. Parker, 39 Conn. 450; 12 Am. Rep. 401, 409, involving one of the identical trademarks under which appellee sells the wares of the International Silver Co., the Supreme Court of Connecticut said:

> "It only remains for us to consider the extent to which the remedy should be applied. The prayer of the petition is, that the respondent may be enjoined from using the stamp, 'C. Rogers Bros. A 1', or any stamp of which the word 'Rogers' or the words 'Rogers Bros.' shall form the whole or a part, and from selling goods so stamped, or stamped with any stamp so nearly resembling the petitioners stamp, '1847, Rogers Bros. A 1', as to be likely to

deceive purchasers. We think the petition should be granted so far as to restrain the use of the stamp specified, and also to restrain the use of the word 'Rogers Bros.' *But the use of the name 'Rogers' ought not to be prohibited.*

We cannot say that every use of that name will necessarily infringe upon the petitioners' trademark. *If it may be so used as not to infringe, it would be manifestly unjust to forbid such use by the respondent, inasmuch as his title to the mere names is as good apparently as the petitioners'. Even if the use of the name should in some degree increase the respondent's sales, and thus, at least indirectly and remotely, injure the petitioners, it is an injury to which they must submit, unless there is such resemblance to the petitioners' stamps as to induce purchasers to believe that they are purchasing the petitioners' goods. The use of a prominent name in a trade-mark will necessarily give rise to some embarrassment of this character, and those so using it must be presumed to take the risk."* (Italics ours.)

In another early Rogers case involving the Rogers trademarks and from the decision in which we have heretofore quoted the Connecticut Supreme Court adheres to the same doctrine that the use of a family name (referring to the identical word "Rogers") could not be enjoined but only regulated where its use amounted to a misrepresentation and says:

"* * * Where a person is selling goods under a particular name, and another person, not *having* that name, is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses; but

where the defendant sells goods under his own name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence, in each case, whether there is false representation or not. Considered in the ordinary course of trade, it is a contradiction of terms to say that a man selling goods under his own name sells them as the goods of another, even if that other have the same name. The cases seem to require some element of false representation other than that implied in the fair, honest, and ordinary use of a person's own name.

"An examination of the following and kindred cases, wherein the use of a person's name has been regulated, will show that in most instances conscious, intentional, fraudulent misrepresentation on the part of the defendant had been resorted to; in others, there was such a combined use of the name with other marks, characters, figures, or form, and arrangement of circulars, advertisements, etc., as to amount to a false representation, and the combination only was enjoined. No instance can be found where the use of the name only, in good faith, has been stopped. See Croft v. Day, 7 Beav. 84; Holloway v. Holloway, 13 Beav. 213; Clark v. Clark, 25 Barb. 78; Sykes v. Sykes, 3 Barn. & Co. 541; Metzler v. Wood, 8 Ch. Div. 606, 610; Fullwood v. Fullwood, 9 Ch. Div. 179; Devlin v. Devlin, 69 N. Y. 214; Landreth v. Landreth, 22 Fed. Rep. 41; Shaver v. Shaver, 54 Iowa, 213; S. C. 6 N. W. Rep. 188; Stonebraker v. Stonebraker, 33 Md. 253; Williams v. Brooks, 50 Conn. 278; Meriden Brit. Co. v. Parker, 39 Conn. 450.

"Upon the other hand, there has been, from the first to the present time, a general consensus of judicial opinion that the use of a personal name in a fair, honest, and ordinary business manner,

could not be prevented, even if damage resulted therefrom. Croft v. Day, 7 Beav. 84; Holloway v. Holloway, 13 Beav. 213; Burgess v. Burgess, 3 De Gex, M. & G. 896; Faber v. Faber, 49 Barb. 357; Clark v. Clark, 25 Barb. 80; Meneely v. Meneely, 62 N. Y. 427; Comstock v. Moore, 18 How. Pr. 424; Gilman v. Hunnewell, 122 Mass. 139; McLean v. Fleming, 96 U. S. 252; Carmichel v. Latimer, 11 R. I. 395; Landreth v. Landreth, 22 Fed. Rep. 41; Singer Manuf'g. Co. v. Loog, 18 Ch. Div. 412. Other cases and dicta might be cited, but it is deemed unnecessary." (Rogers v. Rogers, 1 Atlantic Reporter, 807, 813-814.)

XVII.

The court erred in assuming and holding in effect that the appellee, the H. E. Heacock Co., is the party injured by the transactions which are the subject of this action.

The difference between enjoining unfair business competition and stifling legitimate competition is as great as between day and night. If the decision of this court be upheld the wares of not only Wm. A. Rogers, Ltd., but those of all the other Rogers silverplated and flatware concerns whose trademarks and right to compete with the International Silver Company have been recognized and established by the Commissioner of Patents and Tribunals of Justice of the United States will be excluded from the Philippines and a most pernicious monopoly for the benefit of the International Silver Company through the H. E. Heacock Co. will be thereby created at the expense of the public.

THE MOTION FOR A NEW TRIAL

This Honorable Court is required by Section 275 of the Code of Civil Procedure to take judicial cognizance of Rule "9" for the enforcement of Act 666 which was Rule "1" in the year 1918 when the alleged trademark "Rogers" was registered by the appellee, as this court finds, for the use and benefit of the International Silver Company. A certified copy of said Rule "1" for the enforcement of Act 666 as it existed in the year 1918 is attached hereto as Appendix "B". Nevertheless, inasmuch as the trial court's attention was not called to the rule due to the fact that J. W. Ferrier, counsel for appellants in the court below, was informed by the Bureau of Commerce and Industry that the rule had not yet been promulgated in the year 1918 as set forth in the affidavit of the said J. W. Ferrier hereto attached as Appendix "C", we have deemed it expedient to make the failure to present Rule "1", now Rule "9", for the enforcement of Act 666 the subject of a motion for a new trial.

Based upon the contents of said Rule "1", a certified copy of which is attached as Appendix "B", and without compliance with which the alleged trademark "Rogers" could not have been registered for the benefit of the International Silver Company, and based likewise upon the contents of the affidavit of the said J. W. Ferrier which is attached as Appendix "C", appellants respectfully ask that a

new trial be directed in the event of the denial of their motion for rehearing.

Respectfully submitted,

J. W. FERRIER *and*
GIBBS & McDONOUGH,
By A. D. GIBBS,
Attorneys for Appellants.

Manila, P. I.
December 19, 1930.

Received copy, Dec. 19, 1930.
DEWITT, PERKINS & BRADY,
By (Sgd.) A. PONCE ENRILE,
Attorneys for Appellee.

APPENDIX "A"

THE GOVERNMENT OF THE PHILIPPINE ISLANDS
Department of Finance
BUREAU OF CUSTOMS
Manila

January 13, 1926.

Customs Administrative Order
No. 194.

Trade-marks and trade-names; Laws relative thereto and regulations governing the exclusion of imported products bearing marks or names that imitate registered trade-marks or trade-names; Customs Administrative Circular No. 730, superseded.

PARAGRAPH I. Act 666 of the Philippine Legislature, as amended by Acts numbered 744, 808,

and 2460, contains the rules and regulations of the Government of the Philippine Islands relative to property in *domestic* trade-marks and trade-names and the protection to be afforded the owners thereof, while the Act of Congress of February 20, 1905, as amended, provides for the registration and protection of trade-marks used in connection with *foreign* nations or between the Philippine Islands and the several States of the United States.

PAR. II. Act numbered 2460 (amending Act numbered 666) relative to the protection of *domestic* trade-marks states in part:—

> "No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or shall copy or simulate a trade-mark or trade-name registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the Philippine Islands, shall be admitted to entry at any customhouse of the Philippine Islands; and in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark or trade-name issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the office of the Insular Collector of Customs, under such regulations as the Insular Collector of Customs, with the approval of the Secretary of Finance, shall prescribe, and may furnish to the office of the Insular Collector of Customs a facsimile of his name, the name of the local-

ity in which his goods are manufactured, and of his registered trademark or tradename; and thereupon the Insular Collector of Customs shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs."

PAR. III. The attention of all Customs officers is especially invited to that portion of the above-quoted section which reads as follows:

> "No article of imported merchandise which * * * shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the Philippine Islands shall be admitted to entry at any customhouse of the Philippine Islands."

and they are directed to use due diligence to prevent violations of this provision.

PAR. IV. Manufacturers, merchants, traders, or others, who desire to exclude from the Philippine Islands, under the provisions of section 1 of Act numbered 2460, imported products which bear a trade-name or trademark that is an infringement of their domestic trade-mark or trade-name, will be required to furnish the following information relative to such trade-marks or trade-names:

Name of owner;
Residence of owner;
Locality in which goods are manufactured;
Certified copy of the certificate of registration of the trade-mark or trade-name in the Division of Archives, Bureau of Commerce and Industry;

Nine facsimiles of the trade-mark or trade-name.

PAR. V. Any domestic manufacturer or trader and any foreign manufacturer or trader who is entitled under the provisions of a Treaty, Convention, Declaration, or Agreement, between the United States and any foreign country, to the advantages afforded by law to citizens of the United States in respect to trade-marks and commercial names, may, in order to protect a trade-mark or trade-name used in foreign commerce; i. e., between the Philippine Islands and foreign countries, or with the several States of the United States; register such trade-mark or trade-name and receive the protection contemplated in section 27 of the Act of Congress of February 20, 1905, by furnishing the following information to the Insular Collector of Customs, Port of Manila:

Name of owner;
Residence of owner;
Locality in which goods are manufactured;
Certified copy of the certificate of registration of trade-mark or trade-name in the United States Patent Office, Washington, D. C.;
Nine facsimiles of the trade-name, the name of the locality in which the goods are manufactured, or of the registered trade-mark.

PAR. VI. All applications for the recording of domestic or foreign trade-marks or trade-names shall be made to the Insular Collector of Customs, who, upon compliance with the conditions outlined in Paragraphs IV and V hereof, shall cause the

trade-mark or trade-name in question to be recorded in a book to be kept for that purpose in the office of the Appraiser of the Port. Collectors of Customs at sub-ports of entry will be furnished with copies of the facsimiles and statements of recorded trade-marks and trade-names, and shall file the same in their respective offices.

PAR. VII. Customs Administrative Circular No. 730 is hereby superseded.

V. ALDANESE,
Insular Collector of Customs.

APPROVED:

MIGUEL UNSON,
Acting Secretary of Finance.
10-3-29.
GS

Manila, P. I., Dec. 4th, 1930.

I hereby certify that the foregoing document consisting of three pages is a full, true, and correct copy of the original on file in the Manila Customhouse of which original I am the legal custodian.

V. ALDANESE,
Insular Collector of Customs.

APPENDIX "B"

THE GOVERNMENT OF THE PHILIPPINE ISLANDS
Department of Commerce and Communications
BUREAU OF COMMERCE AND INDUSTRY
Mercantile Register

TO ALL PERSONS TO WHOM THESE PRESENTS MAY COME, GREETING:

This is to certify that the annexed is a true copy

from the records of the MERCANTILE REGISTER, BUREAU OF COMMERCE AND INDUSTRY,

Of Rule 1 of the Rules issued on August 31, 1906, by the Chief of Division of Archives, Patents and Copyrights and Trademarks, pursuant to section 20 of Act No. 666, enacted March 6, 1903, governing the registration of trademarks and tradenames.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of the MERCANTILE REGISTER, BUREAU OF COMMERCE AND INDUSTRY, to be affixed at the City of Manila, this tenth day of December in the year of our Lord one thousand nine hundred and thirty.

(Sgd.) TOMAS CONFESOR,
Director.

(SEAL)
(1-20c doc. stamp)

RULES ISSUED PURSUANT TO SECTION 20 OF ACT No, 666, ENACTED MARCH 6, 1903, GOVERNING THE REGISTRATION OF TRADE-MARKS AND TRADE-NAMES

1. Any person, firm, or corporation desiring to register a trade-mark or trade-name for his or its exclusive use shall make application therefor in writing to the Chief of the Division of Archives, Patents, Copyrights and Trade-marks, who will note on the margin thereof the day, hour, and minute when the same was filed.

Any importer desiring to register the mark of the articles imported by him may do so either in

the name of the owner of the mark, or in his own name; in the latter case he shall be required to file in the Division of Archives, Patents, Copyrights, and Trade-marks with the application, description and affidavit, a document, duly executed and signed by the owner of the mark, authorizing such importer to register the mark in the latter's name.

APPENDIX "C"

UNITED STATES OF AMERICA

In the Supreme Court of the Philippine Islands

H. E. HEACOCK CO.,
Plaintiff and Appellee,

vs.

AMERICAN TRADING COMPANY,
Defendant and Appellant,

G. R. No. 31851

WM. A. ROGERS, LTD., a corporation and AMERICAN TRADING COMPANY, a corporation,
Plaintiffs and Appellants,

vs.

H. E. HEACOCK CO., a corporation,
Defendant and Appellee.

G. R. No. 31852

UNITED STATES OF AMERICA
PHILIPPINE ISLANDS
CITY OF MANILA
ss.:

AFFIDAVIT

J. W. FERRIER, being first duly sworn deposes and says that he was the attorney for appel-

lants in the Court below and is one of the attorneys for the appellants before this Honorable Court; that during the trial of the above entitled cases in the Court of First Instance he made diligent search and investigation in the Bureau of Commerce and Industry to ascertain whether Rule 9 for the enforcement of Act 666 as published by said Bureau in pamphlet form in the year 1927, was in force in the year 1918 and was informed by two different employees of the Law Division of said Bureau on two different occasions when he went there for the purpose of inquiring regarding said rule that it was not in force until the year 1922; that upon receiving such information affiant was misled into failing to make any further investigation upon the subject and thereupon assumed that no such rule was in existence in 1918 and failed to call the Court's attention thereto; that affiant did not learn of the existence of the Rules issued on August 31, 1906, by the Chief of the Division of Archives, Patents, Copyrights and Trademarks, which were in force in 1918, until after the Supreme Court had rendered its decision in the above entitled appeals; that affiant could not by the exercise of due diligence have discovered that said Rule 9, which is the same as Par. 2, Rule 1 of the Rules issued in 1906, was in force in the year 1918, and that said newly discovered evidence is of such character as probably to change the result of this case.

(Sgd.) J. W. FERRIER.

Subscribed and sworn to before me this 17th day of December, 1930, affiant exhibiting to me his cedula, No. F-2497670 issued at Pasay, on the 9th day of January, 1930.

(Sgd.) ROMAN OZAETA,
Notary Public.

My commission expires Dec. 31, 1930.

Doc. No. 112
Page No. 51
Book No. IV
Not. Reg. 1930.

(EE)

On January 16, 1931, counsel for the appellants filed the following supplemental argument in support of first, second and third assignments of error of motion for rehearing:

(HEADING AND TITLES OMITTED)

SUPPLEMENTAL ARGUMENT IN SUPPORT OF FIRST, SECOND AND THIRD ASSIGNMENTS OF ERROR OF MOTION FOR REHEARING

Come now appellants and by leave of court first obtained hereby supplement their argument in support of the first, second and third assignments of error of their motion for a rehearing by the following:

The decision in this case, by failing to apply the United States trademark laws and by denying validity in the Philippines of trademarks registered under the United States trademark laws and subsequently duly registered in the Philippines, is in violation of the Act of Congress of August 29, 1916, c. 416, sec. 10 (Sec. 1042, United States Code Annotated) which among other things provides:

> "While this chapter provides that the Philippine Government shall have the authority to enact a tariff law *the trade relations between the Islands and the United States shall continue to be governed exclusively by laws of the Congress of the United States.*" (Italics ours.)

There can be no doubt about the fact that the importation of merchandise from the United States into the Philippines for sale in the latter country and vice versa constitute the trade relations between the Islands and the United States, and that any

restriction or interference with such importation on account of trademarks or for any other reason comes within the purview of the above quoted provision of the Jones bill.

It was precisely in recognition of the validity and force and effect of the United States trademarks and trade mark laws in the Philippines that the proviso was appended to Section 14 of Act 666. The pertinent part of Section 14 with the qualifying proviso is as follows:

> "Sec. 14. No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or shall copy or simulate a trademark or tradename registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the Philippine Islands, shall be admitted to entry at any custom house of the Philippine Islands; * * *; *Provided, however, That this section shall not be construed to affect rights that any person may have acquired by virtue of having registered a trademark under the laws of the United States.*" (Italics ours.)

The holding of this Honorable Court that the registration of the word "Rogers" by the H. E. Heacock Company under the trademark laws of the Philippines deprives the appellant, Wm. A. Rogers, Ltd., of the right to import and sell wares in the Philippines bearing its trademarks registered under the United States trademark laws long prior to the H. E. Heacock Company's registration and subse-

quently again registered in the Philippines under Section 11 of Act 666 is in open and flagrant violation of both the letter and spirit of the above quoted proviso of Section 14 of Act 666. It is also clearly in violation of Section 10, c. 416, of the Jones bill (Act of Congress of August 29, 1916) above quoted because it seeks to deprive appellant of the right to ship its wares from the United States to the Philippines and to sell them under its United States trademarks, thereby interfering with the trade relations between the Islands and the United States.

While it would seem that the provisions of the United States trademark laws and of Section 14 of Act 666 are too clear to give rise to any question, nevertheless our interpretation is reinforced by an opinion of the Attorney-General of the Philippines rendered to the Director of the Bureau of Commerce and Industry on the 26th of February, 1925, from which we quote as follows:

> "The Philippines and the United States are not foreign to each other (Diamond Rings case, 188 U. S. 176, 46 L. Ed. 138). The goods or articles of either country are not considered foreign to each other. It follows that United States trademarks should not be considered foreign under Act No. 666. In fact we find no provision of this law which implies otherwise. On the contrary section 11 thereof provides that owners of trade-marks or trade-names domiciled in any foreign country which by treaty, convention, or law affords similar privileges to the *trade-marks of citizens of the United States and of the Philippine Islands* may

obtain registration of their trade-marks or trade-names in this country, thus showing that United States trademarks and Philippine trade-marks are not considered foreign to each other."

All trademarks must be classified as either foreign or domestic. In as much as trademarks of United States registration as correctly held by the Attorney-General cannot be considered foreign trademarks they must be classified and treated as domestic trademarks, that is to say, on the same footing as trademarks of Philippine registration. The only exception to this equality in footing in the Philippines of trademarks of United States registration with trademarks of Philippine registration is that the former must be registered in the Philippines as a condition precedent to bringing the actions mentioned in Section 4 of Act 666.

All the foregoing is but another way of stating that the rights guaranteed by the registration of trademarks in any country are co-extensive with the sovereignity of that country (38 Cyc. 688) and which principle is sufficient in this case without invoking the still more inclusive doctrine laid down by this Honorable Court in the case of Western Equipment & Supply Co. et al *v.* Reyes, 51 Phil. 116, to the effect that "a trademark does not acknowledge any territorial boundaries".

For further conclusive authority for our contention that the trademark laws of the United States

embraced in the Act of Congress of February 20, 1905, are applicable to the Philippine Islands, we cite Volume 27 Opinions of the Attorney-General of the United States, pp. 623-624; Volume 32, p. 258 of the Opinions of the Attorney-General of the United States holding the 18th Amendment applicable to the Islands and Opinion of the Chief of Bureau of Insular Affairs of March 7, 1917. We have been unable as yet to find a copy of this last mentioned opinion but are informed by cable from counsel for Appellant, Wm. A. Rogers, Ltd., in the United States that it holds the Act of Congress of 1905 to be applicable to commerce between the United States and the Islands. We are searching for a copy of this opinion of the Chief of the Bureau of Insular Affairs and respectfully reserve the right to present it when obtained. The opinion of the Attorney-General of the United States of September 24, 1909, is so conclusive as to the applicability to the Islands of the trademark Act of Congress of February 20, 1905, that for the convenience of the court we set it out in full as follows:

"REGISTRATION OF TRADE-MARKS—RESIDENTS OF PHILIPPINE ISLANDS

Residents of the Philippine Islands have the right, under the act of February 20, 1905 (33 Stat. 724), to avail themselves of the provisions of the trademark law of the United States.

DEPARTMENT OF JUSTICE,
September 24, 1909.

SIR: Your communication of September 20, 1909, in which you request an opinion as to whether a

resident of the Philippine Islands has the right to register a trade-mark in the Patent Office of the United States, was received, and I have the honor to reply:

The act of March 3, 1881 (21 Stat. 502), provided, with reference to the residence of those entitled to the registration of trademarks, that they should 'be domiciled in the United States, or located in any foreign country or tribes (territory) which by treaty, convention, or law affords similar privileges to citizens of the United States'. Attorney-General Knox held that under this provision a resident of the Philippine Islands was not entitled to the privileges of the trade-mark law, because those islands were not a part of the United States. (23 Op. 634, 636.) But in the trade-mark act of February 20, 1905 (33 Stat. 724), this provision as to residence was so changed as to make it sufficient that the owner 'be domiciled within the territory of the United States.'

Unquestionably the Philippine Islands, though not an organized Territory of the United States, yet constitute 'territory of the United States'. (*Dorr v. United States*, 195 U. S. 138.) But if there were otherwise any doubt upon this question, it would be set at rest by the twenty-ninth section of the said act of 1905, which provides:

'That in construing this act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof. The United States includes and embraces all territory which is under the jurisdiction and control of the United States,'

thus unequivocally declaring the purpose of Congress to bring within the provisions of the act all territory belonging to the United States, whether

embraced within a State or organized Territory or not.

I am therefore of the opinion that a resident of the Philippine Islands has the right to avail himself of the privileges of the trade-mark law.

Very respectfully,
LLOYD W. BOWERS,
Acting Attorney-General

THE SECRETARY OF THE INTERIOR."
(Opinions of Attorney-General, Vol. 27, pp. 623-624.)

Bearing in mind that the Act of Congress of February 20, 1905, applies to the Islands, then the registration of the word "Rogers" alone by the appellee is void for many reasons, among which may be mentioned the previous registration in the United States of the trademarks of Wm. A. Rogers, Ltd., and the prohibition in Section 5 of Act of Congress of February 20, 1905, against the registration of a family name unaccompanied by distinguishing marks or symbols.

Moreover, we presume counsel for appellee will concede that the application to the case of the said Act of Congress renders the decision of this Honorable Court wholly untenable for about all the reasons that could apply to any trademark or unfair business competition case.

Respectfully submitted,

J. W. FERRIER and
GIBBS & McDONOUGH,
By A. D. GIBBS,
Attorneys for Appellants.

Manila, P. I.,
January 16, 1931.

(FF)

On February 19, 1931, counsel for the appellants filed the following Additional Affidavits and Citations in Support of Application For Rehearing and Motion for New Trial:

(HEADING AND TITLE OMITTED)

ADDITIONAL AFFIDAVITS AND CITATIONS IN SUPPORT OF APPLICATION FOR REHEARING AND MOTION FOR NEW TRIAL

COME now the appellants and respectfully move the Court for permission to file in further support of their application for a rehearing and motion for a new trial the following affidavits and citations just received by mail from Counsel in the United States of the appellant Wm. A. Rogers Ltd. and which were not available for presentation at the time of the filing of the original application for rehearing and motion for a new trial nor at the time of the filing of the supplemental argument in support of the first, second and third assignments of error:

1.—Affidavit of Harold H. Elmendorf, Manager of the Planning and Production Department of Wm. A. Rogers Ltd. at Niagara Falls, New York.

2.—Affidavit of James R. Hagen, Superintendent of the factory of Wm. A. Rogers, Ltd. at Niagara Falls, New York.

3.—Affidavit of Alexis W. Bearce, Assistant Manager of the Niagara Falls, New York factory of Wm. A. Rogers, Ltd.

4.—Opinion of the Chief of the Bureau of Insular Affairs of March 7, 1927 as to the applicability to the Philippines of the Act of Congress of February 20, 1905 and the right to present which upon receiving it we asked leave to reserve in our supplemental argument (p. 6).

In support of our motion to have these affidavits and authorities considered notwithstanding the delay in their presentation, we advance the following reasons:

(a) The distance of the home offices and factory of the appellant Wm. A. Rogers Ltd. from the Philippines and the unavoidable delays in correspondence.

(b) There was no question raised before the trial court nor on appeal by the H. E. Heacock Co. as to the wares of the Wm. A. Rogers Ltd. imported into the Philippines being marked or put up in any different manner than the wares of Wm. A. Rogers Ltd. sold in the United States in competition with the same wares of the International Silver Co. which have been sold by the H. E. Heacock in the Philippines and, therefore, counsel for appellants in the trial court had no reason to suppose that proof of the facts set forth in the affidavits presented here-

with would be required to refute the allegations of unfair business competition.

(c) That the affirmance by this Honorable Court of the decision of the trial court finding appellants guilty of unfair business competition, notwithstanding the assumption on the part of this Honorable Court that the wares sold by the American Trading Co. in the Philippines were the same as those sold by Wm. A. Rogers Ltd. in the United States in competition with the wares of the International Silver Co., makes material for the first time the question of whether or not the wares thus sold in the Philippines were packed and put up in the same form and manner as those sold in the United States; that the appellants could not with reasonable diligence have anticipated the decision of the Court holding them guilty of unfair business competition; that the decision of the trial court took appellants entirely by surprise; that the accompanying affidavits were obtained at the earliest possible moment after the decision of this Honorable Court; that should this Honorable Court be of the opinion that the pleadings sufficiently advised appellants of the necessity of proving by deposition in court below the facts embraced in the accompanying affidavits then appellants respectfully represent that the failure to take such depositions was due to the inadvertence and excusable oversight and omission of their counsel in the court below from

which as a matter of equity they should be relieved upon such terms as the court may see fit to impose.

For further authority to the effect that the Act of Congress of February 20, 1905 is applicable to and enforceable in the Philippines, see the opinion of the Solicitor General of the Philippines of August 28, 1908 in which all previous legislation and regulations for the registration and protection of trademarks in the Philippines is reviewed at length.

Assuming that the Act of Congress of February 20, 1905 applies to the Philippines as shown by the various opinions of the Attorney General of the United States and of the Philippines, the following additional arguments are presented to nullify the Heacock registration:

(1) Registration under the Philippines Trademark law would be even more subordinated to the trademark laws of the United States than registration in any State of the Union which has a State registration law for the reason that the legislature of these Islands is but an agent of the Congress of the United States in so far as its laws require the approval of Congress. Act 666 of the Philippine Legislature was passed in 1903. The Act of Congress of February 20, 1905 as subsequent legislation would, if in conflict with the Philippines Act, amend it to the extent of such conflict. In the Philippines Act 666 of its legislature and the Act of Congress

of February 20, 1905 are and must be treated as the Acts of the same sovereignity.

(2) The testimony indicated that Heacock had registered Rogers as "Trustee" for International Silver Company. The International Silver Company has no registration in the United States of the word Rogers (simpliciter). All of the registrations of the International Silver Company in the United States which include the word Rogers have associated therewith additional matter clearly indicating that the symbols are part of the trademarks and not merely indicative of quality. Heacock knew of these registrations and therefore, know or should have known that International had no rights in Rogers (simpliciter). Therefore, it did not act in good faith when it registered Rogers alone. In this connection see the case of Ubeda vs. Zialcita 226 U. S. 452 or 57, L. ed., 296 and the case below in 13 Phil. Rep. 11, February 17, 1909.

(3) Another question presented is that of discrimination under Act 666, as interpreted by this Honorable Court, against Interstate Commerce. "Commerce with foreign nations and among the several states" includes the right not merely to bring the goods into the State or Territory but likewise to sell them there. This is established by decisions of the United States Supreme Court. In tax cases it has been held that while property may become subject to local taxation as soon as it has

"come to rest" within the State or Territory such taxes may not be discriminatory, may not be levied against such property simply *because* it has been brought into the State or Territory and there can be no prohibition of its further sale or transfer within the State or Territory (Brown v. Maryland, 12 Wheaton 678 or 25 U. S. 419; Texas Co. v. Brown 258 U. S. 466, 476-477 or 66 L. ed. 721; Sonneborn vs. Keeling 262 U. S. 506 or 67 L. ed. 1095). In other words the Court's interpretation of local law 666 is contrary to the principle that a State may not burden Interstate Commerce.

We quote from the statement of the case and position of counsel in Brown v. Maryland (supra) as follows:

> "What are the apparent differences between this and a tax directly on imports? It may be said, in the first place, that the one is a tax for the privilege of bringing the foreign article into the country, and the other a tax for the privilege of selling it after it is so brought in. But these privileges are indissolubly connected; the right to sell is a necessary incident to the right of importing. The grant of a privilege to import would be of no value, unless it implies a right to sell. Prohibit sale, and importation necessarily ceases". (Brown et al. v. The State of Maryland, pp. 679-680, U. S. Sup. Ct. Rep. Wheat, Book 6) (12 Wheaton 679-680.)

Chief Justice Marshall of the Supreme Court of the United States in the course of his opinion said:

> "There is no difference between the power to

prohibit the sale of an article and a power to prohibit its introduction into the country. The one would be a necessary consequence of the other. No goods would be imported if none could be sold." (Brown et al v. The State of Maryland, p. 685, U. S. Sup. Ct. Rep. Wheat. Book 6) (12 Wheat. 685.)

Manila, P. I., February 19, 1931.

Respectfully submitted,

J. W. FERRIER and
GIBBS & McDONOUGH
By A. D. GIBBS,
Attorneys for Appellants,
Peoples Bank Bldg., Manila.

UNITED STATES OF AMERICA
STATE OF NEW YORK

BY

EDWARD J. FLYNN
SECRETARY OF STATE AND CUSTODIAN
OF THE GREAT SEAL THEREOF.

IT IS HEREBY CERTIFIED, That Jesse Read was Clerk of the County of Niagara in said State, and Clerk of the Supreme Court therein, being a Court of Record, on the day of the date of the annexed certificate and duly authorized to grant the the same; that the same is in due form and executed by the proper officer; that the seal affixed to said certificate is the seal of said County and Court; that the signature thereto of said Clerk is in his

proper handwriting, and is genuine; and that full faith and credit may and ought to be given to his official acts.

IN TESTIMONY WHEREOF, The Great Seal of the State is hereunto affixed.

WITNESS my hand at the City of Albany, the fifteenth day of January in the year of our Lord one thousand nine hundred and thirty-one.

(SGD.) GRACE A. REAVY
Deputy Secretary of State

UNITED STATES OF AMERICA
PHILIPPINE ISLANDS
In the Supreme Court of the Philippine Islands

H. E. HEACOCK CO.,
Plaintiff and Appellee,

vs.

AMERICAN TRADING COMPANY,
Defendant and Appellant.

G. R. No. 31851

WM. A. ROGERS, LTD., a corporation and AMERICAN TRADING COMPANY, a corporation,
Plaintiffs and Appellants,

vs.

H. E. HEACOCK CO., a corporation,
Defendant and Appellee.

G. R. No. 31852

STATE OF NEW YORK
COUNTY OF NIAGARA } *ss.*

HAROLD H. ELMENDORF, being duly sworn, deposes and says:

I reside in the City of Niagara Falls, New York, and am in the employ of Wm. A. Rogers, Ltd., above named. Since April 12, 1923, I have been manager of the Planning and Production Departments of Wm. A. Rogers, Ltd., and in this connection I have had charge of the Planning, Production, Assembling and Shipping Departments of its plant at Niagara Falls, New York.

In connection with my duties, I have been for

the period mentioned fully conversant with the various designs manufactured by Wm. A. Rogers, Ltd., and with the labels which have been used upon the containers and boxes in which such merchandise is shipped to points both in the United States of America and in the Philippine Islands and elsewhere for distribution.

I have read the affidavit of Alexis W. Bearce, verified January 7, 1931, herein. Of my own knowledge I am able to state that the Tipped and Windsor designs described in Mr. Bearce's affidavit and the exhibits thereto annexed are not subject to any exclusive right of use in the United States and elsewhere but are open to free and general unrestricted use by manufacturers of flatware and are freely used by such manufacturers. With respect to the various designs specified in Mr. Bearce's affidavit, which are described in Exhibits "A", "B", "C" and "D" thereto annexed, I am able to say of my own knowledge that during the period in which I have been employed by Wm. A. Rogers, Ltd., that Company has manufactured flatware bearing the respective back-stamp and in the respective patterns indicated in those exhibits and in other patterns for sale throughout the United States of America and that the Company has manufactured goods bearing the respective back-stamps in the various designs shown in those exhibits for shipment to the Philippine Islands.

In connection with my official duties, I am and for seven years last past as stated have been in charge of boxing and labeling the merchandise of Wm. A. Rogers, Ltd., for shipment not only to the United States but to the Philippine Islands and elsewhere. I have personally never seen any of the containers which are used by H. E. Heacock Company for distribution in the Philippine Islands of merchandise identical with that which has been sold for many years in the United States by International Silver Company. I do know that none of the containers used during the past seven years by Wm. A. Rogers, Ltd., were designed to resemble or made for the purpose of simulating any form of container in use by H. E. Heacock Company or any other competitor of Wm. A. Rogers, Ltd. I know of my own knowledge that the containers used by Wm. A. Rogers, Ltd., in the distribution of its merchandise in the Philippine Islands through American Trading Company were and are identical with the size, style and type of container used by Wm. A. Rogers, Ltd., for the shipment and distribution of its merchandise in the United States of America. More than 90% of the sales of Wm. A. Rogers, Ltd., flatware in the Philippine Islands, through American Trading Company, have been sales of flatware bearing the backstamp "Wm. A. Rogers, Nickel Silver." The forms of container used for this quality of flatware are for the most part plain white or Manila boxes composed of cardboard and from my own ob-

servation practically all manufacturers of flatware in the United States use and for a long time have used boxes practically identical for the shipment of approximately the same quality of merchandise.

Annexed hereto and marked Exhibit "E" is a sheet to which are affixed samples of the labels which have been used by Wm. A. Rogers, Ltd., upon containers of merchandise shipped to the American Trading Company, Philippine Islands, in the patterns and bearing the back-stamps which are described in Mr. Bearce's affidavit above referred to and Exhibits "A" to "D", inclusive, thereto attached. These same labels have been used by Wm. A. Rogers, Ltd., without substantial change during the course of the last seven years upon shipments not only to points in the Philippine Islands but to points in the United States of America and elsewhere.

In the decision of this Court promulgated November 21, 1930, it is stated: "The evidence is conclusive that the wares for which the American Trading Company has been taking and filling orders is very similar in appearance, design, and material to the wares which have been advertised and sold in this country by Heacock Company since 1905. It is true that a dealer in such wares could and would see the distinction between them, but even so, in the ordinary course of business the average public to whom they are sold could not and would not distinguish one from the other." It is respectfully sub-

mitted to the Court that so far as any simulation of containers of Wm. A. Rogers, Ltd., to those of any other manufacturer or distributor of flatware is concerned, there is before this Court and there can be produced no evidence in support of a claim of unfair competition. The evidence above described and a great volume of evidence which may be presented to the Court in corroboration thereof shows beyond doubt that Wm. A. Rogers, Ltd., has simply adapted for the distribution and sale of its merchandise in the Philippine Islands identical forms of container and label which it has for many years used in the distribution of its flatware in the United States of America and elsewhere.

Deponent asks special attention of the Court to this question of alleged unfair competition on the part of Wm. A. Rogers, Ltd., and avers that it is contrary to the facts as presented to the Court, and that it impugns its reputation and honesty to its irreparable damage.

Deponent further asks the Court to reopen the case in order that testimony in rebuttal of the unfair competition charge may be introduced under Section 497 of the Philippine Code of Civil Procedure or such other pertinent portion of said Code as may appear to the Court proper.

(SGD.) HAROLD H. ELMENDORF

Subscribed and sworn to before
me this 7th day of January, 1931.

(SGD.) BURTON ELLISON
Notary Public
My commission Expires
March 30, 1931

STATE OF NEW YORK
NIAGARA COUNTY } ss.
CLERK'S OFFICE

I, JESSE READ, Clerk of the County of Niagara, and also Clerk of the Supreme and County Courts in and for said County, do hereby certify:

That said Courts are Courts of Record, having by law a seal, That *Burton Ellison* whose name is subscribed to the attached certificate of acknowledgment, proof or affidavit, and before whom the same was taken, was at the time of taking such acknowledgment, proof or affidavit a NOTARY PUBLIC, residing in said County
(SEAL) and duly authorized to take and certify the same, and that the same is taken and certified in all respects as required by the laws of said State of New York. That I am well acquainted with the handwriting of said NOTARY PUBLIC and verily believe that the signature to the said certificate is genuine.

IN WITNESS WHEREOF, I have hereunto set my hand and affixed the seal of said Courts at Lockport, in said County, this 18th day of January A. D. 1931.

No. 4942. (SGD.) JESSE READ Clerk.

UNITED STATES OF AMERICA
STATE OF NEW YORK

BY
EDWARD J. FLYNN
SECRETARY OF STATE AND CUSTODIAN
OF THE GREAT SEAL THEREOF.

IT IS HEREBY CERTIFIED, That Jesse Read was Clerk of the County of Niagara in said State, and Clerk of the Supreme Court therein, being a Court of Record, on the day of the date of the annexed certificate and duly authorized to grant the same; that the same is in due form and executed by the proper officer; that the seal affixed to said certificate is the seal of said County and Court; that the signature thereto of said Clerk is in his proper handwriting, and is genuine; and that full faith and credit may and ought to be given to his official acts.

IN TESTIMONY WHEREOF, The Great Seal of the State is hereunto affixed.

WITNESS my hand at the City of Albany, the fifteenth day of January in the year of our Lord one thousand nine hundred and thirty-one.

(SGD.) GRACE A. REAVY
Deputy Secretary of State

STATE OF NEW YORK
COUNTY OF NIAGARA } s. s.

JAMES R. HAGEN, being duly sworn, deposes and says:

I reside in the City of Niagara Falls, New York and am in the employ of Wm. A. Rogers, Ltd., above named. I entered the employ of Wm. A. Rogers, Ltd., in December, 1902. I was first employed in its Niagara Falls factory until September, 1905. For a period of approximately three years I was engaged in study. I returned again to the employ of Wm. A. Rogers, Ltd. in January, 1908 and until 1914 worked at the Niagara Falls, New York factory of that company as a tool worker and die cutter. In 1914 I was appointed foreman of the Tool Department and held that position until 1918 when I was appointed and for three years held the position of foreman of the Machine and Tool Departments. In May, 1921, I was appointed Assistant Superintendent of the Niagara Falls, New York factory, which position I retained until November, 1921, at which time I became Superintendent of that factory and have continued to hold that position to the present time.

In my many years of experience in the silver ware and flat ware manufacturing industry, I have become very familiar with methods of the manufacture of flat ware, with designs and patterns employed by Wm. A. Rogers, Ltd. at its Niagara Falls fac-

tory and elsewhere and I have become familiar as well with methods of production and designs and patterns of the products of practically all the companies at present engaged in the industry.

The Court in its decision promulgated November 21, 1930, held against the plaintiff, Wm. A. Rogers, Ltd., and said:

> "The evidence is conclusive that the wares for which the American Trading Company has been taking and filling orders is very similar in appearance, design, and material to the wares which have been advertised and sold in this country by Heacock Company since 1905. It is true that a dealer in such wares could and would see the distinction between them, but even so, in the ordinary course of business the average public to whom they are sold could not and would not distinguish one from the other."

I understand from the language of the decision that the Court has been led to believe that Wm. A. Rogers, Ltd. has been guilty of unfair competition in respect of patterns and designs of merchandise and the form and appearance of container which it has used for distribution of its products in the Philippine Islands. I have read the affidavits of Alexis W. Bearce and Harold H. Elmendorf, both verified herein on January 7, 1931. The statements which Mr. Bearce and Mr. Elmendorf have made in those affidavits respecting the free and general unrestricted use of the Windsor and Tipped designs of flat ware, respecting the design and pattern of mer-

chandise which have been shipped by Wm. A. Rogers, Ltd. to the Philippine Islands and elsewhere and respecting the type and form of label and the form, quality and appearance of container which have been used by Wm. A. Rogers, Ltd. for shipment both to the Philippine Islands and elsewhere are true to my own knowledge based upon my own experience above stated.

Deponent asks special attention of the Court to this question of alleged unfair competition on the part of Wm. A. Rogers, Ltd., and avers that it is contrary to the facts as presented to the Court, and that it impugns its reputation and honesty to its irreparable damage.

Deponent further asks the court to reopen the case in order that testimony in rebuttal of the unfair competition charge may be introduced under Section 497 of the Philippine Code of Civil Procedure or such other pertinent portion of said Code as may appear to the court proper.

(SGD.) JAMES R. HAGEN

Subscribed and sworn to before me
this 7th day of January, 1931.

(Sgd.) BURTON ELLISON
Notary Public
My commission Expires
March 30, 1931.

STATE OF NEW YORK
NIAGARA COUNTY } SS.
CLERK'S OFFICE

I, JESSE READ, Clerk of the County of

Niagara, and also Clerk of the Supreme and County Courts in and for said County, do hereby certify:

That said Courts are Courts of Record, having by law a seal, That Burton Ellison whose name is subscribed to the attached certificate of acknowledgment, proof or affidavit, and before whom the same was taken, was at the time of taking such acknowledgment, proof or affidavit a NOTARY PUBLIC, residing in said County and duly authorized to take and certify the same, and that the same is taken and certified in all respects as required by the laws of said State of New York. That I am well acquainted with the handwriting of said NOTARY PUBLIC and verily believe that the signature to the said certificate is genuine.

(SEAL)

IN WITNESS WHEREOF, I have hereunto set my hand and affixed the seal of said Courts at Lockport, in said County, this 18th day of January A. D. 1931.

No. 4941 (SGD.) JESSE READ Clerk.

(HEADING AND TITLE OMITTED)

UNITED STATES OF AMERICA
STATE OF NEW YORK

BY
EDWARD J. FLYNN
SECRETARY OF STATE AND CUSTODIAN
OF THE GREAT SEAL THEREOF.

IT IS HEREBY CERTIFIED, That Jesse Read was Clerk of the County of Niagara in said State,

and Clerk of the Supreme Court therein, being a Court of Record, on the day of the date of the annexed certificate and duly authorized to grant the same; that the same is in due form and executed by the proper officer; that the seal affixed to said certificate is the seal of said County and Court; that the signature thereto of said Clerk is in his proper handwriting, and is genuine; and that full faith and credit may and ought to be given to his official acts.

IN TESTIMONY WHEREOF, the Great Seal of the State is hereunto affixed.

WITNESS my hand at the City of Albany, the fifteenth day of January in the year of our Lord one thousand nine hundred and thirty-one.

(SGD.) GRACE A. REAVY
Deputy Secretary of State.

(HEADING AND TITLES OMITTED)

STATE OF NEW YORK
COUNTY OF NIAGARA } ss.

ALEXIS W. BEARCE, being duly sworn, deposes and says:

I reside at Niagara Falls, New York and am Assistant Manager of the Niagara Falls, New York factory of Wm. A. Rogers, Ltd., one of the plaintiffs above named. I have been in the employ of Wm. A Rogers, Ltd. since January 1, 1918 and at all times since that date have been Assistant Manager of that factory. In connection with my employment my duties have, during the period em-

tioned, necessitated my personal familiarity with all phases of the business of my employer, including both the manufacturing or production and the commercial or sales aspects of its interests. For many years prior to my employment by Wm. A. Rogers, Ltd. I have been familiar with the manufacture and sale of flat ware products, having been from April 15, 1908 to December, 1917, Assistant General Manager of Simeon L. & George H. Rogers, Company, Ltd., a flat ware manufacturing company with offices at Hartford, Connecticut.

By a decision of this Court promulgated November 21, 1930, herein it has been held that said Wm. A. Rogers, Ltd. has been guilty of unfair competition in respect of H. E. Heacock Co. above named. In that decision it was stated:—

> "The evidence is conclusive that the wares for which the American Trading Company has been taking and filling orders is very similar in appearance, design, and material to the wares which have been advertised and sold in this country by Heacock Company since 1905. It is true that a dealer in such wares could and would see the distinction between them, but even so, in the ordinary course of business the average public to whom they are sold could not and would not distinguish one from the other."

With respect to that portion of the decision which is above set forth and to the issues herein to which said language has reference, I wish to state the following facts which are based upon my personal knowledge and observation of my employer's

method of transacting business in the United States since January 1, 1918. The merchandise which has been sold since 1925 by Wm. A. Rogers, Ltd. in the Philippine Islands has been sold through its agent American Trading Company. All such merchandise which has been thus distributed is identical with merchandise manufactured and distributed by Wm. A. Rogers, Ltd. in large quantities in the United States of America for upwards of the past twenty-five years. For upwards of twenty-five years last past such merchandise has to my knowledge been manufactured and sold in the United States by Wm. A. Rogers, Ltd. in competition with goods, wares and merchandise manufactured and sold in the United States of America by International Silver Company, a corporation of the State of New Jersey, having its principal office and place of business at Meriden, Connecticut.

Wm. A. Rogers, Ltd. has manufactured and sold merchandise bearing the stamp "1881 (*R*) ROGERS (*R*) A1" in numerous patterns of flat ware, and has distributed the same throughout the United States of America for many years last past. Among the flat ware patterns which have been manufactured bearing this stamp have been those patterns indicated on the lithograph hereto attached and marked "Exhibit A", namely: Helen of Troy, Essex, Coronet, Henly, Cheshire and Salem, all of which patterns have been sold by Wm. A. Rogers,

Ltd. in the Philippine Islands through American Trading Company.

Wm. A. Rogers Ltd. has likewise manufactured and sold merchandise bearing the stamp "Wm. A. Rogers" in numerous patterns of flat ware, and had distributed the same throughout the United States of America for many years last past. Among the flat ware patterns which have been manufactured bearing this stamp have been those patterns indicated on the catalog hereto attached and marked "Exhibit B" namely: Sovereign, Emerson, Raleigh and Elizabeth, all of which patterns have been sold by Wm. A. Rogers, Ltd. in the Philippine Islands through American Trading Company.

Wm. A. Rogers, Ltd. has likewise manufactured and sold merchandise bearing the stamp "W. R." preceded by a figure of a small Maltese Cross and followed by the figure of a key stone in numerous patterns of flatware, and has distributed the same throughout the United States of America and the Philippine Islands for many years last past. Among the flat ware patterns which have been manufactured bearing this stamp have been those patterns indicated on the catalog hereto attached and marked "Exhibit C", namely: Alden, Amherst, Windsor and Tipped, all of which patterns have been sold by Wm. A. Rogers, Ltd. in the Philippine Islands through American Trading Company.

Wm. A. Rogers, Ltd. has likewise manufactured

and sold merchandise bearing the stamp "Wm. A. Rogers, Nickel Silver" in numerous patterns of flatware, and had distributed the same throughout the United States of America for many years last past. Among the flatware patterns which have been manufactured bearing this stamp have been those patterns indicated on the catalog hereto attached and marked "Exhibit D", namely: Alden, Violet, Amherst, Windsor, Tipped, Avon, Yates and Saxon, all of which patterns have been sold by Wm. A. Rogers, Ltd. in the Philippine Islands through American Trading Company.

As appears from the evidence and the Exhibits in the above entitled actions, all of the goods, wares and merchandise sold by H. E. Heacock Co. in the Philippine Islands are identical with the goods, wares and merchandise manufactured and sold in the United States of America by the above mentioned International Silver Company. The merchandise of Wm. A. Rogers, Ltd. which has been above described has been sold in competition with the merchandise of International Silver Company throughout the United States of America for more than twenty-five years without any objection whatever by International Silver Company to such sale and distribution and without any such objection by any competitor of Wm. A. Rogers, Ltd.

The Windsor and Tipped designs to which reference has been made above and which are illustrated in Exhibits "C" and "D" hereto attached,

are common to the trade and are not subject to any exclusive right of manufacture or distribution, but are available to any manufacturer and used by practically all persons and corporations engaged in the trade.

With respect to the labels used upon the boxes and containers in the sale and distribution of merchandise by Wm. A. Rogers, Ltd. in the Philippine Islands and elsewhere, I have read the affidavit of Harold H. Elmendorf, verified herein on January 7, 1931, and the contents of said affidavit are true to my own knowledge which is based upon the experience hereinbefore stated.

In consequence of the facts herein set forth, it is respectfully submitted to the Court that there is no foundation in fact for the charge that Wm. A. Rogers, Ltd. has been guilty of any unfair competition, in any manner, in respect of the goods and merchandise sold by H. E. Heacock Co. in the Philippine Islands.

Deponent asks special attention of the court to this question of alleged unfair competition on the part of Wm. A. Rogers, Ltd., and avers that it is contrary to the facts as presented to the Court, and that it impugns its reputation and honesty to its irreparable damage.

Deponent further asks the Court to reopen the case in order that testimony in rebuttal of the unfair competition charge may be introduced under Section 497 of the Philippine Code of Civil Proce-

dure or such other pertinent portion of the said Code as may appear to the Court proper.

(SGD.) ALEXIS W. BEARCE

Subscribed and sworn to before me
this 7th day of January, 1931.
(SGD.) BURTON ELLISON
Notary Public
My commission Expires
March 30, 1931

STATE OF NEW YORK }
NIAGARA COUNTY } SS.
CLERK'S OFFICE }

I, JESSE READ, Clerk of the County of Niagara, and also Clerk of the Supreme and County Courts in and for said County, do hereby certify;

That said Courts are Courts of Record, having by law a seal, That Burton Ellison whose name is subscribed to the attached certificate of acknowledgment, proof or affidavit, and before whom the same was taken, was at the time of taking such acknowledgment, proof or affidavit a NOTARY PUBLIC, residing in said County and duly authorized to take and certify the same, and that the same is taken and certified in all respects as required by the laws of said State of New York. That I am well acquainted with the handwriting of said NOTARY PUBLIC and verily believe that the signature to the said certificate is genuine.

(SEAL)

IN WITNESS WHEREOF, I have hereunto set my hand and affixed the seal of said Courts at Lockport, in said County, this 12th day of January A. D. 1931.

No. 4944. (SGD.) JESSE READ Clerk.

INFORMATION

WAR DEPARTMENT,
BUREAU OF INSULAR AFFAIRS,
WASHINGTON.

March 7, 1917.

Messrs. Marks & Clerk,
220 Broadway, New York City.

Gentlemen:

I beg to acknowledge the receipt of your letter of February 14th with reference to a communication from the Philippine Library and Museum advising you that *it is no longer the practice to file certified copies of registrations of trade marks secured in the United States, with which you inclose a copy of your letter to this Bureau* requesting an explanation of the action taken by the Philippine Library and Museum.

The letter last referred to, which you state was dated December 5th last, did not reach us, which may be due to the fact that the copy you have furnished us indicates that it was addressed "Bureau of Insular Affairs, Manila, P. I", instead of Washington, D. C.

The Federal Trade Mark Act of February 20, 1905, has been construed (section 27) *as prohibiting the entry at ports of the Philippine Islands of any article of imported merchandise infringing upon trade marks registered in the United States or foreign countries offering similar privileges to citi-*

zens of the United States, and to enable the customs officials of the Islands to prevent the entry of such articles, it has been the practice to have the owners of trade marks desiring such protection record their trade marks with the Insular Collector of Customs at Manila, at the same time furnishing him a number of facsimiles of each trade mark for distribution to the customs collectors at the sub-ports of the Islands, of which there are six in number, and this was the procedure followed in the case of the Royal Typewriter Company to which you allude in your letter of December 5th. *In other words, the Federal Trade Mark Law is limited in its scope, so far as the Philippine Islands are concerned, to commerce between the Islands on the one hand, and the United States and foreign countries on the other.* Original jurisdiction is conferred upon the Courts of First Instance of the Islands in cases arising from the above provision.

There still remains, however, the protection of United States and foreign trade marks in the internal commerce of the Islands, and to accomplish this, and at the same time provide for the registration and protection of domestic trade marks and trade names, the Philippine Commission enacted Act 666, a copy of which is inclosed. You will note that this Act provides *that ownership of a trade mark or trade name shall be recognized and protected in the Is-*

lands in the same manner and to the same extent as other property rights known to the law, and that, to justify recovery for infringement, it is not necessary to show that the trade mark or trade name has been registered under the Spanish law in force at the time of American occupation or under this Act. You will also note in Sec. 11 that trade marks and trade names, whether their owners are domiciled in the Philippine Islands, the United States, or elsewhere, are registered only upon payment of the prescribed fees, which at present are $25.10 and payable to the Director of the Philippine Library and Museum, Manila, P. I.

I am returning herewith the duplicate application of the B. J. Johnson Company for registration of their trade mark "Palmolive". If it is desired that it be registered in the Philippine Islands, you should return it as now prepared accompanied with a money order for $25.10 made payable as above. If, however, it is desired that this trade mark be recorded in the various ports of entry of the Philippine Islands, to prevent importation of goods infringing thereon, it will only be necessary for you to send us a certified copy of the United States registration together with ten facsimiles of the trade mark.

Very respectfully,

(Sgd.) CHAS. C. WALCUTT, Jr.
Assistant to Chief of Bureau.

Inc 1. copy Act. 666.

" Rules & Regulations Governing Registration of Trade Marks & Trade Names. P. I.

Application, in duplicate, of B. J. Johnson Soap Company.

(GG)

On February 24, 1931, counsel for the appellee filed the following Memorandum in Reply to Appellants' Application for Rehearing and Motion for New Trial:

(HEADING AND TITLES OMITTED)

APPELLEE'S MEMORANDUM IN REPLY TO APPELLANTS' APPLICATION FOR REHEARING AND MOTION FOR NEW TRIAL

PRELIMINARY REMARKS

The decision of this Honorable Court in these cases consists of a lengthy document comprising eighteen (18) typewritten pages and is confirmatory of that rendered by the trial court which consists of sixty-two printed pages (pp. 17-78 of the Bill of Exceptions).

There is no dissenting opinion or vote in the decision rendered by this Honorable Court which is signed and concurred in by seven of the nine members of the Court, one of the other two members not taking part therein (Mr. Justice Johnson) and the other reserving his vote (Mr. Justice Ostrand).

All of the points raised by the appellants in their application for a rehearing have been duly and exhaustively discussed by both sides in their printed briefs and memoranda and it is to be presumed that they have been thoroughly weighed and considered by this Honorable Court when it said in one of the last paragraphs of the decision in question that—

> "The attorneys for the respective parties have submitted able and exhaustive briefs on numerous other legal questions, but in the final analysis the important and decisive question is the legal force and effect of the registration of the word 'Rogers' by the Heacock Company in June, 1918, and we are clearly of the opinion that the registration at that time of that word is valid, and that as such it should be protected under the provisions of Act No. 666 and its amendments."

It is, therefore, the contention of counsel for the appellants that both the Court of First Instance of Manila (Branch presided over by the Honorable Carlos Imperial) as well as this Honorable Court, after all the parties have submitted exhaustive and lengthy briefs and memoranda, have fundamentally erred in the decision of this case, notwithstanding the fact that all the points raised in appellants' application for rehearing have been considered by this Honorable Court and substantially all of them were also considered by the trial court.

ARGUMENT

Appellants claim that this Honorable Court has committed no less than seventeen errors in its de-

cision, that is to say, ten more than the trial court, because while there were only seven assignments of error against the decision of the lower court, appellants now make seventeen assignments of error against this Honorable Court's decision.

We wish to call this Court's attention at the very start to one characteristic of appellants' application for rehearing, and that is that they first attempt to construe the meaning of this Honorable Court's language and then proceed to attack the Court upon the basis of such construction. In other words, appellants fix the target to suit themselves and then attempt to destroy it. A few instances will suffice—

1. Counsel quote from this Honorable Court's decision as follows:

> "If appellants' contention is sustained, any old established firm here which in good faith had applied for, and obtained, the registration of a given word as its trade-mark, and through its skill, energy, and business dealings had built up a good business, largely founded on that trade-mark, could after many years of such business wake up some fine morning and find that its trade-mark was of but little, if any, commercial value, because some other firm in the United States had registered its trade-marks in the Patent Office of that country, in which it made use of the word which the local merchant had registered as its trade-mark in this country. What would be the value of an old registered trade-mark in the Philippine Islands upon which a merchant had established his business here,

> if in later years another person in the same line of business, and on the strength of a similar registered trade-mark in the United States, could enter the field here and become a competitor in the sale of similar wares under similar trade-marks?"

and say (p. 59 of printed Application for Rehearing) that this Court, in the above statement, "*assumes by implication* that the trade-marks of Wm. A. Rogers, Ltd. were registered in the United States *after* the registration in 1918 in the Philippines of the word 'Rogers'". They then proceed to demonstrate how this Court was wrong in such *assumption*. The fact, however, is that there is nothing in the quoted passage which assumes that the registration in the United States of Wm. A. Rogers, Ltd.'s trade-marks was done *after* the Heacock Company had registered the words "Rogers" in the Philippine Islands as its own trade-mark. This Honorable Court, in the quoted statement, says nothing more than that it would be absurd to sustain the validity in this country of Wm. A. Rogers, Ltd.'s trade-marks registered in the United States as against the Heacock Company who had registered here in 1918 its own trade-mark, under our own trade-mark law, because if such contention is sustained registration of Philippine trade-marks under Philippine laws would be valueless and would afford no protection as against a new comer in the field who happened to have registered a similar trade-mark in the United States. This Court's de-

cision simply speaks of the effect of such holding as appellants would have this Court adopt, but makes no finding and no assumption, by implication or otherwise, that Heacock's registration here in 1918 was prior to Wm. A. Rogers, Ltd.'s registration in the United States.

2. One of the main basis of appellants' application for a rehearing, which is found throughout their argument, twisted in one way at times and in another way at other times, is the alleged finding made by this Honorable Court in its decision to the effect that the registration in the Philippine Islands by the H. E. Heacock Company of the word "Rogers" as a trade-mark was *for the use and benefit of the International Silver Company.* (See pp. 22, 25, 56, 58, 60, 62, 75, 85, 87 and 95 of printed Application for Rehearing.) Based on the assumption that this Court made such finding, appellants proceed to show throughout their agument how such finding is erroneous and inconsistent with other findings of fact and of law in such decision made. Appellants, further argue, based on such erroneous and unwarranted assumption, that the real party in interest in this case is the International Silver Co. and not the H. E. Heacock Co., that the latter was merely the agent of the former in such registration and that, therefore, the decisions rendered by some courts of the United States in litiga-

tion between Wm. A. Rogers, Ltd. and the International Silver Co. are final, even in the Philippine Islands, on the respective rights of such supposed litigants in this case. It is also contended, based again on the aforesaid erroneous assumption of fact, that Heacock's registration in the Philippines of the word "Rogers" was a fraud on the appellants because it was designed to deprive Wm. A. Rogers, Ltd. of its rights against the International Silver Co. as established in those United States decisions.

Let it be said once and for all, as stated in our pleadings and as pointed out in our printed memorandum of oral argument before this Honorable Court, that the H. E. Heacock Co. is here asserting its own rights and not those of the International Silver Co.; that in registering the word "Rogers" the Heacock Co. acted *for itself* and not as the agent of the International Silver Co. or any other company; that the whole theory of this case, as set out in the pleadings and previous arguments of *both sides*, is to the effect that the trade-mark "Rogers" as registered in the Bureau of Commerce and Industry of the Philippine Islands is the trade-mark of the H. E. Heacock Co.

It is true that this Court makes the following statement at page 10 of its decision:

> "It having been admitted that Heacock Company registered the word 'Rogers' as a trade-mark in June, 1918, and it appearing that such trade-

> mark was registered with the knowledge, consent, and approval of the International Silver Company, *in fact that it was made for its use and benefit*, the question is squarely presented as to what is its legal force and effect, and what legal right Heacock Company has to the use and enjoyment of the word and trade-mark 'Rogers'". (Italics ours.)

and from that statement appellants draw the conclusion throughout their argument that the real party in interest in this case is the International Silver Company, that the H. E. Heacock Company was merely the agent of the International Silver Company in the registration of the "Rogers" trade-mark in this country and that the Heacock Company could acquire no better rights to the use of such trade-mark, as against the appellants, than the International Silver Company.

The first important question to be determined, then, is what did this Honorable Court mean when in the passage last quoted it said, by way of dictum, that "in fact that it (the registration of the trade-mark 'Rogers') was made for its (the International Silver Company) use and benefit"? Did the Court mean what appellants say, that is, that the real party in interest in this case is the International Silver Company and not the Heacock Company and that the latter, in registering the word "Rogers" *as its own* trade-mark acted merely as the agent of the former? Surely that cannot be the meaning placed on that phrase by this Honorable Court. *First*, because the judgment is given in favor of the

H. E. Heacock Company and not in favor of the International Silver Company. *Second*, because the theory of the whole case from the beginning as well as in the decision of the trial court is that the Heacock Company is the owner of such trade-mark (see especially exhibit "16" quoted at page 24 of appellants' printed Petition for Rehearing) and that the Heacock Company is litigating herein its own rights and not those of the International Silver Company. *Third*, because this Honorable Court in its decision makes specific findings to the effect that the "Rogers" trade-mark in question is the trade-mark of the Heacock Company:

> "The Heacock Company was established in the City of Manila in the year 1909 as the successor of the firm of Heacock & Frier, which was established here in 1901, and has been in business ever since and importing into the Philippine Islands plate, tableware, silverware, flatware and hollowware, and plated goods bearing the trade-mark "Rogers", and it is admitted that on June 27, 1918, *it registered here in the Bureau of Commerce and Industry the trade-mark 'Rogers'. That it has been in the use and enjoyment of that trade-mark ever since.*"
>
> (Decision of this Honorable Court, page 8. Italics ours.)
>
> * * * * *
>
> "In the final analysis, in June, 1918, Heacock Company duly registered here the word 'Rogers' *as its trade-mark.* At that time this was a virgin field for the wares evidenced by that trade-mark. Since then, through its advertising business me-

thods, and dealings, it has built up a growing and increasing market for the sale and purchase of such wares.

Act No. 666 is entitled 'An Act defining property in trade-marks and in trade-names and providing for the protection of the same, defining unfair competition and providing remedies against the same, providing registration for trade-marks and trade-names * * *.' The purpose and intent of the law is very apparent. Pursuant to its provisions *Heacock Company registered the word 'Rogers' as its trade-mark,* for ought that appears, without any knowledge at the time of the existence of the registered trade-marks of Wm. A. Rogers, Ltd. in the Patent Office of the United States in which the word 'Rogers' is used."

(Decision of this Honorable Court, pages 16-17. Italics ours.)

* * * * *

"By Act No. 666 and its amendments, the Legislature of the Philippine Islands made specific provisions for the defining of property in trade-marks and trade-names, and their protection and unfair competition, and provided for remedies against it, and for the registration of trade-marks and trade-names, and it is admitted that in June, 1918, *Heacock Company registered the word 'Rogers' as its trade-mark* upon which it has built up an old established business.

* * * * *

All things considered, the judgment of the lower court (in favor of the Heacock Company) in both cases is affirmed, with costs against the appellants."

(Decision of this Honorable Court, page 18. Italics ours.)

What, then, did this Honorable Court mean when it said that the registration in the Philippines by the Heacock Company of the word "Rogers" was in fact made "for the use and benefit" of the International Silver Company? The answer is simple, indeed.

Appellants at pages 8-21 of their printed memorandum of oral argument (see particularly p. 16 thereof) charged appellee with fraud, because, among other reasons, of the fact, as alleged, that the H. E. Heacock Co. knew that the International Silver Co. had registered trade-marks in the United States containing the word "ROGERS" at the time that it (the Heacock Co.) registered the word "ROGERS" as *its own* trade-mark here. We answered that charge at pages 2-15 of our printed memorandum of oral argument and at pages 14-15 we said as follows:

> "Another point to be considered in this connection is that the H. E. Heacock Co. never committed a fraud on the International Silver Co. when it did register its own trade-mark 'ROGERS' in the Philippine Islands. The International Silver Co. knew of and consented to such registration, according to the undisputed and absolutely uncontradicted testimony of Mr. Gaches just quoted. The H. E. Heacock never committed fraud against Wm. A. Rogers, Ltd., because they had acquired no rights in the Philippine Islands in 1918 when the H. E. Heacock Co. registered its own trade-mark here, either by virtue of registration in the Philippine Islands of its own trade-marks or by the extension of its trade-

here under the United States trade-marks. As we have seen, the registration of a trade-mark does not, of itself, give any rights to the registrant. It is not a right in gross and therefore it is only of value in connection with an existing trade or good will, and Wm. A. Rogers, Ltd. had no trade here prior to 1925, and certainly no good will except what it could poach upon that established by the H. E. Heacock Co. at the expense of many thousands of pesos worth of advertising and continuous fair dealing with the public for about 25 years. Moreover, as we have pointed out in our printed brief (pp. 56-65) and by the trial court in its decision (pp. 30-34, Bill of Exceptions), the Federal Trade-Mark Law is not in force in this jurisdiction, and consequently the effects of registration of a trade-mark in the United States Patent Office, even if done in connection with an established business or good will, do not reach beyond the confines of continental United States.—Standard Brewery Co. of Baltimore v. Interboro Brewing Co., Inc., *supra*."

It is therefore clear that when this Honorable Court stated in its decision that the registration in the Philippine Islands by the Heacock Company of the "ROGERS" trade-mark was in fact made "for the use and benefit" of the International Silver Co., it did not mean that the Heacock Co. acted as the agent of the International Silver Co. in such registration, because such meaning would be openly inconsistent with the findings of this Honorable Court, heretofore quoted, to the effect that said trade-mark was the trade-mark of the Heacock Co. and for that reason the judgment is for the Heacock Co. and not for the International Silver Company. What this

Honorable Court clearly meant and had in mind in making the statement in question is that the Heacock Co. did not commit fraud as charged by the appellants in their memorandum because the International Silver Company, being the manufacturer of the goods sold by the Heacock Co. under *its* "ROGERS" trade-mark, knew and consented to such registration and would, in any event, be the beneficiary of the trade acquired in virtue of such registration.

With this preliminary consideration in mind we will now proceed to show that this Honorable Court committed none of the seventeen errors charged against it by the appellants.

REFUTATION OF FIRST ALLEGED ERROR

Appellants claim that this Honorable Court erred "*in failing to find that the trade-mark laws of the United States contained in the Act of Congress of February 20, 1905, as amended, by virtue of their own recitals and by virtue of the provisions of Section 14 of Act 666 of the Philippine Legislature are applicable to the Philippines and, therefore, decisive of the right to import into the Islands and sell the same kind of wares of Wm. A. Rogers, Ltd., which are sold in the United States under the same trade-marks.*

The question of the applicability of the Federal Trade-Mark Law to these Islands is not a new one. It is discussed at length in the decision of the trial court (pp. 38-42 of the Bill of Exceptions). In our

printed brief we discussed this same question at length in connection with appellants' fifth assignment of error and there (pp. 56-65) we said:

"Under this heading appellants contend that the Act of Congress of February 20, 1905, is in force in these Islands. In this, we submit, appellants are in error. We contend that Act 666 as amended is the trade-mark law in force in this country.

The principal points of conflict between these two laws, with particular reference to these cases, are, among others, the following:

(1) Under the Act of Congress a family name is not susceptible of registration as a trade-mark, there being a special provision to that effect, whereas under Act 666 of the Philippine Legislature such registration may be effected, there being no provision in the law against it.

(2) Act 666 provides in Section 4 thereof that no action may be brought for damages for the violation of trade-mark rights unless it be first shown that the trade-mark in question has been duly registered in the Philippine Bureau of Commerce and Industry. There is no such provision in the Act of Congress of February 20, 1905.

Counsel maintain that the Act of Congress of February 20, 1905, is the trade-mark law in force in these Islands, in view of the provision contained in Section 29 thereof, which reads as follows:

'Sec. 29. That in construing this Act the following rules must be observed, *except where the contrary intent is plainly apparent from the context thereof.* The United States includes and embraces all territory which is under the jurisdiction and

control of the United States.' (Italics ours.)

Our contention is that such words, used in the statute, were never intended to include the Philippine Islands and that had Congress intended the contrary, it would have expressly mentioned the *Philippine Islands by name.*

The Act of Congress of July 1st, 1902, otherwise known as the Philippine Bill, provides in Section 1 thereof the following:

'The provisions of Section eighteen hundred and ninety-one of the Revised Statutes of eighteen hundred and seventy-eight shall not apply to the Philippine Islands.'

The obvious intention of the Congress of the United States in the enactment of the above language is that the laws of the United States shall not apply to the Philippine Islands unless it is *expressly* so stated in the statute.

'Section 1891 of the Revised Statutes of 1878 provides that "The Constitution and all laws of the United States which are not locally inapplicable shall have the same force and effect within all the organized territories, and in every territory hereafter organized, as elsewhere within the United States." When Congress organized a civil government for the Philippines, it expressly provided that this section of the Revised Statutes should not apply to the Philippine Islands. (Sec. 1, Act of 1902.)'

(United States vs. Bull, 15 P. R. p. 22.)

We contend that the Federal Trade-Mark Law is not applicable to the Philippine Islands on the following grounds:

1. Because it does not mention the Philippine Islands specifically by name;

2. Because no proper machinery is provided therein for its enforcement in the Philippine Islands;

3. Because, language similar to that employed in Section 29 of said Act, *supra*, relied upon by counsel for Wm. A. Rogers, Ltd. and American Trading Co., has already been construed by the Attorney General of the United States as not including the Philippine Islands.

It is unquestionable that it was within the power of Congress to include the Philippine Islands in the operation of the Federal Trade-Mark Law if it had so wished; and had it been its intention that this Act should apply to the Philippine Islands, it would have expressly said so, and it would have mentioned specifically the 'Philippines' or the 'Philippine Islands' as it has done in several other acts, particularly the Narcotic Act of December 17, 1914, the Trading with the Enemy Act of October 6, 1917, the Immigration Act of February 5, 1917, the Income Tax Act of September 8, 1916, and the National Defense Act of June 15, 1917. In all of these Acts, the 'Philippine Islands' are specifically mentioned by name and suitable legal machinery for their enforcement here is therein provided.

Such being the constant practice of the Congress of the United States in enacting laws intended to apply to the Philippine Islands, we must conclude that the fact that the Philippine Islands are not specifically mentioned in the Federal Trade-Mark Law clearly shows the intention of Congress that this Act should not apply to these Islands.

In the Acts of Congress above enumerated, not only was the Philippine Islands mentioned by name as stated above, but suitable legal machinery for their enforcement in the Islands was also provided.

Officials of this government were specifically entrusted with the enforcement of such laws here, and jurisdiction or controversies arising under them was expressly granted to our local courts, whereas in the Federal Trade-Mark Law no such jurisdiction is provided. Nowhere in this law can we find a provision giving our Philippine courts jurisdiction of cases arising under it, either original or appellate. Such jurisdiction is specifically conferred upon circuit and district courts which are peculiar to the United States proper and territories other than the Philippine Islands. The issuance of the remedy of injunction, which is peculiarly applicable to trade-mark cases, is specifically conferred by this Act on such courts and we think that no one will contend that the circuit and district courts of the United States and the Supreme Court of the District of Columbia can have legal power to enforce their orders in the Philippine Islands.

'The district and territorial courts of the United States and the Supreme Court of the District of Columbia shall have original jurisdiction, and the circuit courts of appeal of the United States and the Court of Appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trade-mark registered in accordance with the provisions of this subdivision of this chapter, arising thereunder, without regard to the amount in controversy.' (Act of February 20, 1905, chapter 592, section 17, 33 Stat. 728; Act of March 3, 1911, chapter 231, section 291, 36 Stat. 1167.)

'The several courts vested with jurisdiction of cases arising under this subdivision of this chapter shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under said subdivision, on such

terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by Section 96 of this chapter for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed.' (Act of February 20, 1905, chapter 592, Section 19, 33 Stat. 729.)

It will thus be seen that if we accept counsel's theory that the Federal Trade-Mark Law is in force in the Philippines we will necessarily arrive at the absurd conclusion that Congress intended such Act to apply to these Islands but provided no legal machinery for its enforcement here. That is absolutely contrary to the accepted canons of statutory construction.

> "The practical inquiry is usually what a particular provision, clause or word means. To answer it one must proceed as he would with any other composition—construe it with reference to the leading idea or purpose of the whole instrument. A statute is passed as a whole and not in parts or sections and is animated by one general purpose and intent. Consequently each part or section should be construed in connection with every other part or section and so as to produce a harmonious whole. It is not proper to confine the attention to the one section to be construed.' (2 Lewis' Sutherland on Statutory Construction, pp. 706-707.)

'The words and meaning of one part may lead to and furnish an explanation of the sense of another.' (2 Lewis' Sutherland on Statutory Construction, p. 709.)

'Where general language construed in a broad sense would lead to absurdity it may be restrained. The particular inquiry is not what is the abstract force of the words or what they may comprehend, but in what sense they were intended to be used as they are found in the act. The sense in which they were intended to be used furnishes the rule of interpretation, and this is to be collected from the context; and a narrower or more extended meaning is to be given according to the intention thus indicated.' (2 Lewis' Sutherland on Statutory Construction, pp. 722-723.)

'A statute may be construed contrary to its literal meaning, when a literal construction would result in an absurdity or inconsistency, and the words are susceptible of another construction which will carry out the manifest intention.' (2 Lewis' Sutherland on Statutory Construction, p. 913.)

Furthermore, the language employed in Section 29 of the Federal Trade-Mark Law heretofore quoted is very similar to that of Section 1 of the eighteenth amendment to the United States Constitution, which is as follows:

'Section 1. After one year from the ratification of this article the manufacture, sale, or transportation of intoxicating liquors within, the importation thereof into, or the exportation thereof from the United States *and all territory subject to the jurisdiction thereof* for beverage purposes is here-

by prohibited." (40 Stat. at L. 1050, 1941. Italics ours.)

To declare that the language employed by Congress in Section 29 of the Federal Trade-Mark Law was intended by it to span the Philippine Islands within its meaning, would automatically put in force in those Islands the 18th Amendment with the result that a great part of the revenues of this country would immediately be wiped off and scores of laws now in force regulating the manufacture, sale and distribution of alcoholic beverages in the Philippine Islands would be nullities.

The interpretation of Section 29 of the Federal Trade-Mark Law as advocated by counsel for Wm. A. Rogers, Ltd. and American Trading Co. with such disastrous consequences to Philippine Commerce, as above pointed out, we cannot accept.

Language almost identical with that employed by Congress in Sec. 29 of the Federal Trade-Mark Law, hereinbefore quoted, was interpreted by no less an authority than the Attorney General of the United States, as not including within its terms the Philippine Islands. We refer to the Narcotic Drugs Import and Export Act of May 26, 1922 (42 Stat. 596) wherein appears in subsections (b), (c) and (d) of section 2 thereof, the following language:

> 'The United States or any territory under its control or jurisdiction.'

In that Act there is this further provision:

> 'Sec. 1. * * * * *
>
> '(b) The term "United States," when used in a geographical sense, includes the several States and Territories and the District of Columbia;
>
> * * * * * * *

It could, therefore, following appellants' view in

this case, have been construed that 'the United States or any territory under its control and jurisdiction' as used in Section 2 above, meant territory subject to the control or jurisdiction of the United States other than the several States, the Territories and the District of Columbia, for the reason that these were already defined by Section 1 as being included in the term 'United States.' Nevertheless, the Attorney General of the United States ruled that said Act was not applicable to the Philippine Islands. Says the Attorney General:

> 'The language of the Narcotic Drugs Import and Export Act of May 26, 1922 (42 Stat. 596) fixing its geographical application, says:
>
> > "The United States or any territory under its control and jurisdiction."
> >
> > (Par. *b* of Sec. 2)
>
> * * * * * * *
>
> 'The Narcotic Drugs Import and Export Act will be searched in vain for any language disclosing that it "specifically" provided that it shall apply to the Philippines. Not only does the Act not provide any enforcement machinery for the Philippines as is ordinarily done, as will be hereinafter pointed out in statutes intended to apply to the Philippines, but * * * *
>
> 'Additional support for the views above expressed is to be found in what may now be regarded as the *well-settled manner in which Congress expresses its intention where it desires any of the Federal laws to be operative in the Philippines.* In Sec. 23 of the Income Tax Act of September 8, 1916 (39 Stat. 776), it is provided that the provisions

of that Act shall extend to the "Philippine Islands". The Act also confers jurisdiction upon "courts of first instance of said Islands", and places the administration of the law so far as the Act is concerned upon the officers of those Islands. The so-called National Defense Act of June 15, 1917, (40 Stat. 217, 231) specifically confers upon the "courts of first instance in the Philippine Islands" jurisdiction of offenses under that Act committed within the Philippines * * *. In Section 2 of the Narcotic Act of December 17, 1914 (38 Stat. 785, 787), it is provided that in "the Philippine Islands administration of this Act" shall be looked after by the local internal revenue officers. The Act further provides that "the courts of first instance in the Philippine Islands shall possess and exercise jurisdiction in all cases arising under this Act in said Islands." In the Trading with the Enemy Act of October 6, 1917 (40 Stat. 411, 425), it is provided that "the several courts of first instance in the Philippine Islands shall have jurisdiction of offenses committed under the Act within their territory." * * *

"In conclusion, it seems proper to state that even though the correct interpretation of the Narcotic Drugs Import and Export Act were more doubtful than I find it to be, it would nevertheless be necessary to resolve that doubt against the application of the law to the Philippines in view *not only* of the provisions of section 5 of the Act of August 29, 1916, supra, *but also because of the provisions in section 1 of the Act of July 1, 1902* (32 Stat. 691), in which Congress specifically withheld from the Philippine Is-

lands the application of section 1891 of the Revised Statutes, *thus expressing its intention that the laws of the United States should not apply to the Philippines* unless the intention to that effect was *clearly* expressed.' (32 Op. Atty. Gen. 550, Opinion dated Oct. 17, 1925.) (Italics ours.)

On the foregoing arguments we submit that the Federal Trade-Mark law is of no force and effect in these Islands."

At pages 2-8 of our printed memorandum of oral argument we said as follows:

"It is also argued by counsel that such registration in the United States Patent Office gives to the registrants 'the right to the use of such trade-marks in the United States *and in the Philippine Islands*' (p. 13).

We are indeed surprised to hear from the learned counsel for the appellants the last of these two statements, that is to say, that registration of a trade-mark in the United States gives to the registrant the right to the use of the trade-mark *in the Philippine Islands.* Unless the bare statement of counsel for the appellants can effect a change in the law of trade-marks we know of no such law.

It is a universal principle in the law of trade-marks that a trade-mark, unlike a patent, gives no right of monopoly to the registrant, independent of the business which such trade-mark is designed to protect. It is not a right in gross and becomes a property right only when it identifies a particular trade.—Aunt Jemina Mills Co. vs. Rigney & Co. (N. Y. 1917), 247 Fed. 407, 159 C. C. A. 461, L. R. A. 1918C, 1089; Vermont Maple Syrup Co. vs. F. N. Johnson Maple Syrup Co. (D. C. Vt. 1921), 272 Fed.

473; In re Leslie-Judge Co. (C. C. A., N. Y. 1921), 272 Fed. 886, certiorari denied Green vs. Felder, 256 U. S. 704, 65 L. Ed. 1180; Coca-Cola Bottling Co. vs. Coca-Cola Co., 269 Fed. 796; President Suspender Co. vs. MacWilliam, 238 U. S. 159, affirming 233 Fed. 433, and certiorari denied in Hugh G. MacWilliam vs. President Suspender Co., 243 U. S. 636, 61 L. Ed. 941; Ward Baking Co. vs. Potter-Wrightington, Inc. 298, affirming Potter-Wrightington, Inc. vs. Ward Baking Co., 288 Fed. 597; Andrew Jergens Co. vs. Bonded Products Corporation, 13 Fed. (2nd) 417; Detroit Creamery Co. vs. Velvet Brand Ice Cream Co., 153 N. W. 664, 187 Mich. 312; American Steel Foundries vs. Robertson, 269 U. S. 372, 70 L. Ed. 317.

Another fundamental principle in the law of trade-marks is that the trade-mark merely identifies the good will of a particular business, and a part from such good will a trade-mark has no recognized value and is not subject of legal appropriation.—Joseph Schlitz Brewing Co. vs. Houston Ice & Brewing Co., 241 Fed. 817, affirmed 250 U. S. 28, 63 L. Ed. 822.

The result is that neither the International Silver Co. nor Wm. A. Rogers, Ltd. could acquire any rights here by virtue of registration of their trade-marks in the United States, because they had no business to protect here. The evidence is undisputed that when Wm. A. Rogers, Ltd. came to the Philippine markets, the goods of H. E. Heacock Co. were already known under the appellation of 'Rogers,' and had been so known since 1905. Wm. A. Rogers, Ltd. is a newcomer in these islands and their trade-mark, registered in the United States—assuming that it is a valid registration in the Philippine Islands and that Federal Trade Mark Law is in force in these islands, *which is not the case* as we will hereafter show—could give them no

rights or protection in this country. This general doctrine becomes clearer when we consider the territorial extent of trade-mark rights as expounded in the following leading cases on the subject:—

'A trade-mark confers no monopoly whatever in a proper sense, but is merely a convenient means for facilitating the protection of one's good will in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or the package in which it is sold. *It results that the adoption of a trade-mark does not,* at least in the absence of some valid legislation enacted for the purpose, *project the right of protection in advance of the extension of the trade, or operate as a claim of territorial rights over areas into which it thereafter may be deemed desirable to extend the trade.*' (Italics ours.)

(Ammon vs. Narragansett Dairy Co., 262 Fed. 880, affirming 252 Fed. 276, and 254 Fed. 208, and following United Drug Co. vs. Theodore Rectanus Co., 248 U. S. 90, 63 L. Ed. 141, which affirmed Theodore Rectanus Co. vs. United Drug Co., 226 Fed. 545.)

'Further, a trade-mark right is not a right in gross or at large, and it is not the trade-mark, *but the good will in connection with which the mark is used,* which is protected, and the proprietor of a trade-mark cannot monopolize markets that his trade has not appropriated. Hanover v. Metcalf, 240 U. S. 403, 36 S. Ct. 357, 60 L. Ed. 713; United Drug Co. v. Rectanus Co., 248 U. S. 95, 39 S. Ct. 48, 63 L. Ed., 141.

'(4) This is true of common law trademarks and it is equally true of those which have been registered, for the Federal Registration Acts are wholly without effect to extend or limit,

except in interstate commerce, as to remedies, the substantive rights which reasons have in, or in connection with, those trade-marks at common law. Scandinavia Belting Co. v. Asbestos & Rubber Works, 257 F. 937, 169 C. C. A. 87; Andrew Jergens & Co. v. Woodbury Co. (D. C.) 273 F. 952.

'(5) Registration does not create a trade-mark. It is not essential to its validity. Armour vs. Louisville Provision Co. (C. C. A.), 283 F. 42; Phillipps v. Hudnutt, 263 F. 643, 49 App. D. C. 247; Trappey v. McIlhenny (C. C. A.), 281 F. 23. The law is well stated in United Drug Co. v. Rectanus Co., 248 U. S. 97, 39 S. Ct. 48, 63 L. Ed., 141, where the court said, of an effort to predicate a right upon a mark rather than upon a business to which the mark was an incident:

> "The asserted doctrine is based upon the fundamental error of supposing that a trade-mark right is a right in gross or at large. * * * There is no such thing as property in a trade-mark, *except as a right appurtenant to an established business or trade in connection with which the mark is employed.* The law of trade-marks is but a part of the broader law of unfair competition; the right to a particular mark grows out of its use, not its mere adoption. Its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another's product as his; and it is not the subject of property, except in connection with an existing business. * * * *It results that the adoption of a trade-mark does not*, at least in the absence of some valid legislation enacted for the purpose,

project the right of protection in advance of the extension of the trade, or operate as a claim of territorial rights over areas into which it thereafter may be deemed desirable to extend the trade."

'And it concludes by reaffirming what Justice Holmes had in the concurring opinion in the Hanover Case so clearly declared, that *state lines have great importance in the matter of trademark laws, change the law of trademarks is a matter of state rather than of federal law;* the court, in the Rectanus Case, at page 98 (39 S. Ct. 51), saying:

> '"Property in trade-marks and the right to their exclusive use *rest upon the laws of the several states, and depend upon them for security and protection; the power of Congress to legislate on the subject being only such as arises from the authority to regulate commerce with foreign nations and* among the several states." ' (Italics ours.)
>
> (Pulitzer Pub. Co. vs. Houston Printing Co., 4 Fed. 2nd 924, 926-927.)

In the case of Standard Brewery Co. of Baltimore vs. Interboro Brewing Co., Inc., 229 Fed. 543, 544, decided in 1916, brought later on certiorari by the defendant before the United States Circuit Court of Appeals for the Second Circuit, the petition being dismissed there, the court held that—

'The rights which a person obtains by registration of a trade-mark under those statutes (U. S. Statutes) *are coterminous with the territory of the United States.*'

This case is also authority on the basic proposition that a registered trade-mark is valueless ex-

cept in connection with an established business or good will.

Summarizing the foregoing arguments on the first proposition advanced by counsel for the appellants we can readily reach the following legal conclusions:

(a) That the decisions relied on by appellants in prior litigation between the International Silver Co. and Wm. A. Rogers, Ltd., before the Court of Appeals of the District of Columbia have no legal or binding force as against the H. E. Heacock Co., who, in the present cases, is litigating its own rights by virtue of registration of its own trade-mark in this jurisdiction in connection with its own business and good will;

(b) Granting, for the sake of argument only, that these cases were being litigated by the International Silver Co. and Wm. A. Rogers, Ltd., and further granting, also for the sake of argument only, that the Federal Trade Mark Law is in force here, registration by Wm. A. Rogers, Ltd., of its trade-mark in the U. S. Patent Office could have no effect beyond the territorial limits of the United States, and for the further reason that being new comers in this territory they could acquire no rights under such registration without first having a trade and established good will here."

At page 72 of our said memorandum of oral argument we also said the following:

"Counsel again argue that the Federal Trade Mark Law is applicable to the Philippines. We have argued this point fully at pages 56-65 of our printed brief. The same question has been fully

discussed by the trial court in its decision (pp. 29-34, Bill of Exceptions).

This Hon. Court, in the case of Spinner & Co. v. Neuss Hesslein Corporation (Jan. 13, 1930), XXVIII O. G. 1939, 1941, has unmistakably stated that 'the law governing trade-mark rights as well as unfair competition in this jurisdiction is found in Act 666 of the Philippine Commission.' "

That, we hope, will settle forever the question as to the applicability to these islands of the Federal Trade-Mark Law. But appellants argue that the opinion of the Attorney General of the United States regarding the applicability to these islands of the Federal Narcotic Act cited in the trial Court's decision and in our printed brief (quoted in the preceding pages) is not applicable to the case at bar for the reason that the Federal Narcotic Act was enacted *after* the passage of the Jones Law which specifically provides that "the statutory laws of the United States *hereafter* enacted shall not apply to the Philippine Islands, * * *". But it has evidently and conveniently escaped the attention of appellants that the Attorney General's ruling is based not only on that provision of the Jones Law but on other considerations which equally apply to the Federal Trade-Mark Law of 1905. Among those considerations are: (1) that no machinery is provided for its application in these islands as Congress has done with respect to other laws which it intended to apply here, notably the Income Tax Act of Sep-

tember 8, 1916, the National Defense Act of June 15, 1917, the Immigration Act of February 5, 1917, the Trading with The Enemy Act of October 6, 1917, and the Narcotic Act of December 17, 1914 (passed prior to the Jones Law); and (2) "the well settled manner in which Congress expresses its intention where it desires any of the Federal laws to be operative in the Philippines." (Opinion of the Attorney General of the United States of October 17, 1925, *supra.*)

Our argument that counsel's contention regarding the applicability in these islands of the Federal Trade-Mark Law of 1905 would lead to the absurd conclusion that while Congress intended it to apply to the Philippines no machinery was therein provided for its application here, is dismissed with scorn by counsel with the following self-serving statement:

> "The argument about the lack of courts and other machinery to enforce the Act of Congress of February 20, 1905, *is entirely without merit.*"
>
> (Appellant's printed Petition for Rehearing, p. 13.)

Will counsel pray tell us why such argument is without merit? Why not frankly confess that the said argument is not met because it is unanswerable?

Appellants speak of "property rights" conferred in virtue of "registration of trade-marks under the laws of the United States". (See pp. 6, 13, 15,

16, etc., etc. of Appellants' Printed Application for Rehearing.) Our answer to that is that we know of no such property rights in trade-marks "acquired in virtue of mere registration." We so stated with citation of authorities relied on at pp. 3-7 of our printed memorandum of oral argument (heretofore quoted) which for the sake of convenience we again reproduce hereunder, as follows:

> "It is a universal principle in the law of trade-marks that a trade-mark, unlike a patent, gives no right of monopoly to the registrant, independent of the business which such trade-mark is designed to protect. It is not a right in gross and becomes a property right only when it identifies a particular trade.—Aunt Jemima Mills Co. v. Rigney & Co. (N. Y. 1917), 247 Fed. 407, 159 C. C. A. 461, L. R. A. 1918 C, 1039; Vermont Maple Syrup Co. v. F. N. Johnson Maple Syrup Co. (D. C. Vt. 1921), 272 Fed. 478; In re Leslie-Judge Co. (C. C. A., N. Y. 1921), 272 Fed. 886, certiorari denied Green vs. Felder, 256 U. S. 704, 65 L. Ed. 1180; Coca-Cola Bottling Co. vs. Coca-Cola Co., 269 Fed. 796; President Suspender Co. vs. MacWilliam, 238 U. S. 159, affirming 233 Fed. 433, and certiorari denied in Hugh G. MacWilliam vs. President Suspender Co., 243 U. S. 636, 61 L. Ed. 941; Ward Baking Co. v. Poter-Wrightington, Inc. 298, affirming Potter-Wrightington, Inc. vs. Ward Baking Co., 288 Fed. 597; Andrew Jergens Co. vs. Bonded Products Corporation, 13 Fed. (2nd) 417; Detroit Creamery Co. vs. Velvet Brand Ice Cream Co., 153 N. W. 664, 187 Mich. 312; American Steel Foundries vs. Robertson, 269 U. S. 372, 70 L. Ed. 317.
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The result is that neither the International Silver Co. nor Wm. A. Rogers Ltd. could acquire any rights here by virtue of registration of their trade-marks in the United States, because they had no business to protect here. The evidence is undisputed that when Wm. A. Rogers, Ltd. came to the Philippine markets, the goods of H. E. Heacock Co. were already known under the appellation of 'Rogers', and had been so known since 1905. Wm. A. Rogers, Ltd. is a newcomer in these islands and their trade-mark registered in the United States—assuming that it is a valid registration in the Philippine Islands and that the Federal Trade-Mark Law is in force in these islands, which is not the case as we will hereafter show—could give them no rights or protection in this country. This general doctrine becomes clearer when we consider the territorial extent of trade-mark rights as expounded in the following leading cases on the subject:—

> 'A trade-mark confers no monopoly whatever in a proper sense, but is merely a convenient means for facilitating the protection of one's good will in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or the package in which it is sold. *It results that the adoption of a trade-mark does not*, at least in the absence of some valid legislation enacted for the purpose, *project the right of protection in advance of the extension of the trade, or operate as a claim of territorial rights over areas into which it there-*

after may be deemed desirable to extend the trade.' (Italics ours.)

(Ammon vs. Naragansett Dairy Co., 22 Fed. 880, affirming 252 Fed. 276, and 254 Fed. 208, and following United Drug Co. vs. Theodore Rectanus Co., 248 U. S. 90, 63 L. Ed. 141, which affirmed Theodore Rectanus Co. vs. United Drug Co., 226 Fed. 545.)

'Further, a trade-mark right is not a right in gross or at large, and it is not the trade-mark, *but the good will in connection with which the mark is used*, which is protected, and the proprietor of a trade-mark cannot monopolize markets that his trade has not appropriated. Hanover v. Metcalf, 240 U. S. 403, 36 S. Ct. 357, 60 L. Ed. 713; United Drug Co. v. Rectanus Co., 248 U. S. 95, 39 S. Ct. 48, 63 L. Ed. 141.

'(4) This is true of common-law trade-marks and it is equally true of those which have been registered, for the Federal Registration Acts are wholly without effect to extend or limit, except in interstate commerce, as to remedies, the substantive rights which person have in, or in connection with, those trade-marks at common law. Scandinavia Belting Co. v. Asbestos & Rubber Works, 257 F. 937, 169 C. C. A. 87; Andrew Jergens & Co. v. Woodbury Co. (D. C.) 278 F. 952.

'(5) Registration does not create a trade-mark. It is not essential to its validity. Armour v. Louisville Provision Co. (C. C. A.), 283 F. 42; Phillippe v. Hudnutt, 263 F. 643; 49 App. D. C. 247; Trappey v. McIlhenny (C. C. A.), 281 F. 23. The law is well stated in United Drug Co. v. Rectanus Co., 248

U. S. 97, 39 S. Ct. 48, 63 L. Ed. 141, where the court said, of an effort to predicate a right upon a mark rather than upon business to which the mark was an incident:

"The asserted doctrine is based upon the fundamental error of supposing that a trade-mark right is a right in gross or at large. * * * There is no such thing as property in a trade-mark, *except as a right appurtenant to an established business or trade in connection with which the mark is employed.* The law of trade-marks is but a part of the broader law of unfair competition; the right to a particular mark grows out of its use, not its mere adoption. Its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another's product as his; and it is not the subject of property, except in connection with an existing business. * * * *It results that the adoption of a trade-mark does not,* at least in the absence of some valid legislation enacted for the purpose, *project the right of protection in advance of the extension of the trade, or operate as a claim of territorial rights over areas into which it thereafter may be deemed desirable to extend the trade.*"

'And it concludes by reaffirming what Justice Holmes had in the concurring opinion in the Hanover Case so clearly declared, that *state lines have great importance in the matter of trade-mark laws, since the law of trade-marks is a matter of state rather*

than of federal law; the court, in the Rectanus Case, at page 98 (89 S. Ct. 51), saying:

> "Property in trade-marks and the right to their exclusive use *rest upon the laws of the several states, and depend upon them for security and protection; the power of Congress to legislate on the subject being only such as arises from the authority to regulate commerce with foreign nations and among the several states.*" (Italics ours.)
>
> (Pulitzer Pub. Co. vs. Houston Printing Co., 4 Fed. 2nd 924, 926-927.)

Furthermore, it is undisputed that appellants never made use of their trade-marks in this country prior to 1925 and that the H. E. Heacock Co. had at that time registered and used its trade-mark in these islands for many years. The result is that even assuming, but without for a moment admitting, that the Federal Trade-Mark Law is in force in these islands, the appellants could never have acquired any *property rights* here in virtue of such registration alone, because it is a fundamental principle in the law of trade-marks that registration without use in the particular market gives no right to the registrant to the mark so registered, and in support of that contention we borrow counsel's own citation appearing at page 73 of their printed Application for Rehearing, as follows:

"2. ACTUAL USE NECESSARY.—A trade-mark right can be acquired *only* by actual use of the word or mark in the manner that trade-marks must be used. The goods with the mark must be placed *upon the market*. Mere adoption with intent to use in the future *will not* create a trade-mark."

(38 Cyc. 691. Italics ours.)

Counsel cite in their Printed Supplemental Argument in support of their Motion for Rehearing the Opinion of the Attorney General of the United States of September 24, 1909—an opinion which is of much earlier date than that cited in our printed brief and incorporated herein—in support of their contention that the Federal Trade-Mark Law is in force in these islands. A casual reading of said opinion will disclose that the only statement that the Attorney General of the United States categorically makes therein is "*that a resident of the Philippine Islands has the right to avail himself of the privileges of such law.*" (See concluding paragraph of the opinion.) The Attorney General of the United States did not decide or say that the Federal Trade-Mark Law was in force in these islands or that it was *the* trade-mark law of these islands. Indeed, the Attorney-General of the United States could not possibly have said such a thing of the specific question had been presented to him, for the reason that so to hold would have been the equivalent of saying that Congress intended that *the district and territorial courts of the United States and*

the Supreme Court of the District of Columbia shall have *original jurisdiction in this country* in suits regarding trade-marks and that the *courts of appeals of the United States and the Court of Appeals of the District of Columbia* shall have *appellate jurisdiction* in such suits, because of the provision contained in that law which reads as follows:

> "The district and territorial courts of the United States and the Supreme Court of the District of Columbia shall have original jurisdiction, and the circuit courts of appeal of the United States and the Court of Appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this subdivision of this chapter, arising thereunder, without regard to the amount in controversy." (Act of February 20, 1905, chapter 592, section 17, 33 Stat. 728; Act of March 3, 1911, chapter 231, section 291, 36 Stat. 1167.)

Counsel's contention that Congress intended that the Federal Trade-Mark Law should apply in the Philippine Islands is, therefore, equivalent to holding that the following are sound legal propositions:

> 1. That Congress by uncertain and equivocal language, and without expressly so stating, intended that the district and territorial courts of the United States and the Supreme Court of the District of Columbia should exercise original jurisdiction in the Philippine Islands in suits regarding trade-marks and that the courts of appeals of the United States and the Court of Appeals of the

District of Columbia should exercise appellate jurisdiction in such suits.

2. That Congress by uncertain and equivocal language, and without expressly so stating, intended to sweep off the map not only this Hon. Supreme Court but all of the courts of first instance of these islands in suits regarding trade-marks.

3. That we have two trade-mark laws in force in this country—the Federal Trade-Mark Law of February 20, 1905, and Act 666 of the Philippine Legislature—totally inconsistent with each other, one with teeth for its proper enforcement in these islands and the other a mere platonic gesture without machinery for enforcement here.

4. That this Hon. Court was wrong when it said in Spinner & Co. vs. Neuss Hesslein Corporation (Jan. 30, 1930), XXVIII O. G. 1939, 1941, that "*the law* governing trade-mark rights as well as unfair competition in this jurisdiction is found in Act 666 of the Philippine Commission."

When counsel for the appellants are ready and willing to subscribe to the foregoing four conclusions naturally flowing from their contention that the Federal Trade-Mark Law of February 20, 1905, is in force in this jurisdiction, then they may begin to find listeners to such contention.

That closes the most important phase of our argument and we shall have to refer back to it as we proceed further, for the reason that nearly all of the propositions sustained by the appellants in their seventeen assignments of error, supposedly committed by this Hon. Court, are based and found-

ed upon the single untenable contention that the Federal Trade-Mark Law of February 20, 1905, is in force in these islands.

REFUTATION OF SECOND ALLEGED ERROR

Appellant's second assignment of error, alleged to have been committed in this Hon. Court's decision, reads as follows:

> *"The court erred in failing to hold that property rights created by the registration of trade-marks in the United States under the provisions of the Act of Congress of February 20, 1905, as amended in conjunction with Section 14 of Act 666 of the Philippine Legislature are entitled to the protection of the tribunals of justice in the Philippine Islands whether that Act of Congress be technically and directly applicable to these islands or not."*

Before proceeding to present our argument in refutation of this second alleged error, allow us to point out some fallacies and inconsistencies contained therein.

Counsel speak of "property rights created by the registration" of trade-marks in the United States. We have shown in the preceding pages that it is a universal principle in the law of trade-marks that registration alone gives no property rights to the registrant. It is therefore an idle and useless task to speak of property rights created in virtue of registration. Furthermore, even if registration creates such "property rights", the same would not exist in this country for the reason that

the Federal Trade-Mark Law under which appellant's trade-marks were registered is not in force here.

Counsel speak of trade-mark rights created in virtue of registration under the Federal Trade-Mark Law "in conjunction with Section 14 of Act 666 of the Philippine Legislature." If these two trade-mark laws are totally inconsistent with each other—and they are—and if the former is in force in these islands, as appellants contend, we cannot conceive of the legal existence of Act 666 of the Philippine Legislature. Counsel must decide whether the trade-mark law in force in this jurisdiction is the Act of Congress of February 20, 1905, as they vigorously contend, or Act 666 of the Philippine Commission. Both of them cannot coexist. How, then, can anyone speak of trade-mark rights derived from a "conjunction" of the two acts?

The question presented by this assignment of error is not a new one in this case. Counsel discussed the same question fully in their printed memorandum of oral argument, pp. 22-24. Our answer then is a complete answer to their renewed charge on this same subject and it reads as follows:

> "Counsel claim that under the proviso contained in Sec. 14 of act 666 of the Philippine Legislature, the registrant of a trade-mark in the United States may freely deal in the wares bearing such trade-mark in the Philippine Islands, even though

it may clash with locally registered trade-marks. Such interpretation of the law is untenable. It would amount, in effect, to an affirmation that we have two trade-mark laws in force in this country, wholly inconsistent with each other, each establishing its own procedure in the matter of registration and providing remedies in different courts for their infringement.

Section 14 of our own trade-mark law cannot mean more than what it actually says, and if there be any doubt as to that meaning we must interpret it in connection with the rest of the act and in a manner that will not lead to absurd conclusion.

Said Section reads as follows:

> Sec. 14. No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or shall copy or simulate a trade-mark or trade-name registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the Philippine Islands, shall be admitted to entry at any custom-house of the Philippine Islands; and in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark or trade-name issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the office of the Insular Collector of Customs, under such regulations as the Insular Collector of Customs, with the

approval of the Secretary of Finance and Justice, shall prescribe, and may furnish to the office of the Insular Collector of Customs a facsimile of his name, the name of the locality in which his goods are manufactured, and of his registered trade-mark or trade-name; and thereupon the Insular Collector of Customs shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs: PROVIDED, HOWEVER, THAT THIS SECTION shall not be construed to affect rights that any person may have acquired by virtue of having registered a trade-mark under the laws of the United States.

In matters arising under this section original jurisdiction is hereby conferred upon the Court of First Instance, and appellate jurisdiction upon the Supreme Court, identical with the jurisdiction conferred upon such courts by section twenty-six of the Act of Congress approved August fifth, nineteen hundred and nine, entitled "An Act to raise revenue for the Philippine Islands, and for other purposes."

The above quoted proviso reads: 'Provided, however, that this section shall not be construed, etc.' What does that mean? It simply means that registration of a trade-mark in the United States shall enable the goods bearing the registered trade-mark to enter the ports of the Philippine Islands. It does not mean that such goods may be sold in the Philippines in violation of rights previously acquired here. This meaning becomes very clear if we consider that this particular section deals *solely* with the importation of goods into the Philippine Islands and if the *proviso* above quoted had not been inserted in the act, it would have been unconstitutional, for the reason that Congress, in the

Jones Law, expressly reserved to itself the right to legislate in matters regarding commerce between the Islands and the United States while it granted to the Philippine Legislature the absolute power to deal with its internal commerce as it saw fit. Now then, if this proviso had been omitted from the act, the result would have been to prevent the entry here of goods of American manufacture, a result contrary to the spirit and letter of the Jones Law and previous organic acts. The insertion of that proviso in Sec. 14 of Act 666 clearly avoids such a situation because it in effect permits the importation, but not the sale, here, of goods bearing a United States trade-mark. In other words, Act 666 regulates internal commerce without interfering with the powers of Congress regarding commerce between the islands and the United States. Without that proviso the registrant of a Philipine trade-mark could stand at the Custom House and prevent the entry of goods manufactured in the United States and bearing a trade-mark registered in the United States Patent Office, although such goods may have been purchased in the United States and not intended for sale here. As Act 666 stands, that cannot be done. If a person comes from the United States or from any other country and brings with him, for his own use, goods bearing a United States registered trade-mark, such goods may enter a port of the Philippine Islands although the mark thereon may infringe a locally registered trade-mark, because that section of the law and the proviso in it refer solely to importation and not to the sale of such goods.

It is clear, therefore, that the proviso contained in Section 14 of the Philippine Trade-Mark Law allows only the importation but not the sale of such goods here, as a contrary interpretation, aside from being totally unwarranted, would lead to a conclusion completely absurd.

> Counsel argue also that registration here of a trade-mark registered in the United States is a mere *proforma* proceeding. We cannot agree with that view. Section 11 of Act 666 which prescribes the manner of registration here of such trade-marks provides a procedure somewhat different from the ordinary procedure but it does not do away with the requirement contained in Section 2 of the same Act which provides that a trade-mark may be appropriated if it *'has not been so appropriated by another'*. Said section 11 does not mean that the registrant of a trade-mark in the United States may have such trade-mark registered here in a *proforma* manner even though it conflicts with a previously registered local trade-mark." (Appellee's Printed Memorandum of Oral Argument, pp. 56-60.)

Appellants at pages 9-10 of their printed Application for Rehearing cite Customs Administrative Order No. 194 to prove that the Federal Trade-Mark Law of 1905 is in force in these islands. A very thin argument, indeed. Appellants' contention in effect is that the Collector of Customs, by the issuance of an administrative order, may decide, over the courts of this country and over the Philippine Legislature, which trade-mark law is in force here—whether the Act of Congress of February 20, 1905, or Act 666 of the Philippine Commission. But a careful reading of said Customs Administrative Order No. 194 will disclose the fact that it refers to foreign manufacturers or traders who by treaty or convention between their respective countries and the United States are entitled to

the same protection as citizens of the United States with respect to their trade-marks, and it is intended to give to such foreign manufacturers or traders the protection contemplated in Section 27 of the Federal Trade-Mark Law. Now then, what protection does Sec. 27 of the Federal Trade-Mark Law afford to such foreign manufacturers or traders? Said section, in so far as foreign manufacturers or traders are concerned, reads as follows:

> "No article of imported merchandise which shall copy or simulate the name * * * of any manufacturer or trader located in a foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, * * * or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom house of the United States * * *."
>
> (Act of Congress of Feb. 20, 1905, c. 592, Sec. 27, 33 Stat. 730.)

Does that mean that such foreign goods are entitled to entry *and sale* in the Philippine Islands in violation of a Philippine trade-mark? Certainly not. It simply is intended to protect the public from the importation of spurious goods bearing a misleading or fraudulent mark. Said Customs Administrative Order No. 194 was evidently designed to protect foreign manufacturers or traders, not against local manufacturers or traders who operate

and sell their goods under a Philippine trade-mark, but against "imported merchandise" which shall copy or simulate the name of "a manufacturer or trader located in a foreign country" who under United States treaties or conventions is entitled to protection, or shall bear a mark calculated to deceive the public. That is the only protection afforded by Section 27 of the Act of Congress of February 20, 1905, to "foreign manufacturers or traders" referred to in Customs Administrative Order No. 194 cited by the appellants.

Appellants make this further criticism of this Honorable Court's decision with reference to the interpretation given by it of Section 14 of Act 666 of the Philippine Legislature:

> "The right to import merchandise into the Philippines is necessarily and obviously a mere incident to the right to sell the same. The interpretation by this Honorable Court of the proviso above quoted of Section 14 of Act 666 presupposes that the Legislature intended to beguile its own citizens and the citizens of the United States into incurring the expense of importing merchandise into the Philippine Islands only to find that they could not dispose of it after such importation."
>
> (Appellants' Printed Application for Rehearing, p. 8.)

Appellants' conclusion are, indeed, far-fetched. Must a person who brings an article of merchandise into the Philippine Islands necessarily sell it? Is it

inconceivable that merchandise may be brought into the Philippine Islands for purposes other than their sale? Cannot the Legislature say that it is its wish that merchandise imported into the Philippine Islands bearing a mark which clashes with locally registered trade-marks, may be so imported but not sold therein? Is it not the privilege of the Legislature when granting a right, to limit and define the extent of that right, provided it does not amount to a denial of a constitutional right? Must the Legislature *necessarily* grant the right to sell merchandise when granting the right to import them into the country? The answers to these questions are obvious. Such powers pertain to the Philippine Legislature.

Appellants at page 13 of their Printed Application for Rehearing and also at page 5 of their Printed Supplemental Argument invoke the decision of this Honorable Court in the case of Western Equipment & Supply Co. *et al.* vs. Reyes, 51 Phil. 116, to the effect that "a trade-mark does not acknowledge any territorial boundaries." That statement is true but in a limited sense. A trade-mark does not acknowledge territorial boundaries once it is coupled with a trade which it is designed to protect and identify. In the same paragraph of the syllabus of the cited case from which the statement above quoted is taken, we find this other statement: "In such a case it is the trade and not the mark that

is protected." What trade did the appellants have in the Philippines when in 1918 the Heacock Co. registered its "ROGERS" trade-mark? Nothing. Surely counsel do not contend that because a "trade-mark does not acknowledge territorial boundaries" that a trader from another country may come into the Philippine Islands with his foreign trade-mark which infringes a locally registered trade-mark and sell his goods here with impunity. Is not there such a principle in law as a limitation of a person's right by rights previously acquired by another? Is it not a sound legal principle that a man's rights end where his neighbor's rights begin?

Counsel at page 15 of their Printed Application for Rehearing make these pointed remarks:

> "The trade-marks of the appellant Wm. A. Rogers, Ltd. here in question would, by virtue of the certificates of registration of the Patent Office at Washington, be protected in England, France, or any other friendly foreign nations against the piracy of a third person acting as the representative of the United States competitor of the appellant.
>
> "Is it the intention of this Honorable Court to lay down the doctrine that trade-marks registered under the laws of the United States are entitled to less protection in the Philippines, a territory of the United States, than in foreign countries?"

In the first place, counsel is laboring under the delusion that the mere act of registration of a trade-mark confers a property right upon the registrant. We have shown that such is not the law; that a reg-

istered trade-mark is worthless unless coupled with a trade or business which it identifies and of which it is a part. It naturally follows that if a United States registrant has no trade in England, France or any other foreign country, he cannot invoke protection of such mark in those countries and the same is true of the Philippines, even if we grant for the sake of argument that the Federal Trade-Mark Law is in force in this country.

In the second place, when citizens of one country desire or invoke protection in another country they must first show, as a condition precedent to that protection, that they have complied with the laws of the latter country which prescribe the manner and conditions under which such protection may be granted. Is it the opinion of counsel that a citizen of a foreign country or of the United States may come into the Philippine Islands and without complying with its laws regarding trade-marks acquire therein better rights than a domestic trade-mark registrant who has fully complied with local laws, simply because he has registered his trade-marks under the laws of his own country? Surely counsel for the appellants will not contend that. A citizen of one country in virtue of compliance with the laws of his country cannot acquire in another country better rights than the nationals of the latter country. And that is doubtly true when the national but not the stranger has complied with the re-

quirements of local laws regarding the particular matter.

REFUTATION OF THIRD ALLEGED ERROR

Appellants claim that this Honorable Court erred when it perpetually enjoined, in virtue of the provisions of Act 666 of the Philippine Legislature, the importation and sale of the wares of the appellant Wm. A. Rogers, Ltd. Counsel make this sarcastic remark at pages 19 and 20 of their printed Application for Rehearing:

> "It seems to the undersigned that if any distinction can be drawn between the many astounding doctrines laid down in the decision that this one should be given place at the head of the class.
> * * * * * *
>
> "If this Honorable Court knows of any reason under the sun for perpetually enjoining the sale in the Philippines of the wares of Wm. A. Rogers, Ltd. after the registration of its United States trademarks in the Philippines, our clients are entitled to hear them."

Those reasons are the following:

1. Registration of a trade-mark in the United States gives no right in the Philippine Islands to the registrant as against another person who has previously registered *and used* in the Philippine Islands a conflicting trade-mark.
2. Granting for the sake of argument only that registration of a trade-mark in the United States is the equivalent of a valid registration in the Philippine Islands, such United States registration would still be worthless

without a trade or good will which the registered mark is intended to identify in these islands.

3. The appellants started their business in the Philippines long after the appellee had acquired its trade-mark rights under Act 666 of the Philippine Legislature in virtue of registration *and use* thereunder, and therefore, they could not acquire rights in virtue of their subsequent registration here in opposition to the appellee.

4. Section 14 of Act 666 refers to importation *only* and inasmuch as appellants' importation of their wares are intended for *sale* of the wares so imported in the Philippines, the sale and importation thereof may both be enjoined under Act 666.

5. The remedy of injunction is peculiarly applicable to the violation of trade-mark rights as, indeed, in most cases it is the only effective remedy.

Now, is there anything more astounding than for the appellants to ask for the reasons why this Honorable Court issued a perpetual injunction against them, when those reasons appear in this Honorable Court's decision?

REFUTATION OF FOURTH, FIFTH, SIXTH, SEVENTH AND EIGHTH ALLEGED ERRORS

Appellants claim that this Honorable Court committed the following errors:

IV

"The court erred in holding that the appellee registered the word 'Rogers' with the Bureau of Commerce and Industry in the year 1918 for the use and benefit of the International Silver Com-

pany; in holding that the H. E. Heacock Co. could legally appropriate and register in its own name as a trade-mark the family name 'Rogers' whether for its own use and benefit or for the use and benefit of the International Silver Company and in assuming and holding in effect that the International Silver Company had power to and did authorize such registration for its use and benefit.

V

The court erred in failing to hold that if the appellee registered the family name 'Rogers' for the use and benefit of the International Silver Company it was charged with the latter's knowledge of the registration of the trade-marks of Wm. A. Rogers, Ltd. in the United States and the sale of its wares under such trade-marks in the United States and the court therefore further erred in finding that appellee did not violate Sections 2, 12 and 19 of Act 666 of the Philippine Legislature in obtaining such registration.

VI

The finding and holding of the court that the word 'Rogers' was registered by appellee for the use and benefit of the International Silver Company is in conflict with the rules and regulations governing the registration of trade-marks and is at variance with the pleadings, proofs and theory of appellee and with the judgment of the trial court.

VII

The court erred in disregarding final decisions of the Court of Appeals of the District of Columbia and of the Federal Courts of the United States between Wm. A. Rogers, Ltd. and its predecessor in litigation with the International Silver Company and its predecessors, in which every issue in the cases at bar has been decided in favor of Wm. A. Rogers, Ltd. and its predecessor and founder, Wm. A. Ro-

gers, notwithstanding the finding of this court that the appellee H. E. Heacock Co. is acting as the agent and representative of the International Silver Co. in this litigation.

VIII

The court, having held that the alleged trade-mark 'Rogers' was registered by the H. E. Heacock Co. with the authorization and for the use and benefit of the International Silver Co., erred in failing to hold that the final decisions of the Federal Courts of the United States and of the Court of Appeals of the District of Columbia in the litigation between Wm. A. Rogers, Ltd. and its predecessor and founder, Wm. A. Rogers, on one side and the International Silver Co. and its predecessors on the other are res adjudicata of the present litigation."

It will be noted that in all of these assignments of error the appellants assume that this Honorable Court has made the finding that the H. E. Heacock Co. acted as a mere agent for the International Silver Company when it registered in this country the word "ROGERS" as a trade-mark. We have already shown at pages 5-12 of this memorandum that this Honorable Court did not and could not have made such finding as, indeed, the appellee has always insisted that the "ROGERS" trade-mark is *its own* trade-mark and this Court has so found and given judgment for the appellee and not for the International Silver Company. Moreover, the most cursory reading of appellants' pleadings in these cases will show that that was their own theory of the case. When this Honorable Court said in its

decision that the "ROGERS" trade-mark was registered in this country by the Heacock Co. "for the use and benefit of the International Silver Company," such remarks were only intended to meet appellant's allegations to the effect that the appellee by such registration committed fraud against the International Silver Company. If we are correct in that interpretation of the Court's language, then all of the above assignments of error are baseless.

Appellants also contend under some of these assignments of error that the appellee could not legally register the word "ROGERS" as a trade-mark, whether for itself or for the International Silver Co., because it is a family name. This point has been thoroughly discussed in previous memoranda and briefs submitted by the parties to this Honorable Court and need not be discussed again. Suffice it at this time to point out to this Honorable Court that this question is not a new one in the case, and for that purpose we beg to refer to the trial court's decision, pages 43-75; appellants' printed brief, pages 9-22; appellee's printed brief, pages 22-48; appellants' printed memorandum of oral argument, page 19; appellee's printed memorandum of oral argument, pages 48-50.

Appellants claim that the decisions in previous litigation in the United States between Wm. A. Rogers, Ltd. and the International Silver Company

are binding on the H. E. Heacock Co. because it is merely acting for the International Silver Company. This allegation is at complete variance with the pleadings of both parties. We again repeat, and this Court has so found, that the H. E. Heacock Co. is here litigating its own rights and not those of the International Silver Company. We have said this so many times that we thought appellants would not again dare to confuse the issues of this case by such baseless and unwarranted assumptions. See appellee's printed memorandum of oral argument, pages 11-12, 16, 51-52, 62 and 67-68.

REFUTATION OF THE NINTH ASSIGNMENT OF ERROR

This assignment reads as follows:

> *"The court erred in failing to hold that if the appellee registered the alleged trade-mark 'Rogers' with the authorization and for the use and benefit of the International Silver Co., then such registration must have been consummated for the purpose of wrongfully depriving Wm. A. Rogers, Ltd. and all other independent Rogers concerns engaged in the same business of the rights acquired by virtue of the registration of their trade-marks in the United States Patent Office at Washington."*

Our answer is, as repeatedly stated in the foregoing pages, that the H. E. Heacock Company did not register the trade-mark "ROGERS" as the agent of or for the use and benefit of the International Silver Company who is not a party to this suit and this Honorable Court has expresly found that fact

and has rendered judgment in favor of the H. E. Heacock Co.

Furthermore, there is nothing in the pleadings filed by the appellants in the trial court which would indicate a contention on their part that such registration was made for the use and benefit of the International Silver Company or that the H. E. Heacock Company in such registration merely acted as the agent of the International Silver Company.

TENTH ASSIGNMENT OF ERROR

This assignment reads:

> *"The court erred in assuming and holding in effect that the word 'Rogers' as registered by the appellee embraced all the trade-marks of the International Silver Co. and that such registration protected appellee's trade in the wares of the International Silver Co. in the Philippines and that the sale of the wares of the International Silver Co. before and after the registration of the word 'Rogers' by appellee constituted the use and application of the alleged trade-mark 'Rogers' to the merchandise sold by appellee."*

Under this assignment counsel again bring up the point previously discussed in the printed briefs and printed memoranda of oral argument, submitted by both sides, that the H. E. Heacock Co. never has made use of the word "ROGERS" alone as a trade-mark and that the trade-marks of Wm. A. Rogers, Ltd. contain other words, figures and symbols which differentiate them from the Heacock trade-mark. (See pp. 25-39 of appellants' printed brief; pp. 17-

18 of appellants' printed memorandum of oral argument; and pp. 42-47 of appellee's memorandum of oral argument.)

This case has been decided, and rightly so, on the evidence appearing in the record before the court and not upon evidence which might have been but was not introduced at the trial. The citation from Meriden Britannia Co. vs. Parker, 39 Conn. 450, 12 Am. Rep. 405, made by counsel at pp. 69-71 of their printed Application for Rehearing has no bearing whatsoever to this case for the reason that in the cited case it was not shown, as it was conclusively shown in the instant case, that the words, figures and symbols accompanying the word "Rogers" as stamped on the goods sold and dealt in by both appellants and appellees simply meant different grades or standards of the same article. We quote hereunder what we said on this same subject in our printed memorandum of oral argument, pp. 42-47, as follows:

> "It is next agreed that both the goods of appellants and appellee contain, besides the word 'Rogers' other initials, figures and symbols which distinguish them from each other.
>
> Our answer to that is that those initials, figures and symbols are merely indicative of the different grades of the same line of merchandise, and that is true not only of the goods of the appellee but also of the goods of the appellants. Moreover, the above quoted statements of the witnesses who testified at the trial conclusively show that the all

important word in the local trade is the word 'Rogers', the rest of the inscriptions appearing on the goods being of absolutely no consequence as far as the buying public is concerned."

We quote from the testimony of Mr. Presby himself:

Q. Do you know where these three factories manufacture their goods?

A. William A. Rogers manufactures them at Niagara Falls, William A. Rogers Ltd. in Rhode Island. As to the International Silver Company, I don't know; but I believe it is in Connecticut.

Q. Do you know anything about the quality of the silverware manufactured by these three factories or firms?

A. They all manufacture different grades or qualities, the International Silver Company, Rogers, I mean, William A. Rogers, Ltd., with whose goods I am familiar, are grade for grade known in business as being of the same grade or quality. The nickel-silver of the International and the nickel-silver of William A. Rogers Ltd. are sold by the manufacturers at almost the same prices in the United States, and the prices of the other goods are approximately the same, with the exception that the best grade of the International Silver Company is the type 1847 and the best quality of William A. Rogers Ltd. is known in the market under the name of "Heirloom Plate," which is of better quality than the 1847 of the International Silver Company.

(Translation of the official Transcript of the Stenographic Notes in English, session of October 3, 1928, testimony of Mr. Allen Presby, pp. 108-109).

Q. You said that the number 1881 on the goods of William A. Rogers means a certain grade of those goods. What grade is that?

A. First grade, which is "Heirloom Plate."

Q. And the other marks of William A. Rogers Ltd. indicate different grades?

A. Yes, sir.

Q. So that the number 1881 does not indicate anything else but the grade?

A. Not as far as I know, sir. The others we do not advertise (referring to other symbols or letters); but as far as I know, in our advertisements, 1881 has no special significance, like the International which announced the year 1847 as the year when it was founded.

Q. And how did you advertise this table-ware?

A. We advertised it as one of our trade-marks 1881.

Q. Testifying here the other day, you said you had never advertised these goods?

A. I said so and I maintain it. If you ask me how the American Trading Company has advertised it, then I have not answered the question correctly; I understood that your question referred to the manner in which William A. Rogers Ltd. advertised.

Q. You said this morning that the number 1847 on the goods of the International Silver Company indicates the grade of the article?

A. No, sir. I said that that was the date when it was founded.

Q. Did you not say this morning, that the word [illegible] on the goods of William A. Rogers Ltd. indicated the highest grade of their goods, and that [illegible] 1847 indicates the highest [illegible] International Silver Company?

A. I remember this morning, as did you not? I remember well, I said yes and no. Be-

cause this morning I said that the grade 1847 of the International Silver Company was equivalent to the "Heirloom Plate" of William A. Rogers Ltd. I did not say that the International Silver Company advertised its mark "1847 Plate" as its highest grade article; I said that it is actually a first class article of theirs.

(Testimony of Mr. Allen Presby, pp. 128-130, Translation of the official transcript of the Stenographic Notes in Spanish, session of October 8, 1928.)

On the same subject, we quote from the testimony of Mr. Samuel Gaches, as follows:

Q. Those words or signs which you put or use or have been putting or using in combination with the word Rogers on your articles, such as tableware and other articles of silver, silver plated or nickel, what meaning have they? Why are they put jointly with the word Rogers?

A. The quality of the article, whether it is Meneses silver, nickel, or Meneses silver or various kinds.

Q. So that, as I understand it, those words or signs used jointly with the word Rogers on your articles indicate the quality of the particular article bearing those signs or words?

A. Yes, sir.

(Testimony of Mr. Samuel Gaches, pp. 13-14. Translation of the official transcript of the Stenographic Notes in Spanish, session of August 30, 1928.)

* * * * * * * * *

Q. You said this word Rogers was used jointly with other symbols or words indicating the quality of the merchandise. Is it not true that

the most famous mark that Rogers, made by the International Silver Company, has had, is known as Rogers, 1847?

A. It is the article most extensively advertised as "Rogers 1847".

Q. What quality does the figure 1847 indicate?

A. It is the highest quality of the silver-plated articles manufactured by the International Silver Company.

(Testimony of Mr. Samuel Gaches, p. 21, Translation of the official transcript of the Stenographic Notes in Spanish, session of August 30, 1928.)

From the testimony of Mr. Mariano Javier, Manager of the wholesale department of the H. E. Heacock Co., we quote the following:

Q. Are you employed by the firm Heacock?

A. Yes, sir.

Q. Since when?

A. Approximately twenty-three years, since 1906.

Q. What position do you hold, if you hold any now with the firm mentioned?

A. Chief of the wholesale department.

(Testimony of Mr. Mariano Javier, p. 36, Translation of the official transcript of the Stenographic Notes in Spanish, session of October 3, 1928.)

* * * * * * * *

Q. But these articles exhibited here show the different grades of all those articles?

A. According to the mark they bear.

Q. Yes?

A. Yes, sir.

Q. According to this sample that you have brought here, the symbols indicate the quality of the article?

A. Yes, sir.

Q. And these samples here, for instance "A. A. 1847", and the word "Bros. 1847", in addition to the word Rogers, what do they indicate in this article?

A. That is the difference in quality, that is, in the grade of the article, as 1847, 66, the A. A. followed by other names like "Nickel-Silver, 66 Silver", according to the different articles or the quality of each article.

Q. You mean that those symbols or words "66 A. A." and other symbols or words indicate the specific quality of each article?

A. Yes, sir.

MR. ENRILE. Nothing further.

MR. FERRIER.

Q. Have you anything to do with the advertisement of the Heacock Company?

A. No, sir.

Q. What quality does the number 1847 indicate on any of those silver or silver-plated articles?

A. As far as I know, 1847 is the best grade of silver-plated Rogers ware.

Q. Is it not true that that figure 1847 means the year when Rogers began to manufacture silver table-ware or silverware?

A. I don't know.

MR. FERRIER. That is all.

(Testimony of Mr. Mariano Javier, pp. 92-93, Translation of the Official Transcript of the Stenographic Notes in Spanish, session of October 3, 1928.)

And this Honorable Court, having before it the evidence submitted during the trial, has made this finding:

"The evidence is conclusive that the wares for which the American Trading Company has been

taking and filling orders is *very similar in appearance, design, and material* to the wares which have been advertised and sold in this country by Heacock Company since 1906. It is true that a dealer in such wares could and would see the distinction between them, but even so, in the ordinary course of business, the average public to whom they are sold could not and would not distinguish one from the other."

* * * * * * * *

"It is contended that besides the word 'Rogers', the goods of both parties contain initials, figures, and symbols which distinguish them from each other, *but the evidence shows that in dealing with the public, the important and decisive words is the word 'Rogers'.*" (Italics ours.)

We may add that the above holding of this Honorable Court is not new in this jurisdiction. In the case of Spinner & Co. vs. Neuss Hesslein Corporation (Jan. 13, 1930), XXVIII O. G. 1939, 1942, this Honorable Court said:

"It has been held in the Supreme Court of the United States that the use of *only* one of the words constituting a trade-mark may be sufficient to constitute an infringement, and it is not necessary to this end that all of the words comprising the trade-mark should be appropriated." (Italics ours.)

Counsel make this statement at pp. 65-66 of their printed Application for Rehearing:

"It is idle to expect that if the rights of *the parties* have been settled as a result of registration of all the trade-marks *involved in this litigation* in

> the United States Patent Office and as a result of years of litigation in the courts of the United States, that the Supreme Court of the United States will tolerate repudiation by the International Silver Company or by its representative, the H. E. Heacock Company, of such registration proceedings and final decisions *between the parties* in the United States."

The most serious statement we can find in the quoted paragraph is the open threat made to this Honorable Court to the effect, that unless it reverses itself, the Supreme Court of the United States is sure to reverse its decision in this case. The rest is of no consequence. The rights of the *parties in this case* have never been settled by registration proceedings or litigation before the courts of the United States or elsewhere. The International Silver Company is not a party to this case. The parties herein are the H. E. Heacock Company on the one side and Wm. A. Rogers, Ltd. and Americas Trading Company on the other. The subject matter of this litigation is the word "ROGERS" registered in the Bureau of Commerce and Industry of the Philippine Islands pursuant to Act No. 666 of the Philippine Legislature as the trade-mark of the H. E. Heacock Company and unfair competition waged by the appellants against the H. E. Heacock Company *in the Philippine Islands*. Even if this suit were one between the appellants on the one side and the International Silver Company on the other —which, of course, it is not—still the decisions relied on by the appellants would be of no consequence

in this suit for the reason that it is the unanimous weight of authority in the law of trade-marks that the adoption of a trade-mark does not, at least in the absence of some valid legislation enacted for the purpose, project the right of protection in advance of the extension of the trade, or operate as a claim of territorial rights over areas into which it thereafter may be deemed desirable to extend the trade. This is the language used by the Supreme Court of the United States in the case of United Drug Co. vs. Theodore Rectanus Co., 248 U. S. 97, 39 Sup. Ct. 48, 63 L. Ed. 141, which to this day remains a leading case on the subject of trade-marks. The facts of that case almost exactly parallel the facts of the present case. One Mrs. Regis started to manufacture and sell medicinal preparations in a small way in Massachusetts under the mark "REX" which a firm succeeding her in the business registered as its trade-mark, first under the laws of the state of Massachusetts and later on under the Federal Trade-Mark Law of March 3, 1881. Later on the plaintiff corporation acquired the business, which was then conducted in the State of Massachussets, together with all of its trade-mark rights. In the meanwhile Theodore Rectanus, a druggist of Louisville, Ky., employed the word "REX" as a trade-mark for a medicinal preparation which he sold in and around Louisville, gradually extending his trade in the State of Kentucky and spending money for advertising and building up his trade. Later on Rectanus sold

his business to the defendant corporation including his trade-mark rights. Then the plaintiff corporation sought to extend its trade into the State of Kentucky where the defendant company and its predecessors in business had been operating in ignorance of the plaintiff's prior appropriation of the word "REX" and its use in Massachusetts. Plaintiff then brought suit in the United States district court for the western district of Kentucky to restrain infringement of its trade-mark in that state. Upon appeal to the Supreme Court of the United States, that court, in a very illuminating decision, laid down the rules with respect to the nature of property rights in trade-marks and their territorial span, which to this day are followed and recognized as the most lucid statements of such principles. Said the United States Supreme Court in that case:

> "The entire argument for the petitioner is summed up in the contention that whenever the first user of a trade-mark has been reasonably diligent in extending the territory of his trade, and as a result of such extension has in good faith come into competition with a later user of the same mark, who, in equal good faith, has extended his trade locally before invasion of his field by the first user, so that finally it comes to pass that the rival traders are offering competitive merchandise in a common market under the same trade-mark, the latter user should be enjoined at the suit of the prior adopter, even though the latter be thus kept in only the competitive field and the former have already established a trade there. Its application to the case is based upon the hypothesis that the record

shows that Mrs. Regis and her firm, during the entire period of limited and local trade in her medicine under the Rex mark, were making efforts to extend their trade so far as they were able to do with the means at their disposal. There is little in the record to support this hypothesis; but, waiving this, we will pass upon the principal contention.

"The asserted doctrine is based upon the fundamental error of supposing that a trade-mark right is a right in gross or at large, like a statutory copyright or a patent for an invention, to either of which, in truth, it has little or no analogy. Delaware & H. Canal Co. v. Clark, 13 Wall. 311, 322, 20 L. ed. 581, 583; McLean v. Fleming, 96 U. S. 245, 254, 24 L. ed. 828, 832. There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed. The law of trade-marks is but a part of the broader law of unfair competition; the right to a particular mark grows out of its use, not its mere adoption; its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another's product as his; and it is not the subject of property except in connection with an existing business. Hanover Star Mill, Co. v. Metcalf, 240 U. S. 403, 412-414, 60 L. ed. 713, 717-719, 36 Sup. Ct. Rep. 357.

"The owner of a trade-mark may not, like the proprietor of a patented invention, make a negative and merely prohibitive use of it as a monopoly. See United States v. American Bell Teleph. Co. 167 U. S. 224, 250, 42 L. ed. 144, 157, 17 Sup. Ct. Rep. 809; E. Bement & Sons v. National Harrow Co., 186 U. S. 70, 90, 46 L. ed. 1058, 1068, 22 Sup. Ct. Rep. 747; Paper Bag Patent Case, 210 U. S. 405, 424, 52 L. ed. 1122, 1130, 28 Sup. Ct. Rep. 748.

In truth, a trade-mark confers no monopoly whatever in a proper sense, but is merely a convenient means for facilitating the protection of one's good will in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or the package in which it is sold.

"*It results that the adoption of a trade-mark does not*, at least in the absence of some valid legislation enacted for the purpose, *project the right of protection in advance of the extension of the trade, or operate as a claim of territorial rights over areas into which it thereafter may be deemed desirable to extend the trade.* And the expression, sometimes met with, that a trade-mark right is not limited in its enjoyment by territorial bounds, is true only in the sense that wherever the trade goes, attended by the use of the mark, the right of the trader to be protected against the sale by others of their wares in the place of his wares will be sustained."

(United Drug Co. v. Theodore Rectanus Co., 63 L. ed. 141, 145-146)

* * * * * * * *

"Conceding everything that is claimed in behalf of the petitioner, the entire business conducted by Mrs. Regis and her firm prior to April, 1911, when petitioner acquired it, was confined to the New England states, with inconsiderable sales in New York, New Jersey, Canada, and Nova Scotia. There was nothing in all of this to give her any rights in Kentucky, where the principles of the common law obtain. Hunt v. Warnicke, Hardin (Ky.) 61, 62; Lathrop v. Commercial Bank, 8 Dana, 114, 121, 33 Am. Dec. 481; Ray v. Sweeney, 14 Bush, 1, 9, 29 Am. Rep. 388; Aetna Ins. Co. v. Com., 106 Ky. 864, 881, 45 L. R. A. 356, 51 S. W. 624; Nider v. Com., 140 Ky. 684, 687, 131 S. W.

1024, Ann. Cas. 1913E, 1246".
(Id. Id. p. 146.)

Assuming for the sake of argument only that the Federal Trade-Mark Law is in force in this jurisdiction as contended by the appellants, and assuming further that they were the prior users of the "ROGERS" trade-mark in the United States, although they had come to the Philippines to extend their trade herein in 1925 (long after the Heacock Co. had been operating under the same trade-mark), we might with propriety paraphrase the above language of the Supreme Court of the United States in applying it to the instant case, as follows:

> "Conceding everything that is claimed by the appellants, the entire business conducted by them prior to 1925 was confined to the United States and elsewhere but not in the Philippine Islands. There is nothing in all of this to give them any rights in the Philippines."

The Supreme Court says further:

> "Undoubtedly, the general rule is that, as between conflicting claimants to the right to use the same mark, priority of appropriation determines the question. See Delaware & H. Canal Co. v. Clark, 13 Wall. 311, 328, 20 L. ed. 581, 583; McLean v. Fleming, 96 U. S. 245; 24 L. ed. 828, 830; Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51, 53, 25 L. ed. 993, 994; Columbia Mill Co. v. Alcorn, 150 U. S. 460, 467, 37 L. ed. 1144, 1146, 14 Sup. Ct. Rep. 151. But the reason is that purchasers have come to understand the mark as indicating the origin of the wares, so that its use by a second proprietor amounts to an attempt to sell his goods as

those of his competitor. The reason for the rule does not extend to a case where the same trade-mark happens to be employed simultaneously by two manufacturers in different markets separate and remote from each other, so that the mark means one thing in one market, and an entirely different thing in another. It would be a perversion of the rule of priority to give it such an application in our broadly extended country that an innocent party who had in good faith employed a trade-mark in one state, and by the use of it had built up a trade there, being the first appropriator in that jurisdiction, might afterwards be prevented from using it, with consequent injury to his trade and good will, at the instance of one who theretofore had employed the same mark, but only in other and remote jurisdictions, upon the ground that its first employment happened to antedate that of the first-mentioned trader.

"In several cases Federal courts have held that a prior use of a trade-mark in a foreign country did not entitle its owner to claim exclusive trade-mark rights in the United States as against one who, in good faith, had adopted a like trade-mark here prior to the entry of the foreigner into this market. Richter v. Anchor Remedy Co., 52 Fed. 455, 458; Richter v. Reynolds, 3 C. C. A. 220, 17 U. S. App. 427, 59 Fed. 577, 579; Walter Baker & Co. v. Delapenha, 160 Fed. 746, 748; Gorham Mfg. Co. v. Weintraub, 196 Fed. 957, 961.

"The same point was involved in Hanover Star Mill. Co. v. Metcalf, 240 U. S. 403, 415, 60 L. ed. 713, 719, 36 Sup. Ct. Rep. 357, where we said: 'In the ordinary case of parties competing under the same mark in the same market, it is correct to say that prior appropriation settles the question. But *where two parties independently are employing the same mark upon goods of the same class, but in so-*

parate markets wholly remote the one from the other, the question of prior appropriation is legally insignificant, unless at least it appears that the second adopter has selected the mark with some design inimical to the interests of the first user, such as to take the benefit of the reputation of his goods, to forestall the extension of his trade, or the like.'".

(United Drug Co. v. Theodore Rectanus Co., 63 L. ed. 141, 146-147)

Again assuming, for the sake of argument only, that the Federal Trade-Mark Law is in force in these Islands as contended by the appellants and that they were the prior registrants and users of the "ROGERS" mark in the United States and elsewhere outside the Philippine Islands, we might paraphrase the above language in applying it to the instant case as follows:

"It would be a perversion of the rule of priority to give it such an application in this broadly extended would, that an innocent party like the appellee, who in good faith had employed and registered the "ROGERS" trade-mark in the Philippine Islands and by the use of it had built up a trade there, being the first appropriator in this jurisdiction, might afterwards be prevented from using it or deprived of its good will by the use of a conflicting mark by the appellants who theretofore had employed the same mark, but only in the United States and elsewhere outside the Philippine Islands, upon the ground that its first employment happened to antedate that of the appellee herein."

This Honorable Court undoubtedly had in mind these very same principles when it wrote into its de-

cision of the instant case this brilliant and illuminating paragraph:

> "If appellants' contention is sustained, any old established firm here which in good faith had applied for and obtained, the registration of a given word as its trade-mark and through its skill, energy, and business dealings had built up a good business, largely founded on that trade-mark, could after many years of such business wake up some fine morning and find that its trade-mark was out of but little, if any, commercial value, because some other firm in the United States had registered its trade-marks in the Patent Office of that country, in which it made use of the word which the local merchant had registered as its trade-mark in this country. What would be the value of an old registered trade-mark in the Philippine Islands upon which a merchant had established his business here, if in later years another person in the same line of business, and on the strength of a similar registered trade-mark in the United States, could enter the field here and become a competitor in the sale of similar wares under similar trade-marks?"

The Supreme Court of the United States in the Rectanus case goes on further to say:

> "And it results as a necessary inference from what we have said, *that petitioner, being the newcomer in that market, must enter it subject to whatever rights had previously been acquired there in good faith by the Rectanus Company and its predecessor.* To hold otherwise—to require Rectanus to retire from the field upon the entry of Mrs. Regis's successor—would be to establish the right of the latter as a right in gross, and to extend it to territory wholly remote from the furthest reach of the trade to which it was annexed, with the

effect not merely of depriving Rectanus of the benefit of the good will resulting from his long continued use of the mark in Louisville and vicinity, and his substantial expenditures in building up his trade, but of enabling petitioner to reap substantial benefit from the publicity that Rectanus had thus given to the mark in that locality, and of confusing if not misleading the public as to the origin of goods thereafter sold in Louisville under the Rex mark; for, in that market, until petitioner entered it, 'Rex' meant the Rectanus product, not that of Regis."

(United Drug Co. v. Rectanus, 63 L. ed. 147.)

"Here the essential facts are so closely parallel to those that furnished the basis of decision in the Allen & Wheeler Case, reported sub nom. Hanover Star Mill. Co. v. Metcalf, 240 U. S. 403, 419, 420, 60 L. ed. 713, 720, 721, 36 Sup. Ct. Rep. 357, as to render further discussion unnecessary. Mrs. Regis and her firm, having, during a long period of years, confined their use of the 'Rex' mark to a limited territory wholly remote from that in controversy, must be held to have taken the risk that some innocent party might in the meantime hit upon the same mark, apply it to goods of similar character, and expend money and effort in building up a trade under it; and since it appears that Rectanus in good faith, and without notice of any prior use by others, selected and used the 'Rex' mark, and by the expenditure of money and effort succeeded in building up a local but valuable trade under it in Louisville and vicinity before petitioner entered that field, so that 'Rex' had come to be recognized there as the 'trade signature' of Rectanus and of respondent as his successor, petitioner is estopped to set up their continued use of the mark in that territory as an infringement of the Regis trade-mark. Whatever confusion may have arisen

from conflicting use of the mark is attributable to petitioner's entry into the field with notice of the situation; and petitioner cannot complain of this. As already stated, respondent is not complaining of it."

(Id. Id. page 148.)

The result of it all is that even under the most favorable assumptions, the appellants in the present case have not a leg to stand on.

Furthermore, under the doctrine laid down in the Rectanus case, this case can be easily distinguished from Western Equipment & Supply Co. vs. Reyes in that there the principal defendant was clearly guilty of fraud, whereas in the present case the H. E. Heacock Co. committed no fraud whatever.

REFUTATION OF ELEVENTH ERROR

As their eleventh assignment of error, appellants allege as follows:

"The court erred in failing to find that the registration in the Philippines of the alleged trademark 'Rogers' was and is a nullity first, because it was never applied to any wares previous to its registration and second, because it was never used after its registration.

Under this assignment appellants again bring up the question of the alleged non-use by the Heacock Co. of its trade-mark "ROGERS" and this claim is based on the fact, as alleged, that the appellee has never used, either before or after registration, the word "ROGERS" alone upon the merchan-

dise it has sold, but always in conjunction with other words, figures and symbols.

This point is not a new one in this case. Appellants have discussed this same question in their printed brief, pages 22-24, and the authorities now cited from 26 R. C. L. and from 38 Cyc. were also cited in said brief. Appellants also touched on this point in their printed memorandum of oral argument, pages 20-21. Our answer to that question may be found in pages 48-49 of our printed brief and pages 53-56 of our printed memorandum of oral argument. We also beg to refer this Honorable Court to pages 56-65 of this memorandum where we have dealt with this same subject at length.

We only have to add that it is not necessary that the Heacock Co. itself should place the mark on its goods or that such goods be manufactured by it.

> "*Acquisition of Trade-Marks. Who May Acquire.* Only those persons who have some connection or relation to the goods to which the mark is applied can obtain a trade-mark, because the sole function of a trade-mark is to indicate that relation, and show origin or ownership of the goods. *Any persons, including corporations, and aliens, who are connected with particular goods in any of the following capacities, may acquire a trade-mark to indicate that connection, and to secure to them the benefits of their good-will:* viz., manufacturers, workmen, *dealers*, or *jobbers* who merely select or sell goods manufactured by others, exporters, *importers*, commission merchants, and other persons

bearing a similar relation to the goods." (Italics ours.) (38 Cyc. 688-690.)

And in Nelson v. Winchell, 203 Mass. 75, 89 N. E. 180, 23 L. R. A. (N.S.) 1150, it was said:

> "The use of a trade-mark does not necessarily and as matter of law import that the articles on which it is used are manufactured by the user; it may be enough that they are manufactured *for* him, that he controls their production, *or even that they pass through his hands in the course of trade, and that he gives to them the benefit of his reputation or of his name and business style.*" (Italics ours.)

Furthermore, Section 2 of Act No. 666 of the Philippine Commission, as amended, reads as follows:

> "Sec. 2. Anyone who produces, *or deals in merchandise of any kind* * * * may appropriate to his exclusive use a trade-mark * * *."

The fact that the word "ROGERS" was never used alone by the Heacock Co., but always in conjunction with other words, initials, figures and symbols even if true, would not prove non-user of the mark, because the evidence of record is undisputed that such other words, initials, figures or symbols, at least in this market, indicate merely the different grades or quality of the merchandise. In other words, in so far as the Philippine public is concerned—and that is all that matters as far as this case is concerned—those initials, figures and symbols were not a part of the trade-mark but merely indicative of the quality of the merchandise trade-

marked "ROGERS". This is not only true of the goods of the appellee as testified to by its witnesses without contradiction, but also of the goods of the appellants, according to the testimony of Mr. Presby, President and General Manager of the appellant American Trading Company, agents in the Philippine Islands for the appellant Wm. A. Rogers, Ltd. Under such circumstances, the decisions relied on by the appellants are not applicable to this case, because this case has been and must be decided on the facts as shown by this particular record.

REFUTATION OF TWELFTH ALLEGED ERROR

This assignment of error reads as follows:

"The court erred in failing to find that the action of the appellee is prohibited by Section 4 of Act 666 of the Philippine Legislature."

Appellants claim, in view of the fact that the Heacock Co. only registered the word "ROGERS" as its trade-mark and that the trade-marks appearing on appellee's goods which appellee claims to have been infringed were "1847 Rogers Bros." and "Wm. Rogers & Son", that there is no infringement, for the reason that "1847 Rogers Bros." and "Wm. Rogers & Son", have never been registered here as trade-marks of the appellee.

Again this point is not a new one. It has been brought up time and time again by the appellants

and we have answered it in every instance. In the preceding pages we have given a complete answer to this question. That answer is that the all important word in the business of the appellee and also of the appellants in the Philippine Islands is the word "ROGERS", and this Court has so found; and that the other initials, words, figures and symbols accompanying said word are—as far as the Philippines is concerned—merely indicative of the quality or grade of the merchandise. Under the evidence in this case, which is concurred in by both appellants and appellee, the word "ROGERS" is the trade-mark, and the words and figures "1847", "Bros." "Wm." "& Son" are merely indicative of quality or grade of the merchandise. The same is true of the goods sold by the appellants as testified to by Mr. Presby, *supra*. That is the understanding of the public in the Philippine Islands, and this case has been and must be decided upon that evidence, irrespective of the United States decisions on the subject. If appellants can show us one single contrary decision where the same state of facts appear, we are willing to withdraw this argument.

THIRTEENTH ASSIGNMENT OF ERROR

As appellants do not argue this assignment and as this Honorable Court has rightly decided this question at pages 15-16 of its decision herein, using the following language:

> "How could Heacock Company in 1918 know that seven years later the American Trading Com-

pany or Wm. A. Rogers, Ltd. would appear on the scene, claiming the right to the use of the word 'Rogers' as a family name? How could it then know that Wm. A. Rogers, Ltd. had registered its trade-marks in the United States Patent Office? The construction of this section should be confined and limited to actual matters and things as they existed in 1918 when Heacock Company applied for, and obtained the registration of, the word 'Rogers'.

In one form or another the word 'Rogers' was used in the trade-mark of the International Silver Company which it registered in the Patent Office of the United States, *and the records show that the International Silver Company knew of, and consented to, the registration of the word 'Rogers' by the Heacock Company in 1918. Hence, Heacock Company never committed any fraud against that company when it registered the word 'Rogers' in the Philippine Islands.* Neither did it commit any fraud against Wm. A. Rogers, Ltd., for the simple reason that when in 1918 Heacock Company registered the word 'Rogers', Wm. A. Rogere Ltd. was then not doing business in the Philippine Islands;"

we need not dwell further upon this assignment of error. Suffice it to add that at pages 10-11 of our printed memorandum of oral argument we already answered this contention of the appellants in the following language:

"Appellants apparently wish to say that because of registration in the United States they had *previously appropriated* the mark so that the Heacock Co. could not thereafter register it in the Philippine Islands. The argument is surprising. In the first place, the Philippine Legislature never attempted to legislate for any other country but the Philippine Islands. In the second place, to give

Sec. 2 of Act 666 such a meaning would require that the Bureau of Commerce and Industry carry a complete up-to-date register of all trade-marks registered in the United States,—nay, in all the countries of the world—in order to determine, upon application for registration of a particular trade-mark, if the same had previously been appropriated elsewhere, because there is as much reason to construe the phrase 'previously appropriated by another' as applying to the United States as to any other country of the civilized world. In the third place, registration of a trade-mark—as we have seen—gives no right to the registrant except in connection with an established trade and good will, and appellants had none *here* in 1918 when the Heacock Co. registered its own trade-mark *here*. In the fourth place, the rights of a registrant under the Federal Trade-Mark Law are 'coterminous with the territory of the United States', and, therefore, can have no effect beyond the confines of continental United States, *supra*."

Refutation of Fourteenth Assignment of Error

This assignment reads:

"The court erred in the following conclusion: 'If in June, 1918, when the Heacock Company applied for the registration of the word 'Rogers', the Wm. A. Rogers, Ltd. had then been in the field with its wares, another and a very different question would be presented.'" (p. 17, decision.)

This Honorable Court is absolutely right in the statement quoted by counsel. If in June, 1918, when the Heacock Co. applied for registration of the word "ROGERS" as its trade-mark, the appellant Wm. A. Rogers, Ltd., had been in this field en-

gaged in the sale of its wares, a different question would be presented. That question would be one of fact as to which of the two concerns had first used the mark in this country and whether the goods bearing that trade-mark were sufficiently identified in the public mind and in the trade with the word "ROGERS" to warrant a finding that the registered word was the equivalent of the "commercial signature" of either of them.

Counsel ask at page 78 of their printed Application for Rehearing this question:

> "But why, we ask, does such exclusive right flow from priority in the Philippine market and priority of registration of the word 'Rogers' in the Philippines if it is not by reason of the expiration of some prescriptive period?"

Counsel may have saved themselves the trouble of asking this question if they had read the decision of the Supreme Court of the United States in the case of United Drug Co. vs. Theodore Rectanus, *supra*, which is a complete answer thereto. There is no question of prescription involved; the question is simply one of acquisition of a right by priority of use and priority of registration. Prescription, as we understand it, presupposes a right already existing, which is lost in favor of another through the lapse of the prescriptive period. No such question is involved in this case. The question here is the same as would be involved if A. and B., for example, were to apply for the possession of public

lands in the Philippines as a homestead. The land belongs to neither of them in the first place, so that neither would loose it by prescription, but priority of occupancy or priority of application would determine the respective rights of the parties to the land applied for.

REFUTATION OF FIFTEENTH ALLEGED ERROR

This assignment of error reads as follows:

> *"The court erred in assuming and holding in effect that appellants were guilty of unfair business competition solely by dressing the wares of Wm. A. Rogers, Ltd. in their legitimate trade marks registered in the United States Patent Office at Washington, and that such unfair business competition continued even after such trade-marks were duly registered in the Bureau of Commerce and Industry of the Philippine Islands."*

Again and again, this is not a new question in this case. Appellants discussed it at pages 26-34 of their printed memorandum of oral argument. We dwelt upon it at pages 63-69 of our printed memorandum of oral argument as follows:

> "It is argued by counsel that the H. E. Heacock Co. has no case of unfair competition against the appellants for the following reasons:
>
> 1.—Because there is no contention on the part of the appellee that appellants' goods constitute an imitation of appellee's goods, as indeed all spoons, forks etc. must necessarily have the same general shape.
>
> 2.—Because unfair competition cannot be predicated on the possible confusion or de-

ception caused by *'the legitimate use* of a *duly* registered trade-mark.'

3.—Because the right of Wm. A. Rogers, Ltd. to the use of its United States trade-marks have been adjudicated against the International Silver Co. in the courts of the United States.

4.—Because the right of Wm. A. Rogers, Ltd. to the exclusive use of its own trade-marks in the United States carries with it the right to use the same trade-marks in the Philippine Islands.

As to the first point, our answer is:

The appellee does not contend that spoons, forks, etc. must be different from other merchandise of similar character in order not to constitute an infringement of appellee's trade-mark or in order to avoid unfair competition. But their designs and distinguishing marks must be such as not to cause confusion in the mind of the public that the goods sold or dealt in by the appellants are those of the appellee, for which the appellee has established a reputation at the expense of a huge fortune thru advertising and a continuous policy of fair dealing for over 25 years. Section 7 of Act 666, as amended, reads as follows:

'Any person who in selling his goods shall give them *the general appearance* of goods of another manufacturer *or dealer*, either in the wrapping of the packages in which they are contained, *or the device or words thereon*, or in the manner of their manufacture, *or in any other feature of their appearance*, which would be likely to influence purchasers to believe that the goods offered are those of a manufacturer or dealer who holds a duly registered patent therefor *or who has* long

been accustomed to manufacture *or sell*, such goods *and who is other than the actual manufacturer or dealer.* * * * *shall be guilty of unfair competition.* * * *"*

There is no question as to the similarity in the general appearance of the goods of both appellants and appellee, specially as to their quality known as "nickel silver". A glance at the exhibits will show this fact. There can be no question that the public has been actually deceived as shown by the testimony of witnesses, heretofore quoted, and that appellants actually sought to profit by the deception. The proof is abundant and overwhelming that the appellants induced their customers to place orders for their goods because the mark "Rogers" was known in this market thru the propaganda made by the appellee and that the orders were given because of that. See testimony of Mr. Andre Bernard, General Manager of Levy & Blum, testimony of Vicente Sto. Domingo Bernardo, testimony of Santiago Varela, testimony of Jose Tupas and testimony of Manuel Couto, *supra*. If there is no case of unfair competition in the present instance with the proof of record, absolutely uncontradicted, showing actual and designed deception of the public, there can never be a case of unfair competition.

As to the second point:

Counsel argue that unfair competition cannot be predicated *'on the legitimate use of a duly* registered trade-mark' which causes confusion in the mind of the public. They rely on the last paragraph of Section 7 of Act 666 as amended. We are entirely in accord with the proposition. But are the trademarks of the appellants *duly* registered here? and have they made a *legitimate use* of such trade-marks in this country? Certainly not. As we have shown, they never registered their trade-

marks in the Philippine Islands except after rendition of judgment in these cases by the trial court and that such registration cannot be invoked in this case now. We have also shown that such registration is absolutely illegal because it constitutes an infringement of a previously registered trade-mark of the appellee, and therefore, a violation of Section 2 of Act 666. We have shown that the Federal trade-mark law is not in force in this jurisdiction and therefore, registration in the United States gives no rights to such registrant in the Philippine Islands, except that importation of such goods cannot be prohibited here (Sec. 14 of Act 666), but that the goods so imported or introduced cannot be sold here in violation of the rights of the appellee. And there cannot be any question that appellants have not made a legitimate use here of their United States trade-marks, granting for the sake of argument only that they could use them here at all, for the reason that the proof is overwhelming that they have wilfully and maliciously induced their own dealers to buy or order their goods because there was already a market for them in this country on account of the good will and extensive advertising done by the H. E. Heacock Co. Moreover, if registration of a mark in the United States is not a valid registration under our local laws, such United States registration must be treated as non-existent in so far as the application of the last paragraph of Section 7 of Act 666 is concerned.

As to the third point.

Counsel argues that the rights of Wm. A. Rogers, Ltd. have been adjudicated by the courts of the United States against the International Silver Co. This is no concern of ours. The appellee herein—we repeat—is litigating its own rights acquired by virtue of its own trade here and not those of the International Silver Co. The International Silver

Co. is not a party to this suit. Appellants could have made the International Silver Co. a party if they so desired, but they did not do so. They could have raised this question in their pleadings, but they did not. They relied absolutely on the alleged validity in the Philippine Islands of the registration of their trade-marks in the United States and on the applicability of the Federal Trade-Mark Law to the Philippine Islands. Now they must suffer the consequences. They cannot plead one thing in the lower court and argue another thing on appeal. But that does not surprise us after seeing that they have attempted to introduce evidence before this Honorable Court, which evidence was not submitted to the lower court—as indeed it could not have been submitted because it was non-existent at the time of the judgment—and they are seeking a reversal of the trial court's judgment on evidence submitted for the first time to the Supreme Court and which the trial court never had occasion to consider.

As to the fourth point.

Counsel claim that the right of Wm. A. Rogers, Ltd. to the use of their own trade-mark in the United States carries with it the right to use that same trade-mark in the Philippine Islands. We have repeatedly answered this argument in the foregoing pages of this memorandum. In the first place registration in the United States is not the equivalent of registration in the Philippine Islands and gives no rights to such registrant in the Philippine Islands. In the second place, the Federal Trade-Mark Law is not in force here. In the third place, granting for the sake of argument that the Federal Trade-Mark Law is in force here and that registration in the United States is a valid registration in so far as these islands are concerned, nevertheless, the appellants would have no right to the use of their mark here as against a previous registrant

in this country for the reason that registration alone gives no right to the registrant because it is not a right in gross and it is valueless except in connection with an existing trade or good will, and the proof is undisputed that the H. E. Heacock Co. had sold and advertised their goods since 1905, registered their trade-mark in 1918 and that the appellants came into this market for the first time in 1924 or 1925.

REFUTATION OF SIXTEENTH ALLEGED ERROR

Under this assignment, appellants claim that:

"Where the duly registered legitimate trade-marks of both litigants contain the same family name or other common denominator the court has no power to enjoin the use of such name by either litigant or to go beyond regulating their use in such form as to avoid deception of the public."

This is practically a confession that they have infringed the trade-mark of the appellee. Appellants, in effect, promise to be good and honest competitors hereafter if only this Honorable Court would be so good as to order them to use some device whereby their goods might be distinguished from those of the appellee and save them from a perpetual injunction of the use of the word "ROGERS" thereon.

Again, we repeat, this case has been and must be decided on the evidence as submitted to the trial court. It would be unfair to consider on appeal anything that the trial court did not have before it in deciding this case. Under that evidence it is undisputed, and this court has so found, that other

words, figures and symbols accompanying the word "Rogers" are immaterial and of no consequence in so far as buyers in the Philippines are concerned, and that the all important word here is the word "ROGERS". Under that evidence, how can this Honorable Court consistently permit the appellants to use the word "ROGERS" upon their merchandise?

Appellants again insist that courts are without authority to prevent individuals or corporate entities from the use of their personal names in their business. That is not good law, specially where, as in this case, the proof is conclusive that the appellants actually induced dealers to buy their goods on account of their ready salability arising from the fact that appellee had widely advertised the word "ROGERS" in connection with similar merchandise, and where the dealers actually took advantage of it to deceive the public, even to the extent of supplying appellants' wares to people who had ordered silverware giving in their orders the corresponding number of the Heacock catalogue.

This question is fully discussed in the trial court's decision appearing at pages 44-47 of the Bill of Exceptions in G. R. No. 31852. We also discussed it fully in our printed brief, pages 22-48. We will now briefly give a few of the many cases in the United States where persons were unconditionally enjoined from the use of their own names.

In the case of International Silver Co. v. Simeon L. & George H. Rogers Co. *et al.*, 110 Fed. 955, the court said:

> "It can hardly be denied that the defendant has no right to the use of 'Rogers Bros.' or of '1847, Rogers Bros.', or of '(Anchor) Rogers (Anchor)'; but it is said, 'We have a right to the use of our whole name, and we prefix our initials to "Rogers Bros." and to "Rogers", and we add to "Rogers" the letters "Co."' *In point of fact, these prefixes and suffixes are obscure, and, to the ordinary observer, enigmatical. They actually convey no meaning.* The marks simulate the marks of the complainant and, under the guise of monograms, present the appearance of the marks of the complainant. The motive for such simulation was the advantage to be gained by misleading the purchaser at retail to the belief that the articles so stamped are what the public calls 'Rogers goods.' *Neither can the defendant corporation simulate the marks of the complainant by the use of the name 'Rogers Bros.', or 'Rogers' with or without a preceding or succeeding emblem or symbol or initials. These names are the substantial and distinctive part of the trade-mark in the mind of the purchasing public.*
>
> The bill is for the restraint or prevention of the infringement of trade-marks, and of unfair competition in trade in connection therewith, and asks for a preliminary as well as permanent injunction against the use upon silver-plated ware of the mark 'Rogers Bros.,' whether alone or accompanied by a symbol or monogram, and against the use of a mark consisting of the word 'Rogers', either alone or preceded or followed by some symbol or monogram; in other words, the bill asks for an injunction against the simulation of the complainant's trade-marks upon silverware, and asks for a like

injunction against the use of the corporate name 'Simeon L. & George H. Rogers Co.' in connection with the business of manufacturing and selling silver-plated ware, upon the ground that the adoption of this corporate name was a fraudulent attempt to gain the benefit of the manufacturing reputation of the corporations known as the original 'Rogers' companies. There is no adequate reason why a preliminary injunction should not issue as prayed for against the simulation of the complainant's marks upon silverware, especially against the use of the marks heretofore used; and the simulation is sufficiently complete when 'Rogers Bros.' or *'Rogers' is plainly presented, either alone or accompanied by some symbol or emblem or hieroglyphical device.*" (Italics ours.)

In the case of International Silver Co. vs. Rogers, 67 Atl. 105, the court said:

> *"It is the word 'Rogers' that is all controlling, and it is that which should be differentiated in order to effectually distinguish the goods.* In Baker v. Sanders, 80 Fed. 889, 895, 26 C. C. A. 220, the defendant (in lieu of more extended changes), was required to affix the statement that 'W. H. Baker is distinct from and has no connection with the old chocolate manufactury of Wilter Baker & Co.' In the case of Allegretti v. Allegretti, 52 N. E. 487, 177 Ill. 129, in the Supreme Court of Illinois, the court enjoined the defendants against the use of the name 'Allegretti', except in a manner indicating that the defendants' goods are manufactured and sold by B. F. Rubel, I. A. Rubel, and Giacomo Allegretti, and not by Ignazio Allegretti or the Allegretti Chocolate-Cream Company." (Italics ours.)

In the leading case of Henderson vs. Peter Henderson & Co., 9 Fed. (2nd) 787, the court said:

"We are of the opinion that the use of the initial 'A', preceding 'Henderson' in connection with any part of appellant's seed business does not here, any more than in the Davids *Case*, avoid the conclusion of 'colorable imitation.'.

* * * * * * * *

Nor is the decree objectionable in providing that the term 'Henderson' shall not be employed by appellant in any name he may adopt for his seed packages. Appellee's lawful registry gives it the sole right to the employment of 'Henderson' as a name for its seed product, and, where lawful right to label a product with the registered name has been secured, the same word should not be employed in any name for another's like product where in reason this can be avoided." (Italics ours.)

In the case of Wm. Rogers Mfg. Co. vs. Rogers & Spurr Mfg. Co., 11 Fed. 495, the court said:

"Even if we grant all that has been said about the freedom to use names (and I grant upon that subject much more than has been argued, for I set no limits to that freedom, excepting interference with acquired rights), *the books are full of cases in which defendants have been restrained from using their own names in a way to appropriate the goodwill of a business already established by others of that name.* Croft v. Day, 7 Beav. 84; Mertzler v. Wood, L. R. 8 Ch. D. 606; Fallwood v. Fallwood, L. R. 9 Ch. D. 176; Levy v. Walker L. R. 10 Ch. D, 436; Massam v. Thorley, L. R. 245; Devlin v. Devlin, 69 N. Y. 212; Filkins v. Blackman, 13 Blatchf. 440; Stonebraker, v. Stonebraker 33, Md. 252; Chaver v. Chaver, 54 Iowa, 208 (S. C. 6 N. W. Rep. 188); Churton v. Douglas, Johns. (Eng.) 174. See 25 Albany Law J. 203.

All these cases in equity depend upon an appro-

priation by one person of the reputation of another, sometimes actually fraudulent, and sometimes only constructively so."

Why can the Philippine courts not enjoin appellants from the use of the word "ROGERS", specially as under the evidence in this case they have made a fraudulent use of that word in this country in order to profit by the advertising and good will established therein by the Heacock Co. for its goods so marked, at the expense of a fortune, and it has been conclusively shown, as found by this Honorable Court, that the one all important word in the whole trade-mark system of appellants and appellee, in so far as this particular market is concerned, is the word "Rogers"?

REFUTATION OF SEVENTEETH ALLEGED ERROR

This assignment of error reads as follows:

"The court erred in assuming and holding in effect that the appellee, the H. E. Heacock Co., is the party injured by the transactions which are the subject of this action."

If the real party injured is not the H. E. Heacock Co., may we ask why did the appellants not raise that question in the trial court? May we ask why appellants did not ask the trial court to include the International Silver Company as a party plaintiff or defendant? Did not appellants predicate their complaint against the Heacock Co. (see paragraphs 6 and 7 of appellants' complaint appearing at pages

3-4 of the Bill of Exceptions in G. R. No. 31852) on the fact that said company had registered the word "Rogers" as *its own* trade-mark?

This argument about the Heacock Co. not being the party really injured is clearly an afterthought—the dying song of the swan.

CONCLUSION

In conclusion we wish to state that this Honorable Court has rightly decided this case and has not committed any of the errors assigned by the appellants in their application for rehearing. Furthermore, there is nothing new in the said application except the nature of the language employed therein in criticism of this Honorable Court and, therefore, the decision rendered is one which has been arrived at after due consideration of all those questions.

The argument that the Federal Trade Mark Law of 1905 is in force in this jurisdiction is too ridiculous to merit any further consideration, and even assuming that such law is in force here, under the decision of the Supreme Court of the United States in the case of United Drug Co. vs. Rectanus, cited herein at pages. . . .the decision rendered by this Honorable Court would be a proper and right decision.

FOR ALL OF THE FOREGOING CONSIDERATIONS, it is respectfully submitted that appellants' applica-

tion for rehearing should be denied.

Manila, P. I., February 23, 1931.

DEWITT, PERKINS & BRADY
By: C. A. DEWITT
Attorneys for Appellee,
601-609 National City Bank Bldg.,
Manila, P. I.

ANSWER TO APPELLANTS' MOTION FOR A NEW TRIAL

Appellant's motion for a new trial is based solely upon the affidavit of Attorney J. W. Ferrier appearing at pages 103-104 of appellants' printed application for rehearing (Appendix "C"). Said affidavit virtually states that affiant has some newly discovered evidence consisting of paragraph 2 of rule 1 promulgated by the Bureau of Commerce and Industry for the application of Act 666, which rule one is attached to said application for rehearing and motion for a new trial as Appendix "B".

Attorney Ferrier swears in said affidavit that he exercised due diligence in looking up said rules to find if they were in force in 1918 when the Heacock Co. registered its "ROGERS" trade-mark, which due diligence consisted, as he alleges, in his having asked of "*two employees*" of the Law Division of the Bureau of Commerce and Industry if said rule "was in force in 1918".

In the case of U. S. vs. Luzon, 4 Phil. 343 and other subsequent cases, this Honorable Court has laid down the rules under which a new trial may be granted on the ground that the party seeking such new trial has some newly discovered evidence to present in his defense. Those rules are:

1. The evidence must have been discovered since the trial.
2. It must be such that with the use of reasonable diligence *on the part of the defendant* it could not have been secured on the former trial.
3. It must be material and not merely collateral or cumulative or corroborative or impeaching.
4. It must be such as ought to produce a different result on the merits on another trial.
5. It must go to the merits, and not rest on merely a technical defense.

APPLICATION OF THESE RULES TO THE AFFIDAVIT OF ATTY. FERRIER AND THE SO-CALLED NEWLY DISCOVERED EVIDENCE

1. *Was the alleged new evidence discovered since the trial?* Attorney Ferrier says so and we will take his word for it. But there is no showing that such evidence is newly discovered in so far as his clients are concerned. The universal rule is that the "new evidence" must have been unknown to the client and not to the attorney.

2. *Could the appellants have procured it for use at the former trial if they had used reasonable*

diligence? Certainly. In the first place, there is no statement by any of the appellants that they tried to procure the evidence in question and the duty of searching for evidence devolves on the client and not on the attorney; consequently, when the attorney and not the client looks for evidence, the client is negligent and he cannot predicate his pretended right to a new trial on his own negligence. In the second place, Attorney Ferrier did not use due diligence in his search because the act of asking "two employees" of the Bureau of Commerce if a certain rule was in force or not at any given time, certainly cannot be considered due diligence. Rules for the application of laws promulgated by bureaus of the executive departments of the government, shall have force only when "approved by the Department Head and published in the Official Gazette or otherwise publicly promulgated", in accordance with Section 551 of the Administrative Code. Attorney Ferrier, therefore, being a lawyer, should have inquired of the Chief of the Bureau of Commerce, of the Secretary of Commerce and Communications, or looked in the Official Gazette for the information he wanted instead of merely asking "two employees" of the Law Division of the Bureau of Commerce as he states under oath. His manner of inquiry was negligence in itself and his clients certainly cannot claim a new trial predicated on his negligence. Moreover, according to the certification of Mr. Tomas Confessor, Director of the Bureau

of Commerce and Industry, Appendix "B", the rule sought to be introduced as newly discovered evidence, is merely a copy of what appears on the MERCANTILE REGISTER, which by force of law is open to the inspection of the public. If Attorney Ferrier had looked in the Mercantile Register instead of asking "two employees" of the Bureau of Commerce, he would have found what he wanted. What would this Honorable Court say if appellants should pray that they be absolved from paying damages to the appellee on the ground that they did not know that there was such a thing as a trade-mark law in this country because they had gone to the Legislative Building on Calle P. Burgos and there asked the watchman and, say, fifty other employees, if there was such a thing as a trade-mark law in the Philippine Islands and that they were there informed that there was no such law? Is not that a close parallel of appellants' present reason for asking a new trial? A lawyer must be charged with knowledge of where and how to look for the law in force in the jurisdiction in which he practices his profession.

3. *Is the alleged new evidence material?* Surely not. In the first place, there is no showing that the alleged rule has been approved by the Department Head and only in such case would it have any force in so far as the public is concerned. Neither is it shown that the same has been published in the Official Gazette. In the second place, the require-

ment therein made that the importer file an affidavit that he is authorized to register the mark in his own name, refers only to cases where the importer seeks to register the trade-mark of the manufacturer, and that is not the case here. In this case the Heacock Co. registered the trade-mark "ROGERS" as its own and it is not the mark of the International Silver Company. In the third place, the rule referred to deals with requirements previous to registration but it nowhere appears that such registration would be null and void if made without one of the said requirements. In the fourth place, the only party who could complain of appellee's non-compliance with said requirement would be the International Silver Company, because, as alleged by the appellants, the mark registered by the appellee is the mark of said company. And lastly because the appellants in their pleadings never questioned the legality of registration of appellee's trade-mark on the ground now sought to be raised, as it was an admitted fact that such registration had been properly accomplished, and surely this Honorable Court will not permit the appellants to plead and try their cases by installments.

4. *Will the introduction in evidence upon a new trial of the rules contained in Appendix "B" of appellants printed application for rehearing and motion for a new trial change the result on the merits of this case?* Certainly not. The evidence is undisputed that the International Silver Company consent-

ed to the registration made by the Heacock Co. Furthermore, that evidence can be more firmly and indisputably established upon a new trial. Such being the case, would this court change its decision and leave the appellee completely without redress, notwithstanding the fact conclusively proven that it has been the first comer into this market, that it has spent a fortune in advertising its wares, and that now the appellants are availing themselves of its good will and business reputation to the damage and prejudice of the appellee, simply because it overlooked to file the consent of the International Silver Company? Surely this Honorable Court will not do that, specially in the light of the fact that the rule in question was designed to protect the manufacturer and the International Silver Company is not complaining and the suit instituted by the appellee, in the last analysis, will redound to its benefit as much as to the benefit of the appellee.

5. *Is the defense sought to be established by the appellants by the introduction in evidence of the rule in question merely a technical defense*? No argument is needed to show that it is.

FOR THE REASONS STATED, the appellee respectfully prays that the motion for a new trial filed by the appellants be denied.

Manila, P. I., February 23, 1931.

DEWITT, PERKINS & BRADY

By: C. A. DEWITT

Attorneys for the Appellee,

601 National City Bank Bldg.,

Manila, P. I.

(HH)

On March 7, 1931, counsel for the appellee filed an objection to the admission of appellants' "Additional Affidavits and Citations in Support of Application for Rehearing and Motion for New Trial" dated February 19, 1931.

(II)

On March 7, 1931, the Supreme Court entered the following resolution:

> "Upon consideration of the motion of the attorneys for the appellants in cases R. G. Nos. 31851-31852, H. E. Heacock Co. v. American Trading Company et al., praying, for the reasons therein stated, that a rehearing be granted therein and in case of denial of said motion for rehearing a new trial be ordered, in connection with the supplementary arguments together with the exhibits presented by the appellants; and of the objection thereto interposed by the attorneys for the appellee, the Court, DENIED the MOTION. Mr. Justice Ostrand dissented. Messrs. Justices Johnson and Villamor took no part."

(JJ)

On December 2, 1930, the following final judgments were entered:

The Court having regularly acquired jurisdiction for the trial of the above-entitled cause submitted by both parties for decision, after consideration thereof by the Court upon the record, its decision and order for judgment having been filed on the 21st day of November, A. D. nineteen hundred and thirty;

By virtue thereof it is hereby adjudged and decreed that the judgment of the Court of First Instance of Manila, dated the 11th day of March, nineteen hundred and twenty-nine, and from which the above-entitled appeal was taken, be, and the same is hereby, affirmed, with costs against the appellant.

It is further ordered that the appellee recover from the appellant the sum of ₱40.00, as costs.

(SGD.) V. ALBERT
Clerk of the Supreme Court
of the Philippine Islands

The Court having regularly acquired jurisdiction for the trial of the above-entitled cause submitted by both parties for decision, after consideration thereof by the Court upon the record, its decision and order for judgment having been filed on the 21st day of November, A. D., nineteen hundred and thirty;

By virtue thereof it is hereby adjudged and decreed that the judgment of the Court of First Instance of Manila, dated the 11th day of March, nineteen hundred and twenty-nine, and from which the above-entitled appeal was taken, be, and the same is hereby, affirmed, with costs against the appellants.

It is further ordered that the appellee recover from the appellants the sum of ₱40.00, as costs.

(SGD.) V. ALBERT
Clerk of the Supreme Court of the
Philippine Islands

(KK)

On March 11, 1931, counsel for the appellants filed the following Exception and Notice of Petition for Writ of Certiorari:

EXCEPTION AND NOTICE OF PETITION FOR WRIT OF CERTIORARI

COME NOW the appellants American Trading Company and Wm. A. Rogers, Ltd., by their undersigned attorneys, and except to the decision rendered by this Honorable Court on March 7, 1931, and communicated to the undersigned on March 10, 1931, denying their application for rehearing and motion for new trial, and also except to the final judgment entered therein.

Notice is hereby given that appellants intend to petition the Supreme Court of the United States for a writ of certiorari for a review of the decision.

The grounds *inter alia* upon which appellants intend to petition the Supreme Court of the United States for a writ of certiorari for the revision of the decision and judgment of this Court are:

1.—That under the second to the last paragraph of Section 138 of the Administrative Code, as amended by Section 2 of Act No. 3816 of the Philippine Legislature, the concurrence of eight Justices of the Supreme Court is necessary for the pronouncement of a judgment herein, and that therefore the decision of this Supreme Court denying appellants' ap-

plication for a rehearing and motion for new trial, which was concurred in by only six Justices, is null and void;

2.—That this Honorable Court erred in not holding that the Act of Congress of February 20, 1905, as amended, is applicable to the Philippine Islands;

3.—That this Honorable Court erred in failing to hold that the property rights created by the registration of trade-marks in the United States under the provisions of the Act of Congress of February 20, 1905, as amended, in conjunction with Section 14 of Act No. 666 of the Philippine Commission, are entitled to the protection of the tribunals of justice in the Philippine Islands, whether said Act of Congress be technically and directly applicable to the Islands or not;

4.—That this Honorable Court erred in so interpreting Act No. 666 of the Philippine Legislature as to cause it to interfere with the trade relations between the United States and the Philippines in violation of the Act of Congress of August 29, 1916 (known as the Jones Bill) c. 416, Section 10.

5.—That this Honorable Court erred in disregarding the final decisions of the Court of Appeals of the District of Columbia and of the Federal Courts of the United States between Wm. A. Rogers, Ltd. and its predecessor in litigation with the International Silver Company and its predecessors, in

which every issue in the case at bar has been decided in favor of Wm. A. Rogers, Ltd. and its predecessor and founder Wm. A. Rogers, notwithstanding the finding of this Court that the appellee H. E. Heacock Co. is acting as the agent and representative of the International Silver Company in this litigation;

6.—The Court, after finding "for the purposes of this opinion it is admitted that the trade-marks of Wm. A. Rogers, Ltd. as registered in the United States are now registered in the Philippine Islands" (p. 13, decision), erred in affirming the decision of the trial court perpetually enjoining the importation into the Philippines and sale of the wares of the appellant Wm. A. Rogers, Ltd. under such trademarks thus registered both in the United States and in the Philippines;

7.—The Court erred in holding that the appellee registered the word "Rogers" with the Bureau of Commerce and Industry in the year 1918 for the use and benefit of the International Silver Company; in holding that the H. E. Heacock Co. could legally appropriate and register in its own name as a trademark the family name "Rogers" whether for its own use and benefit or for the use and benefit of the International Silver Company and in assuming and holding in effect that the International Silver Company had power to and did authorize such registration for its use and benefit;

8.—The Court erred in failing to hold that if the appellee registered the family name "Rogers" for the use and benefit of the International Silver Company it was charged with the latter's knowledge of the registration of the trademarks of Wm. A. Rogers, Ltd. in the United States and the sale of its wares under such trademarks in the United States and the Court therefore further erred in finding that appellee did not violate Sections 2, 12 and 19 of Act 666 of the Philippine Legislature in obtaining such registration;

9.—The finding and holding of the court that the word "Rogers" was registered by appellee for the use and benefit of the International Silver Company is in conflict with the rules and regulations governing the registration of trademarks and is at variance with the pleadings, proofs and theory of appellee and with the judgment of the trial court;

10.—The Court, having held that the alleged trademark "Rogers" was registered by the H. E. Hancock Co. with the authorization and for the use and benefit of the International Silver Co., erred in failing to hold that the final decisions of the Federal Courts of the United States and of the Court of Appeals of the District of Columbia in the litigation between Wm. A. Rogers, Ltd. and its predecessor and licensee, Wm. A. Rogers, on one side and the International Silver Co. and its predecessors on the other were res adjudicata of the present litigation,

11.—The Court erred in failing to hold that if the appellee registered the alleged trademark "Rogers" with the authorization and for the use and benefit of the International Silver Co., then such registration must have been consummated for the purpose of wrongfully depriving Wm. A. Rogers, Ltd. and all other independent Rogers concerns engaged in the same business of the rights acquired by virtue of the registration of their trademarks in the United States Patent Office at Washington;

12.—The Court erred in assuming and holding in effect that the word "Rogers" as registered by the appellee embraced all the trademarks of the International Silver Co. and that such registration protected appellee's trade in the wares of the International Silver Co. in the Philippines and that the sale of the wares of the International Silver Co. before and after the registration of the word "Rogers" by appellee constituted the use and application of the alleged trademark "Rogers" to the merchandise sold by appellee;

13.—The Court erred in failing to find that the registration in the Philippines of the alleged trademark "Rogers" was and is a nullity first, because it was never applied to any wares previous to its registration and second, because it was never used after its registration;

14.—The Court erred in failing to find that the action of the appellee is prohibited by Section 4 of

Act 666 of the Philippine Legislature;

15.—The Court erred in assuming and finding in effect that the sworn declaration of the applicant for registration of a trademark required under Sections 12 and 19 of Act 666 to the effect that "no other person, firm or corporation has the right to the use of the trademarks sought to be registered", is limited to persons, firms or corporations in the Philippines and does not apply to persons, firms or corporations whose trademarks are registered only in the United States;

16.—The Court erred in the following conclusion: "If in June, 1918, when the Heacock Company applied for the registration of the word 'Rogers', the Wm. A. Rogers, Ltd. had then been in the field with its wares, another and a very different question would be presented" (p. 17, decision);

17.—The Court erred in not holding that when the duly registered trademarks of both litigants contain the same family name or other common denominator, the Court has no power to enjoin the use of such name by either litigant or go beyond regulating their use in such form as to avoid deception of the public; and

18.—The Court erred in assuming and holding in effect that appellants were guilty of unfair business competition solely by dressing the wares of Wm. A. Rogers, Ltd. in their legitimate trademarks

registered in the United States Patent Office at Washington, and that such unfair business competition continued even after such trademarks were duly registered in the Bureau of Commerce and Industry of the Philippine Islands.

WHEREFORE, appellants pray that the record of the above entitled cases be retained in this Court so as to enable the Clerk of this Court to prepare the necessary transcript of said record for the Supreme Court of the United States; and that an appropriate order be entered fixing the supersedeas bond and suspending the enforcement of the decision and judgment entered herein.

Manila, P. I., March 11, 1931.

J. W. FERRIER and
GIBBS & McDONOUGE,

By

A. D. GIBBS
Attorneys for Appellants,
Peoples Bank Bldg., Manila.

(LL)

On March 13, 1931, the Hon. Ramon Avanceña, Chief Justice of the Supreme Court of the Philippine Islands, issued the following memorandum order:

(CAPTION AND TITLES OMITTED)

MEMORANDUM ORDER

Pursuant to the resolutions of this Court, dated March 11, 1931, Mr. Justice George A. Malcolm is

hereby designated to act for and in the name of the Court, subject to the approval of the Court, in the above-entitled cases, he may pass upon any motion or motions presented therein, and he may issue such orders as are necessary to prevent unnecessary delays in the dispatch of said cases.

(MM)

On March 13, 1931, the Hon. George A. Malcolm, Associate Justice of the Supreme Court of the Philippine Islands, issued the following order:

(CAPTION AND TITLES OMITTED)

ORDER

Upon consideration of the motion of the attorneys for the appellants in the above entitled cases, excepting to the resolution of this Court, denying their application for rehearing and for new trial as well as to the final judgment entered therein; giving notice of their intention to petition the Supreme Court of the United States for a writ of certiorari for review of said judgment, and praying that the record of said cases be retained in this Court, and that appropriate order be entered fixing the supersedeas bond and suspending the enforcement of said decision and judgment, IT IS ORDERED that the EXCEPTION BE NOTED, and the amount of the bond for the stay of execution of judgment is hereby fixed at $10,000.00, United States Currency, to be filed with this Court within ten days from notice hereof and to be approved by the undersigned, after hearing the appellee as to the sufficiency of the bond and solvency of the sureties.

By authority of the Supreme Court.

On March 23, 1931, upon motion of counsel for Wm. A. Rogers, Ltd., and American Trading Com-

pany, the Court granted them an extension of ten days within which to file the supersedeas bond required by the order of March 13, 1931.

On April 1, 1931, Wm. A. Rogers, Ltd. and American Trading Company filed a bond signed by the Fidelity and Surety Company of the Philippine Islands as surety, in the sum of $10,000.00, United States Currency, which bond was approved by Mr. Justice Thomas A. Street on April 4, 1931.

On April 8, 1931, counsel for Wm. A. Rogers, Ltd. and American Trading Company filed the following motion:

(CAPTION AND TITLES OMITTED)

COME NOW the appellants in the above entitled cases, by their undersigned attorneys, and beg leave of the Court to file with the record the annexed affidavit regarding the pecuniary amount involved in this litigation, in relation with their announced intention to petition the Supreme Court of the United States for a writ of certiorari for a review of the decision herein of the Supreme Court of the Philippine Islands.

Manila, P. I., April 7, 1931.

J. W. FERRIER and
GIBBS & McDONOUGH,
BY: A. D. GIBBS
Attorneys for Appellants,
Peoples Bank Bldg., Manila

Received copy this 7th day
of April, 1931
DEWITT, PERKINS & BRADY,
BY ALFONSO ENRILE
Attorneys for the Appellee,
National City Bank Bldg., Manila.

UNITED STATES OF AMERICA
PHILIPPINE ISLANDS } ss.
CITY OF MANILA

S. ALLEN PRESBY, being first duly sworn deposes and says:

That he is the president and general manager of the defendant corporation, American Trading Company, and as such has been and still is representing the codefendant, Wm. A. Rogers, Ltd., as its sales agent in the Philippine Islands; that he knows the amount or value in controversy in the above entitled actions; that the amount or value in controversy in the above entitled actions, that is to say, the value of the use in the Philippines of the trademarks, the use of which has been perpetually enjoined by the judgment of the Court of First Instance and affirmed by the Supreme Court of the Philippines is greatly in excess of twenty-five thousand dollars ($25,000.00), United States Currency; that during the years 1924, 1925 and 1926, the approximate amounts of the sales of the wares of the defendant, Wm. A. Rogers, Ltd., in the Philippines

under the trademarks in controversy were as follows:

1924	$ 2,246.00
1925	3,183.00
1926	12,778.00;

that during the years 1927, 1928, 1929 and 1930, the exact amounts of the sales of the wares of the defendant Wm. A. Rogers, Ltd. in the Philippines under the trademarks in controversy were as follows:

1927	$ 3,300.00
1928	28,730.00
1929	47,480.00
1930	122,322.00;

that the net profit on such sales during the years 1924 to 1930, inclusive, to Wm. A. Rogers, Ltd. and the American Trading Company was in excess of twenty-five thousand ($25,000.00) dollars, United States currency.

Further affiant saith not.

(SGD.) S. ALLEN PRESBY

Subscribed and sworn to before me this 7th day of April, 1931, in the city of Manila, P. I., by the said S. ALLEN PRESBY exhibiting his cedula No. F-8707 issued at Manila, P. I., on January 13, 1931.

(SGD.) ROMAN OZAETA
Notary Public
My commission expires on
December 31, 1932.

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Not. Reg. for 1931.

On April 9, 1931, the Hon. Thos. A. Street, Associate Justice of the Supreme Court of the Philippine Islands, issued the following order:

(CAPTION AND TITLES OMITTED)

ORDER

Upon consideration of the motion of the attorneys for the appellants in the above entitled cases, praying that they be permitted to file with the record the accompanying affidavit regarding the pecuniary amount involved in this litigation, in relation with their announced intention to petition the Supreme Court of the United States for a writ of certiorari for a review of the decision of this Court, IT IS ORDERED that the motion and affidavit be attached to the record.

(NN)

UNITED STATES OF AMERICA

IN THE SUPREME COURT OF THE PHILIPPINE ISLANDS

I, V. ALBERT, Clerk of the Supreme Court of the Philippine Islands, do hereby certify that the foregoing five hundred fifty-six (556) printed pages in all, contain a true and correct translation and transcript of the record of the cases, entitled H. E. HEACOCK CO., Plaintiff and Appellee, vs. AMERICAN TRADING COMPANY, Defendant and Appellant, and WM. A. ROGERS, LTD., and

AMERICAN TRADING COMPANY, Plaintiffs and Appellants, vs. H. E. HEACOCK CO., Defendant and Appellee, bearing Nos. 31851 and 31852, respectively, of the General Register of this Supreme Court.

IN WITNESS WHEREOF I have hereunto set my hand and affixed the seal of the Supreme Court of the Philippine Islands this.....day of May, A. D. nineteen hundred and thirty-one.

V. ALBERT
Clerk of the Supreme Court
of the Philippine Islands.

SUPREME COURT OF THE UNITED STATES, OCTOBER TERM, 1931

No. 506

AMERICAN TRADING COMPANY, Petitioner,

vs.

H. E. HEACOCK Co., Respondent

ORDER EXTENDING TIME WITHIN WHICH TO APPLY FOR WRIT OF CERTIORARI—Filed Aug. 18, 1931

On consideration of the motion of counsel for petitioner in the above entitled cause, and good cause therefor having been shown,

It is ordered that the time within which petition for writ of certiorari may be filed herein be, and the same is hereby, extended for a period of sixty days from September 7, 1931.

Pierce Butler, Associate Justice of the Supreme Court of the United States.

Dated this 15th day of August, 1931.

[File endorsement omitted.]

SUPREME COURT OF THE UNITED STATES, OCTOBER TERM, 1931

No. 507

WILLIAM A. ROGERS, LTD., and AMERICAN TRADING COMPANY, Petitioners,

vs.

H. E. HEACOCK Co., Respondent

ORDER EXTENDING TIME WITHIN WHICH TO APPLY FOR WRIT OF CERTIORARI—Filed Aug. 18, 1931

On consideration of the motion of counsel for petitioner in the above entitled cause, and good cause therefor having been shown,

It is ordered that the time within which petition for writ of certiorari may be filed herein be, and the same is hereby, extended for a period of sixty days from September 7, 1931.

Pierce Butler, Associate Justice of the Supreme Court of the United States.

Dated this 15th day of August, 1931.

[File endorsement omitted.]

SUPREME COURT OF THE UNITED STATES, OCTOBER TERM, 1931

No. 506

AMERICAN TRADING COMPANY, Petitioner,

vs.

H. E. HEACOCK CO.

ORDER ALLOWING CERTIORARI—Filed January 11, 1932

The petition herein for a writ of certiorari to the Supreme Court of the Philippine Islands is granted. And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

SUPREME COURT OF THE UNITED STATES, OCTOBER TERM, 1931

No. 507

WM. A. ROGERS, LTD., and AMERICAN TRADING COMPANY, Petitioners,

vs.

H. E. HEACOCK CO.

ORDER ALLOWING CERTIORARI—Filed January 11, 1932

The petition herein for a writ of certiorari to the Supreme Court of the Philippine Islands is granted. And it

is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

Endorsed on cover: File Nos. 36,320, 36,321. Philippine Islands, Supreme Court. Term No. 506. American Trading Company, petitioner, vs. H. E. Heacock Co. Term No. 507. Wm. A. Rogers, Ltd., and American Trading Company, petitioners, vs. H. E. Heacock Co. Petition for writs of certiorari and exhibit thereto. Filed November 6, 1931. File Nos. 36,320, 36,321.